SUPREME COURT OF THE UNITED STATES,

OCTOBER TERM, 1888. No. 862.

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THE BATE REFRIGERATING COMPANY,
Appellant,

vs.

GEORGE H. HAMMOND & CO.,
Appellees.

BRIEF FOR THE ELECTRIC LIGHT COMPANIES

(BY LEAVE OF COURT.)

EDMUND WETMORE,
SAM'L A. DUNCAN,
LEONARD E. CURTIS,
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THOMAS B. KERR,
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OCTOBER TERM, 1888. No. 862.

THE BATE REFRIGERATING COMPANY,
Appellant,
vs.
GEORGE H. HAMMOND AND COMPANY,
Appellees.

Brief as to the construction of Section 4887 of the Revised Statutes, filed by leave of Court on behalf of the United States Electric Lighting Company, of New York, the Westinghouse Electric Company, of Pennsylvania, the Consolidated Electric Light Company, of New York, the Thomson-Houston Electric Company, of Connecticut, and the Fort Wayne Electric Light Company, of Indiana.

This brief is filed to offer, on behalf of the above-named companies, all of which have an interest in the decision of the appeal, an argument in support of the following propositions :

FIRST ; That Section 4887 of the Revised Statutes applies to all

United States patents granted on inventions patented abroad prior to the issuing of the patents here :

(1) Whether the application for the United States patent preceded or followed the grant of the foreign patent ; and

(2) Whether such patents are for inventions made by citizens or aliens.

SECOND ; That, under this section, that term of the foreign patent which is running at the time of the grant of the domestic patent fixes the term of the home patent, without regard to any subsequent extension of the term of the foreign patent by act of the foreign patentee or otherwise ; and

THIRD ; That, in the case at bar, the Canadian legislation subsequent to the issue of the American patent did not affect the operation of this rule, but the Bate patent in suit expired at the end of the original five-year term oi the Canadian patent.

FIRST.

Section 4887 applies to every United States patent for an invention patented in a foreign country before the grant of the domestic patent, whether such foreign patent is granted before or after the application for the United States patent.

1. The language of the section is as follows :

> "SEC. 4887. No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be

> declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."

There is no doubt or ambiguity about the literal interpretation of these words. The section, taken by itself, admits of but one meaning, *viz.*: That it is the date of the *grant* that is to govern. It reads that: "No person shall be debarred from *receiving* a patent for "his invention * * * by reason of the same having been *first* "*patented* * * * in a foreign country." "First *patented*" in a foreign country means, gramatically, patented in a foreign country before it is *patented* here. If we say a thing is "first sold" abroad, we mean sold abroad before it is *sold* here, not before it is *offered* for sale here; and if we say a thing is "first patented" abroad, we mean patented abroad before it is *patented* here, not before it is *invented* here, or before a patent here is *applied for.* That is the plain, ordinary meaning of the words, which is the sense in which they are to be taken in statutory construction. As they stand, there would be as much reason for saying that "first patented" abroad means patented abroad before the date of *invention* here, as to say that it means before the date of *application* here.

The section proceeds, in a new sentence: "But every patent "granted for an invention which has been *previously patented* in a "foreign country shall be so limited," *etc.* That is, supplying as before the unexpressed consequent, patented abroad before it is *patented* here.

Where language is as free from ambiguity as this—where its literal interpretation is so clear—that interpretation, if it is a case where it can be departed from at all, should only be departed from because it appears by the context, or by existing acts in *pari materia*, to lead to *repugnancy* or to a *manifest defeat* of the plain intention of the law-makers.

Endlich on Stat., Sec. 2, p. 4.

Appellant's brief, so far as it relates to this point, seeks, in substance, to justify a departure from the literal interpretation on two grounds:

First, that the context and the language with which the section begins, "No person shall be debarred," etc., shows that the whole section is to be treated as one which merely creates an exception to Sec. 4886 and nothing else, and, therefore, must be limited to those cases in which, but for the section, the foreign patent would be a bar—so that, it is argued, it does not include foreign patents taken out after the application here, because such foreign patents in no case create a bar to receiving the American patent; and,

Second, that an historical review of the legislation on the subject shows that, from an early day down to the date of the legislation in question, it had been the uniform policy of Congress to make the date of application, and not the date of grant, the date upon which the limitation of the domestic by a foreign patent for the same invention is made to depend.

These respondents earnestly dispute the correctness of these conclusions as well as the accuracy of the premises upon which they are based.

FIRST.

I. It is true that by the Revised Statutes and the preceding Act of 1870, an American patent could not be invalidated by reason of the invention having been patented abroad, unless it was so patented prior not only to the date of the inventor's application here, but to the date of his invention or discovery, and, therefore, express legislation was unnecessary to provide that a foreign patent subsequent to such invention should not debar the inventor from receiving his patent.

But it by no means follows from this that the object of Section 4887 was simply to operate as a proviso or saving clause.

Section 4887 was intended to provide for a different class of cases from that of foreign patents which prevent the granting of an American patent because they anticipate the American applicant and show that he was not the first inventor. It was intended to provide for those cases in which there was no question of the anticipation of an American invention by a foreign patent, but in which the same inventor sought to obtain a patent in this country for an invention which he had already patented abroad, and to prescribe under what conditions and limitations that should be allowed.

The section, therefore, is not treating of what shall anticipate an American invention, but upon what terms inventors may be allowed to patent inventions here which they have also patented abroad.

Now, it is extremely doubtful whether, either under the Revised Statutes or under the preceding Act of 1870 (even if those acts had not contained Sec. 4887 and Sec. 25), a single case could arise in which an inventor would be debarred from obtaining a patent for his invention here simply because he had obtained a foreign patent therefor, either previous to his application here or at any other time.

There is nothing in the Revised Statutes outside of Section 4887, and there was nothing in the Act of 1870 outside Section 25, to prevent any inventor, citizen or alien, from obtaining a patent here for his own invention previously patented abroad, if he complied with the Statutes in other respects, unless, possibly, there existed such a bar in case of inventions *made* abroad and there patented before their introduction to this country.

The provisions of Section 4886 of the Revised Statutes, which substantially re-enacts Section 24 of the Act of 1870, provides that "any person who has invented or discovered any new and useful art," *etc.*, "not patented * * * in any foreign country, before his invention or discovery thereof," may, if the other requisites exist, obtain a patent therefor.

It is clear that, under this section, there is nothing to prevent any person obtaining a patent here for an invention made here, although he may have obtained a prior patent therefor in a foreign country, provided, of course, it has not been introduced into public use here, &c., more than two years before the application.

Suppose Section 4887 did not exist and that an inventor made his invention here, sent his specification abroad, took a patent in England, and then, the invention not having been in public use in this country for more than two years, applied for a patent here? It could not be refused to him. It could not be said to be patented abroad. "before his invention or discovery thereof," and, therefore, in regard to one class of inventors to whom Section 4887 applies, namely, American inventors who make their inventions here and patent them abroad before applying for patents here, there is nothing in the law, exclusive of Section 4887, to debar such inventors from obtaining a patent.

In respect to inventions made abroad, and there patented before the application for a patent for them here, a shade of doubt has been expressed, because it is said "before his invention or discovery thereof" means before his invention or discovery thereof in this country our law taking no notice of what is done in a foreign country, unless it is evidenced by a printed publication or a patent. This seems a strained construction of the law and one which makes an unwarranted interpolation in the language of the statute. If, as actually happened, Prof. Bell makes one of his telephone inventions in London and there patents it, although he cannot carry his date of invention back of his foreign patent so as to defeat a rival inventor who made the invention here, yet can it be said, with any propriety, that he obtained his foreign patent for the invention "before his invention or discovery thereof"?

Supposing 4887 not to exist, and that Prof. Bell applied for an American patent for his invention made abroad and patented abroad prior to his application here, could he, if the case fulfilled the other requisites of the Statute, be rejected under Section 4886 on the ground that his invention had been patented abroad "before his invention or discovery thereof"?

It would certainly seem not.

If, therefore, Section 4887 removes a bar at all, it is only with respect to inventions not only patented abroad, but made abroad, and as to these last, the common-sense construction of the rest of the statute leads to the conclusion that no bar existed, so that the first part of Section 4887 is in no respect a proviso upon 4886, but purely declaratory and intended to remove a possible doubt. *The effect of the section is not to remove a bar but to impose a limitation.* So far as it is a proviso at all, it is simply a proviso or exception to Section 4884, which provides that every patent shall be granted for seventeen years. If it were not for Section 4887, an invention made here and patented abroad by the inventor thereof might be patented here for a full term of seventeen years, and probably the same result would attach in case the applicant here had both made and patented his invention abroad. At all events the first part of the section is either wholly or in part declaratory, and, as the effect of the whole section, limitations are imposed which did not exist without it.

The argument, therefore, founded on the word "debarred" is without force. This word does not show that Section 4887 merely creates an exception, and, moreover, it does not reach the point of this case.

It is only the first part of Section 25 of the Act of 1870, or of Section 4887 of the Revised Statutes, which refers to debarment —to what may prevent the grant of a patent or render it void if granted; the latter part of these sections, with the effect of which alone we are concerned, refers to the limitation of the term of "every patent," without exception, granted after the grant of a foreign patent for the same invention, and this distinction is emphasized and made clear in Section 4887 by dividing the section into two distinct sentences. The first part relates to a certain class of persons, *viz.*, inventors who have previously patented their inventions abroad; the last part refers simply to the *duration* of the patents to such inventors.

We have shown that in at least one notable instance, that of an American inventor who has made his invention here and who takes out a foreign patent before his home application, the removal of a bar by the first part of the sections under consideration does not take place, because, in such case, no bar exists; yet it is admitted that this is one of the cases to which the limitation prescribed by the last part of the sections applies. It follows, therefore, that either the first part of the sections includes cases in which no previous bar exists (and if it includes one of such cases it may include any number), or else that the latter part of the sections includes cases not included in the first part.

This being so, the fact that the first part of the sections removes a bar (if in fact it does this--which is denied), leads to no inference that the limitation imposed by the last part does not apply to a case unaffected by such removal.

II. The argument based upon the theory that under the existing, as under the prior statutes, the filing of the application determines and makes absolute the right to the patent, is irrelevant and unsound. It is irrelevant because it begs the question, and unsound because the right to the patent depends no more upon the filing of the application than upon the other conditions which must be fulfilled before it can be obtained.

(*a*) Even if filing the application determined the right to a patent, it would not, on that account, determine the right to a patent for any particular term; it would only determine the right to such a patent as, under the circumstances, the law allows. If no foreign patent were issued before the grant, it would determine the right to a full term patent; if such foreign patent *were* issued before the grant, it would determine the right to a patent for less than the full term.

To say that filing the application fixes the term of the patent which may be issued thereon is pure assumption, and does not affect the question at issue.

(*b*) But, contrary to appellant's contention, the mere filing of the application does not determine the right to receive a patent, or make absolute what was before inchoate.

That right only becomes absolute upon the performance of *certain other acts*, both antecedent and subsequent to the filing of the application, one of which latter is the payment of the final fee ; and many patents are delayed, or never issued, because the final fee is not paid. The statute (Sec. 4886) gives an inventor a right to a patent only, *inter alia*, " on the *payment* of the fees required by law " and *other due proceedings had*."

So, again, the law requires that the Commissioner of Patents, in certain instances, shall declare an interference to determine the priority between rival claimants ; and no applicant has a right to a patent until this question has been settled. *The record in this case* (pp. 111–113) *shows that Bate's American application was involved in an interference, which was not decided in his favor until October 17, 1877. Consequently he was not entitled to receive his patent until after that date.*

The mere fact that filing the application is the *first* step of the proceedings to be taken in order to secure a patent makes it no more potent in conferring the right thereto, or in making that right absolute, than if it was next to the *last* step. The right to the patent rests primarily not upon the making of the application, but upon the making of the invention.

Every true and original inventor has a right to a patent under our laws upon his fulfilling certain conditions, but until *all* those conditions are fulfilled he has no more right, legal or equitable, to the patent than if none of them were fulfilled.

There is, therefore, nothing in the context or in any provision of existing statutes in pari materia to justify a departure from the literal interpretation of the statute under consideration.

SECOND.

There is no force in appellant's argument derived from the language of the acts prior to the Revised Statutes, or from the supposed policy and intention of the law as disclosed by an historical review of such prior legislation.

I. So far as relates to a comparison of the language of the present and of preceding acts:

(1) The present Statute is free from ambiguity, and, therefore, it is not competent to refer to prior but repealed legislation. Where the meaning of the Revised Statutes is plain, the Court cannot look to the statutes which have been revised to see whether errors were committed in revising them.

United States vs. Bowen, 100 U. S., 508.
Canan vs. Pound, 23 Blatch., 173.

(2) If, however, the former legislation regarding patents be examined, it will furnish an argument in support of respondent's view of Section 4887, rather than against it.

A.

The Act of 1870 was not a mere revision of existing laws.

The very title of the act forbids this assumption. It is entitled "An Act to Revise, Consolidate and AMEND the Statutes relating to "Patents and Copyrights."

Among the changes made by the said act and which are of the nature of *amendment* or *new legislation* and not consolidation, are the following:

(1) The Acts of 1836 and 1839 had undertaken to provide for the contingency of only one prior foreign patent; the Act of 1870 takes up a new question, and enacts what the rights of the inventor shall be when there are several such patents.

(2) Under the Acts of 1836 and 1839 an inventor was barred a patent if the invention had been in common and public use at all prior to his application; the Act of 1870 allows the invention, even in case of a prior foreign patent, to have been in public use for any period not exceeding two years before the application without destroying the right to a patent.

(3) By the Act of 1836, a patent granted here for an invention previously patented abroad was given a term of fourteen years (made seventeen by the Act of 1861) from its own date, which might be the day of actual issue; and in the Act of 1839 the term of the home patent was limited to fourteen years (subsequently made seventeen) from the date or publication of the prior foreign patent. By the Act of 1870, the American patent, instead of being given a term of seventeen years from its own date, or seventeen years from the date of a prior foreign patent, was limited to the term for which the

foreign patent was granted, or, if more than one, of that one having the shortest term ; and thus might be limited to five years or even to one year.

If, then, the Act of 1870 was an act to *amend* as well as to revise ; if it changed the preceding law in the important particulars just enumerated ; if, among those changes, it altered the term of the limitation imposed by the existence of a foreign patent from a fixed term of years calculated from the *date* of the foreign patent to an uncertain term of years dependent upon the *expiration* of the foreign patent ; why should it be assumed that the act did not also intend to amend the law by selecting the date of *grant* here, instead of the date of *application* here, as the date of comparison for determining whether the American is to be limited by the foreign patent?

The fact that the former Acts of 1836 and 1839 fixed this date of comparison by using the explicit terms "preceding the filing of the specification and drawings" and "prior to his application," while the Act of 1870 omits these most important words and adopts in lieu of them the new and significant phraseology "first patented, or "caused to be patented in a foreign country" and "previously patented in a foreign country," is convincing evidence that the Act of 1870 is designed to be *amendatory* in this particular also.

The omission of the express provisions of the former acts must be held to have been made *ex industria*, and this conclusion is strengthened by the fact that the omission is continued and emphasized in the Revised Statutes. Such changes in the phraseology of Section 25 of the former Act of 1870 as were then introduced, and the breaking of the section into two sentences, only tends to make it clearer that the date of the *grant* of the American patent is to be taken as the date of comparison.

If we can for a moment entertain the ingenious idea of appellant's counsel, that the legislators, in passing the Act of 1870, unwittingly sacrificed perspicuity to style, without intending to introduce any real change into the law, it would seem strange that when the revision took place, a few years later, under the management of an able and painstaking commission, this alleged ambiguity should have been in this manner not only perpetuated, but increased, especially when a return to the simple words of the Act of 1839, "patented * * * prior to his application"—substituting these for the new words, "first patented," first adopted in the Act of 1870 —would have expressed with exactness the idea which appellant insists is in fact embodied in the law.

The present case, so far as regards the light to be thrown on Sec. 4887 by reference to the earlier acts, seems to be not unlike the case of *Andrews vs. Hovey*, 123 U. S., 267; 124 U. S., 694.

In that case the complainant contended that, under the Act of 1839 (Sec. 7), a patent could not be defeated by two years' public use or sale of the invention before the application was filed, unless such use or sale was "with the applicant's consent or allowance."

Sec. 6 of the Act of 1836 had provided for the issuing of a patent to an inventor for an invention not known or used by others before his invention or discovery thereof, "and not, at the time of his "application for a patent, in public use or on sale *with his consent or* "*allowance* as the inventor or discoverer."

Sec. 7 of the Act of 1839 provided:

> "Sec. 7. That every person or corporation who has, or shall have, purchased or constructed any newly invented machine, manufacture, or composition of matter, prior to the application of the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific

> machine, manufacture, or composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in said invention ; and no patent shall be held to be invalid by reason of such purchase, sale or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public ; or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent."

The complainant contended that the condition of the applicant's "consent or allowance," although not reproduced in terms in the Act of 1839, really was there by legislative intent. The Supreme Court, although they found that Sec. 7 of the later Act "was intended as an amelioration in favor of the inventor" (as regards the public use or sale necessary to work a bar) "of the strict provisions of the Act of 1836," decided, nevertheless, that the words, "consent or allowance," found in the earlier act but omitted from the new act, could not be put into the latter by judicial interpretation.

The case of *St. Paul Plough Works vs. Starling* (127 U. S., 376), is also instructive in respect to the effect to be given to the changes of phraseology in the Act of 1870 and the Revised Statutes. In that case, Section 56 of the Act of 1870 and Section 699 of the Revised Statutes were under consideration. By the Acts of 1836 and 1861, it was provided that appeals might be had to this Court, without regard to the amount involved, in all "actions, suits, controversies and cases arising under any law of the United States, granting or confirming to inventors the exclusive rights to their inventions or discoveries." Section 56 of the Act of 1870, re-enacted in Sec. 699 of the Revised Statutes, in defining such appeals, changed the phraseology and used the words, "in any action, suit, controversy or case, at law or in equity touching patent rights."

Mr. Justice **Gray** says, in delivering the opinion of the Court, that the substitution of the new phrase "touching patent rights," "must be supposed" to have been made "*purposely*," and that whether or not the case "should be considered as 'arising under' the patent laws of the United States"—a question not before the Court—"it is sufficient for the decision of this motion, that" it "is 'a case touching patent rights,' and therefore within the appellate jurisdiction of this Court under Sec. 699 of the Revised Statutes" (p. 378).

B.

There is no force in the argument of appellant's brief (pp. 10, 11), that, because the latter part of Sec. 6 of the Act of 1839 provides that "every such patent" shall be limited, &c., referring to a patent for an invention patented in a foreign country more than six months prior to the application, and the latter part of Sec. 25 of the Act of 1870, repeated in Sec. 4887 of the Revised Statutes, uses the words "shall expire at the same time with *the* foreign patent," therefore the word "the" in the latter statutes must designate the same kind of a foreign patent as the word "such" in the former. It by no means follows that the foreign patent in one case is the same as to all its conditions as the foreign patent in the other. In one important particular they are, without dispute, dissimilar. In the Act of 1839 the words "such patent" mean every United States patent for an invention patented in a foreign country more than six months before application here, and *also* not introduced into public and common use here *at any time* before application. In the Act of 1870 the words "the foreign patent" mean a patent for an invention which had been first patented in a foreign country, and which has not been introduced into public use here for more than *two years* prior to the application.

II. The amendment of the law by changing the date prior to which the grant of a foreign patent shall have the effect of limiting the American patent, from the date of application (Acts of 1839 and 1861) to the date of grant (Act of 1870 and Sec. 4887 of R. S.), was in furtherance of the original policy of the enactment and in accordance with the true and rational reason for imposing the limitation.

(1.) All the acts on the subject from 1836 to the Revised Statutes make a distinction in regard to American patents for inventions patented abroad, dependent upon the time when the foreign patent may be obtained. If taken out subsequent to the American patent it does not affect it; it only affects the American patent when it is taken out at some time preceding it. This gives an advantage to the person who patents his invention in this country before it is patented abroad, in that the one who patents first here gets a patent for full seventeen years; the one who patents first abroad gets a term which may be very much shorter than seventeen years.

The effect of this is not to prevent a person from obtaining a patent for his invention both here and abroad, but to encourage the taking out of the American patent first, by not granting an American patent for the full term unless that is done. This being the necessary and manifest result of the Statute, it is equally manifest that Congress intended, by passing the act, to bring about that result.

What was the reason for this intention? Why did Congress wish to bring about that result?

The only reason suggested in appellant's brief is that the law was passed so that an invention patented both here and abroad should be free here as soon as it was free abroad; that it was an attempt "to relieve citizens of the United States from a monopoly from which foreigners are exempt" (*ex parte* Mann, 17 O. G., p. 330). But this is an inadequate explanation.

If the object was "to relieve citizens of the United States from monopolies from which foreigners are exempt," the statute is impotent to secure such a result. If a foreign patent is taken out last, it may, and generally does, expire before the American patent, by reason of the shorter terms of foreign patents, so that the result does not follow in that case. If no foreign patent is taken out at all, the American citizen is "under a monopoly from which foreigners are exempt," so that the result does not follow in that case, which is, moreover, the case of the great majority of patents taken out in this country. If Congress had deemed it an evil that an invention patented both here and abroad should not be free here as soon as it is free abroad, it would have provided that the American and foreign patents should, in that case, expire simultaneously, whether the foreign patent was taken out before or after the American patent.

The inadequacy of the statute to "relieve citizens of the United States from monopolies from which foreigners are exempt" is admitted by Patent Commissioner PAYNE himself in *Ex parte* Mann, the only case ever decided in favor of appellant's construction of the statute. He says:

"But in that view the statute is a failure. Its object is only "effected when the foreign monopoly is secured first. If the invention is absolutely free in every other country, or if the foreign patent is obtained last, the monopoly here is complete" (Appellant's Brief, p. 19).

If, however, it *was* among the objects of the statute to prevent the same inventor from obtaining successive monopolies of his invention, first abroad and then here, the second monopoly outlasting the first; or, so far as the statute affects aliens, to deny them privileges not accorded in foreign countries to our own citizens; then, for reasons more fully set forth hereafter, that object was not adequately attained until the date of the *grant* here, instead of the *application* here, was made the date upon which the limiting effect of the foreign patent is made to depend.

It is obvious from the foregoing considerations that to assume that the sole or principal object of the statute was to "relieve citizens of the United States from monopolies from which foreigners are exempt," does not adequately account for its passage. If that was a general policy it should have reached the case of foreign patents subsequent to the home grant; if it was retaliatory legislation only, its operation should have been confined to foreigners, but it embraces our own citizens as well.

The natural inference is that the controlling reason for the passage of the act was the belief on the part of Congress that it was an advantage, where the same invention is patented both here and abroad, to have it patented here *first*. It *is* such an advantage. The probability of the American public reaping the full benefit of the invention is increased, and the danger that foreign nations will obtain greater benefits therefrom than our own people is diminished, by the law under consideration, and to weaken its force by construing it as the appellant contends it should be construed, would be to defeat its intention, impair its benefits and open the door to grave mischiefs.

The primary object of the patent laws is not, as appellant's argument assumes, to benefit the inventor, but to benefit the American people. They are passed for the purpose of securing for inventors a just compensation for giving to the public the benefit of their inventions, not for the purpose of making inventors a favored class.

"A patent for a useful invention," says Mr. Curtis, in his treatise on patents, "is not, under our law, or the law of England, a grant "of a monopoly in the sense of the old common law. It is the "grant by the Government to the author of a new and useful invention, of the exclusive right, for a term of years, of practising "that invention. The consideration for which this grant is made "by the public is the benefit to society resulting from the invention; which benefit flows from the inventor to the public in two "forms: *First*, by the immediate practice of the invention under "the patent; and, *secondly*, by the practice of the invention, or the "opportunity to practice it, which becomes the property of the public on the expiration of the patent."

Curtis on Pat., p. xix.

Now, it is manifest that that part of the benefit received by the public which is first mentioned by Mr. Curtis will, more probably, be enjoyed to its full extent in the country in which the invention is first disclosed and patented. As soon as it is patented it is known. Those who desire to use it, or to purchase the patent, may apply to the patentee for that purpose. Moreover, the practical introduction of an invention is a matter of time. It often needs years of effort on the part of the inventor, or of those who furnish the capital for the purpose, to carry the patented invention through its period of infancy. Ordinarily, this work will be done in the country in which the invention is first protected by a patent, and that country in which the patent is carried through its experimental stage into full development is the country which, naturally, will profit soonest and most from the early practical knowledge of the invention thus acquired and its earlier introduction into general use. This advantage may certainly be very great. Suppose, for example, a valuable improvement in machinery for cotton mills is patented in England and introduced into the mills in that country, and then in the course of five or six years the inventor patents and introduces the invention here. It is highly improbable that it would be introduced here before it was patented here, both because it would not be generally known to our manufacturers, and because no one would undertake to introduce it except through the inventor. Our cotton spinners might, in this way, fall five years behind English manufacturers in point of economy of production, and our public suffer a corresponding loss.

As, therefore, the country of the first patent is more probable to be the country of the first introduction, it is an advantage to our people to secure the first patent, and hence the preference given by the statutes under consideration to those who patent their inventions here before obtaining patents for them in other countries.

While, therefore, our patent laws throw no unnecessary obstacle in the way of American inventors obtaining patents abroad, and give the full benefit of their protection to aliens who may wish to patent here, they offer to all inventors, whether citizens or aliens, an inducement to patent here first by granting a longer monopoly in that case than where there is a prior foreign patent in existence.

It might well be supposed in 1836 and 1839, in the infancy of our patent system, and before its workings could be fully known, that it was sufficient to accomplish this object, if the inventor, in order to get the full benefit of an American patent, was only obliged to first *apply* for his patent here; but during the period of over thirty years which elapsed before the amendments of the Act of 1870, it became evident that it was not enough in order to secure the object of the statute that every American patent *applied for* here before the grant of a foreign patent should be put on the same footing with a patent *granted* here in advance of the foreign patent.

Our patent laws are peculiar in that they enable the inventor to prolong indefinitely the period between the application and the allowance of his patent. If the statute did not apply to cases in which the American application is made before the foreign patent, it would, in such cases, be possible for a foreign inventor to lodge his application in our patent office, and then, by dilatory proceedings open to him, keep his application pending indefinitely until he had taken his foreign patents and developed the invention in any country of his selection—then, returning to the United States, to take out his patent here for the full term of seventeen years, only after he had perfected and introduced the invention abroad.

The evils incident to these delays in prosecuting applications in the U. S. Patent Office are very forcibly set forth by the Commissioner of Patents in his annual report for the year ending December 31, 1887. He says:

> "I desire to call especial attention to the subject of delays which occurs in the Patent Office on the part of applicants in the prosecution of their applications for patents."
>
> "Section 4894 provides:
>
> 'All applications for patents shall be completed and pre-
> ' pared for examination within two years after the filing of the
> ' application, and in default thereof, or upon failure of the ap-
> ' plicant to prosecute the same within two years after any action
> ' therein, of which notice shall have been given to the appli-
> ' cant, they shall be regarded as abandoned by the parties there-
> ' to, unless it be shown to the satisfaction of the Commissioner
> ' of Patents that such delay was unavoidable.'
>
> "Under this section applicants who desire to prolong their applications and postpone action therein have ample opportunity to do so. There are two classes of persons who apply for patents, one composed of those who are exceedingly anxious to obtain their patents at the earliest practicable moment, the other of those who desire to prolong the issue of their patents and to keep the applications pending in the Patent Office to the very latest date possible. The second class embraces the more

powerful, rich and influential parties, who are either the inventors or the assignees of the inventors. This section of the statute enables the second class of persons to keep their applications pending in the office for years before their patents issue. In the meantime they are engaged in manufacturing and putting upon the market the article or improvement, but warning the public that the patent is applied for ; the effect of which is to give them the absolute control and monopoly of the invention, and to deter all other inventors from entering upon the same field of invention and from manufacturing the article.

"The manner in which this delay is effected may be briefly explained. The applicant files his application and is allowed two years within which to complete or perfect it. Any action of the office requiring change or modification, or some formal correction, can be followed under this section by a further delay of two years before the applicant is required to take any action in response. At the expiration of the two years he perhaps makes some amendment or change in the character of his claims. This involves a corresponding action on the part of the office, and however prompt and speedy this action may be, the applicant is permitted another two years before any responsive action can be compelled from him, and so the matter may be continued. There are applications now in the office which have been kept alive nine or ten years, and the office is powerless to compel speedier or earlier action on the part of the applicants.

"I have had occasion to direct an investigation to be made into this matter, and I submit as a part of this report the result reached by a committee on the subject, showing the number of applications in the office which have been so pending for a number of years (see Appendix B)."

The table constituting Appendix B shows that there were at the time of the report 7,745 applications pending in the Patent Office, that had been thus kept alive for more than two years; and of these 810 relate to the department of electricity.

That the evil resulting from allowing the date of the application instead of the grant to govern had been perceived as early as 1853 appears from Judge GRIER's dissenting opinion in *O'Reilly vs. Morse*, quoted on page 16 of appellant's brief. He says:

> "It is supposed that certain evils might arise by allowing an applicant for a patent here to delay its issue till he can obtain a foreign patent. To which it is a sufficient answer to say, that if such evil consequences should be found to exist, it is for Congress to remedy them by legislation."

Congress accordingly did thereafter remedy them by the Act of 1870.

Having regard, therefore, to the policy of securing the first patent for this country, as well as to prevent successive monopolies abroad and here to the same inventor, or his assigns, it became necessary to do more than merely require that the *application* should be first made here, and to require that the invention should be first *patented* here. No benefit is secured to the public, but rather the contrary, from the mere pendency of the application. Benefit to the public is only secured when the patent is *granted*, and if it were permitted to an inventor to file his application here, and then, abandoning for the time this country as his field of operation, obtain and enjoy a long monopoly abroad and thereafter a monopoly for seventeen years here, both an unreasonable privilege would be given to the inventor and the American public would be deprived of the full benefit of the invention. So far, therefore, as the law is intended to prevent the existence of a monopoly here which has ceased abroad, it is, also, necessary in order to make it effective that the limitation imposed by the foreign patent should be governed by the date of the American *patent*.

(2.) The statute under consideration applies equally to citizens and aliens, although the appellant's brief hazards the novel conjecture that it is to be limited to foreigners, based upon the idea that it is simply retaliatory legislation, or rather, as it is described in appellant's brief, reciprocal legislation, directed to the point of harmonizing our own with the laws of foreign countries. For the reasons already stated, this is but one of the objects of the statute, and one that applies to foreigners alone, but if it were the only object of the statute it could only be effectively secured by making the simultaneous expiration of the home and foreign patent depend upon the date not of the *application* but of the *grant* here.

If foreigners, by merely filing an application here and prolonging proceedings, could nevertheless obtain a full term patent without regard to the term of their foreign patent, they would enjoy privileges here not accorded to our own citizens in any other country, besides all the other mischiefs arising which have been already mentioned, as incident to such a condition of the law and detrimental to the interest of the American public.

Moreover as retaliatory, or even if the appellants prefer, reciprocal legislation, the statute should be measured by the restrictions imposed by the foreign laws with which it is supposed to harmonize. Taking the foreign country in most intimate relation with our own, England, the English Patent Law of 1852, in force at the date of the passage of our Act of 1870, and revision of 1874, provides as follows:

> " Where, upon any application made after the passage of this act letters patent are granted in the United Kingdom for or in respect of any invention first invented in any foreign country or by the subject of any foreign power or state, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any foreign country is there

obtained before the *grant* of such letters patent in the United Kingdom, all rights and privileges under such letters patent shall (notwithstanding any term in such letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such foreign country shall continue in force; or where more than one such patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges."

Coryton on Patents (Ed. 1855), p 449.

It will be noted that this statute makes the date of the *grant* of the English patent the controlling date as to the limitation imposed by the foreign patent. If, therefore, it was, as appellants contend, the sole object of the statutes, to make our own law conform to that of foreign countries in respect to the limiting effect of foreign patents on patents granted by our Government, it should naturally be so interpreted as to make it correspond in effect with the provisions of the law with which it was intended to harmonize, and that, in this instance, is the interpretation for which the respondents contend.

(3.) The views here urged as to the policy of the statutes under consideration, receive strong confirmation from the opinion of Mr. FISHER, who was Commissioner of Patents at the time the law of 1870 was enacted, and was in a position to know the actual intent of those who framed and passed the act. Soon after its passage, he had occasion in *ex parte* Boyer, to expound Section 25 of the Act of 1870, and uses this language:

"*It is reasonable to suppose that the inventor will follow up*

> *his earliest patent with the greatest vigor ;* and that, other things being equal, he will protect his invention first in that country where he expects to make the most use of it. If, therefore, the American inventor chooses to exhibit this preference for a foreign country, and to give them the first information respecting his invention, and the earliest opportunity of using it, the law makes no distinction between him and the foreign inventor who obtained his first patent at home."
>
> *Ex parte* Boyer, Commissioners' Decisions, 1870, p. 131.

This statement from such a source is contemporaneous testimony as to the intent of the act, that is entitled to especial consideration.

The same idea as to the general policy of our law was expressed by Commissioner LEGGETT. He says :

> " The law proceeds altogether upon the ground that the inventor confers a benefit on the public here, and it specially encourages and protects him for that reason. A foreign inventor, whether a citizen of the United States or not is immaterial, can only benefit the public here by publishing his invention here."
>
> Tucker vs. Davis, 2 Off. Gaz., 224,

And Commissioner MARBLE, almost following the language of Commissioner FISHER, says :

> " There is no reason why American inventors who choose to obtain patents abroad before doing so in their own country should be placed upon a different platform than foreigners. If they exhibit this preference for foreign countries and give them the first information respecting their inventions, and the first opportunity of using them, the law makes no distinction in

their favor as against an inventor who makes his first efforts at home."

Bell vs. Brooks, 19 Off. Gaz., 290.

Respondents, therefore, submit that the *policy* and *intention* of the law, if it be allowable in this case to resort to prior legislation, or other extrinsic evidence of legislative intent, can only be fulfilled by following the literal and natural interpretation which is here insisted upon.

(4.) Appellant's brief (pp. 17 to 21) asserts that the contemporaneous construction of the profession and of the Patent Office as to the meaning of Section 25 of the Act of 1870, and Section 4887 of the Revised Statutes, was in accordance with the dissenting opinion of Mr. Justice GRIER in *O'Reilly vs. Morse* as to the meaning of the prior acts of 1836 and 1839, and was to the effect that the statutes first named applied only to inventions patented abroad before the date of *application* here.

The fact is just the contrary. The contemporaneous construction was in accordance with the interpretation for which respondents contend, and, with a single exception, which was promptly overruled, has been the uniform construction adopted by the Patent Office and the Courts from 1870 to the present time.

The dissenting opinion of Mr. Justice GRIER as to the Acts of 1836 and 1839, does not seem to be relevant to the question, nor is it perceived how it can furnish any rule of construction for the subsequent statutes of 1870 and the revision of 1874, and need not, therefore, be here discussed.

The substance of appellant's argument in support of their erroneous statement seems to be as follows :

That certain rules of the Patent Office require the applicant, when he makes his application, to disclose whether he has yet obtained a foreign patent, but do not require him to disclose whether he will or may receive one before the grant of his patent ; that Mr. Commissioner Payne, in response to a request from a primary examiner for instructions, decided in 1880 that the statute did not apply where the foreign patent was granted subsequent to the home application ; and then, ignoring the fact that this decision was in direct conflict with the earlier recorded decision of the office, and was overruled by the United States Circuit Court in two years by a decision uniformly followed by every Circuit Court in which the question has since arisen, appellant proceeds to draw the conclusion that these "authorities"—viz., the rules of the Patent Office, the case of *Koechlin vs. Marble* (2 Mac., Dist. Col. Rep., 12), which does not touch the point at issue, and the overruled opinion of Mr. Commissioner Payne—" seem to show affirmatively that the actions of those learned in the law, to wit, those in charge of the Patent Office * * * and those who were practicing under its provisions * * * did, as matter of fact, interpret Section 4887 of the Revised Statutes as having no reference to an American inventor after he had filed his application for a patent," and that "if such was the official and practical interpretation put upon the act for twelve years by those to whom it was addressed * * * then such practical interpretation may be considered as controlling by the Courts."

To this respondents reply :

(*a*.) The rules of the Patent Office prove nothing. They merely require the applicant to state whether any foreign patent was in existence when his application was filed, because that was a reason for more speedy action. Such applications were privileged as to the order of examination.

> See Patent Office Rule 29, page 9 of "Rules of Practice, etc., Ed. of 1877; Rule 63, page 20, Ed. of 1888."

It was unnecessary to require the applicant to state what foreign patent might be issued to him before the grant, because it was a fact the applicant might well be unable to predict, and there was no need on the part of the office to take notice of foreign patents which might be issued after the application, because they limit the patent as a matter of law, it having been decided ever since *O'Reilly vs. Morse*, in 1853, that the limitation need not be expressed on the face of the American patent.

> O'Reilly vs. Morse, 15 How., 62.
> Canan vs. Pound Mfg. Co., 23 Fed. Rep., 185.
> Am. Paper Barrel Co. vs. Laraway, 28 Fed. Rep., 141.

The words italicised at the end of form 26 (p. 17, of appellant's brief) giving the form of oath applicable alike to the case where there is not and where there is a foreign patent, have no reference to the existence of a foreign patent at all, but to the provision of law that in no case can a patent issue where there has been more than two years' use prior to the application.

As to the case of *U. S. ex rel. Koechlin vs. Marble* (2 Mac., 12), the opinion has nothing to do with the interpretation of the statute in respect to whether it refers to the date of *grant* or date of *application.* It simply decided that the patent rules were reasonable and must be obeyed as against parties who insisted that the limitation imposed by the existence of a prior foreign patent had been repealed by the provision that all patents should run for seventeen years.

(*b.*) As to the actual contemporaneous construction of the act, it was given by Mr. Commissioner FISHER in 1870, the very year of its passage, and remained the authoritative and public declaration of the office for ten years, until it was temporarily changed by Mr. Commissioner PAYNE in *ex parte* Mann, already referred to. In October, 1870, immediately after the passage of the act, Mr. Commissioner FISHER, in *ex parte Smith and Skinner*, ruled that Section 25 of the Act of 1870 was not confined to patents issued on applications subsequent to the dates of the foreign patents. He says :

> " In the cases of Ward and Boyer I held that the grant of a
> " foreign patent before the issue of an American patent was
> " fatal to the application for the extension of the American
> " patent, if the foreign patent expired before the original term
> " of the patent sought to be extended. IT IS IMMATERIAL
> " WHETHER THE AMERICAN PATENT WAS APPLIED FOR BEFORE THE
> " FOREIGN PATENT OR NOT. THIS WAS IMPORTANT UNDER THE
> " FIRST LAWS, BUT NO SUCH DISTINCTION EXISTS UNDER THE ACT
> " OF 1870."
>
> Commissioners' Decisions, 1870, p. 131.

This was the true contemporaneous construction of the Act of 1870, promulgated by the head of the Patent Office, in pursuance of his official duty, and binding upon all practising in the office until overruled. If there had been any departure from the construction thus adopted in any subsequent rulings of the office or its practice down to the contrary opinion of Mr. Commissioner PAYNE in 1880, why did not the latter refer to such rulings or practice in his opinion ? In fact, Mr. PAYNE attempted to inaugurate a new practice and was shortly overruled by the Courts, and since 1882 the decision of Judge NIXON in *Bate Co. vs. Gillett* (13 Fed. Rep., 553) has been uniformly followed and upheld in every case in which it has been questioned, *viz.*:

By Justice **Blatchford** in *Gramme Co. vs. Arnoux Co.*, 21 Blatch., 450.

By Justice **Bradley**, in *Bate Co. vs. Gillett*, 31 Fed. Rep., 809, and

By Judge **Colt** in the case at bar.

We concur in the applicability of the cases cited on pp. 20, 21 of appellant's brief, to the effect that long established construction of a statute and cotemporary exposition is entitled to great weight ; but, directly contrary to appellant's assumption, that principle, upon the facts in this case, furnishes a strong argument in favor of the construction for which the respondents contend. It appears that, except for the brief period of two years from 1880 to 1882, the promulgated decision of the Patent Office and the rulings of the Courts have been in favor of respondent's construction from the passage of the Act of 1870 down to the present time.

Appellants urge the rule expressed in *Rutherford vs. Green* (2 Wheat., 203), that, "Whatever the legislative power may be, its acts ought never to be so construed as to subvert the rights of property, unless its intention so to do shall be expressed in such terms as to admit of no doubt and to show a clear design to effect the object."

We invoke that rule. Appellants assume that to give the construction for which the respondents contend would work a hardship upon those who have taken out foreign patents subsequent to their American applications under the mistaken belief that such patents, if issued prior to the American grant, would not abridge the term of their home patents. If any such there be, their error is due to the mistake or negligence of themselves or their solicitors, and may or may not be a reason for legislative relief, but has not been justified by a long continued, generally accepted, or authoritative construction of the law, or by the language of the statute itself. The appellants cannot appeal, in this case, to any principle of vested rights, for when Bate applied for his American patent in 1876 (Appellant's Brief, p. 3), the only published construction of the law was that contained in Mr. Commissioner Fisher's decisions in *ex parte Smith and Skinner* in the volume of Commissioners' Decisions for 1870, with which every competent patent solicitor should have been familiar.

On the other hand, during the period that has elapsed since the Act of 1870 and the Revised Statutes in 1874, the decisions of the Courts have induced hundreds to embark capital and conduct business enterprises upon the faith of the correctness of those adjudications and the plain language of the act. Millions of dollars of capital are represented by parties interested in the result of this appeal, which must be impaired by costly litigation if the meaning of the law shall be wrested from the interpretation it has hitherto received, and, in such an event, the rights of property of those throughout the country whose capital has been invested upon the faith that patents have expired under the operation of the law, will be depreciated, or wholly lost, to an extent difficult to calculate, but enormous in amount.

In the face of such consequences the Court, in accordance with the salutary rule above invoked, may well hesitate to depart from the plain rule of literal interpretation and to overthrow a construction which, with the unimportant interruption above noticed, has universally prevailed, and upon which the public has had a right to rely.

SECOND.

Section 4887 applies to all inventors, whether citizens or aliens.

Appellant's brief (pp. 22 to 25) seeks to maintain the proposition that the section only applies to aliens who have already obtained patents in foreign countries, and not to our own citizens who may have patented their inventions abroad before obtaining a patent here.

The plain answer to this unfounded assumption is that the statute makes no such distinction, and its language is so unqualified and comprehensive that no such distinction can be interpolated by judicial construction.

Appellant's argument upon the point may be summarized as follows :

The original intent of Congress as shown by the Act of 1836, was "to legislate of and concerning foreigners who had previously taken out patents abroad, and had then come to this country and asked for a patent for the same invention," *i. e.*, the said legislation applied to foreigners only and not to our own citizens; that between 1836 and 1870 all foreign countries adopted legislation with reference to patents to foreigners, whereby in England and elsewhere foreigners who had previously taken out letters patent in their own country could obtain patents in those countries, limited, however, so as to expire at the same time with the inventor's home patent ; that with this foreign legislation before them it was the intention of Congress, by Section 25 of the Act of 1870, "to make just such a provision touching foreign inventors and foreign patents as had been made by other nationalities;" that "all the laws were thus complete and harmonious in their provisions;" that "each country in succession was legislating of and concerning foreign patentees and not of and concerning its own inventors," and, therefore, that the Act of 1870, and Sec. 4887 of the Revised Statutes, relate only to foreigners and not to our own citizens.

This argument is inaccurate in point of fact, and a *non sequitur* in point of reasoning.

FIRST. As to the Act of 1836, the statement that its provisions in respect to the limitation imposed by a prior foreign patent, applied only to foreigners is without foundation. As was stated by Judge WALLACE, in *Edison Co. vs. U. S. Co.* (35 Fed. Rep., 134), "since the "Act of July 4, 1836, which repealed all former patent laws and "established a comprehensive code covering the whole subject, our "laws have not made any distinction between our own citizens and "foreigners in respect to the privilege of obtaining patents or the "conditions and restrictions of the privilege granted, except as to "the amount of the fee to be paid and the protection of inventions "by caveat."

The assertion (Appellant's Brief, p. 22), that it is "clear" that Congress, in the Act of 1836, intended to legislate of and concerning foreigners alone—from the following language, *viz.*: "Nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of *his* having previously taken letters patent therefor in a foreign country"—is scarcely worthy of serious reply. If the foreign patent had been obtained by an American inventor, could it be said that it was not a patent for "his" invention? Is it intended to assert that the possessive pronoun does not apply as well when the foreign patentee is an American citizen, native or naturalized, as when the patentee is a foreign citizen?

SECOND. As has been already stated, so far as the Act of 1870 affected foreigners patenting their inventions here, it may well have been, in part, retaliatory legislation, designed, among other things, to impose upon foreigners similar restrictions in obtaining a patent here, to those which foreign laws imposed upon our own citizens seeking a patent in foreign countries; but it does not follow from this that our statute was not also intended to meet the case of our own citizens who might obtain patents abroad before patenting here. The language of the act shows that it was so intended, and it makes no distinction between citizens and aliens; and the reasons for the act, which have been already stated, apply with equal force whether the previous foreign patent has been granted to a foreigner or to one of our own citizens. There is, if anything, less reason why an American citizen who first gives a foreign nation the benefit of his invention should thereafter be able to obtain a full term patent here than for refusing a full term patent under like circumstances to a foreigner.

If the foreign legislation is at all material to the point, which is not perceived, it may be noted that the laws of many foreign countries passed prior to 1870 apply as well to the case of one of their own citizens who may obtain a patent abroad as to foreigners.

Such is the case in England, in France, and other countries.

Carpmael's Patent Laws of the World, pp. 199, 107, 288, 455.

The foregoing are, in brief, the only reasons suggested by the appellants for departing from the plain language of the act under consideration and confining its operation to American citizens.

That they are inadequate to justify such a course, even were the case one to admit, under any circumstances, of such a qualification of the language used, is too plain for argument. So far as reports show, the point was never suggested, since the Act of 1836 was passed down to the present time, until it was raised, by counsel who now represent appellant, in some of the late cases in the Circuit Courts, and whenever raised it has been disregarded or overruled. It was raised before his Honor Mr. Justice BRADLEY in *Bate Co. vs. Gillett*, but not referred to in the opinion of the Court, and also in the case of the *Edison Co. vs. U. S. Co.* (35 Fed. Rep., 134), before Judge WALLACE, who dismissed it as not "of any importance" and "immaterial." Further discussion of the question seems unnecessary.

THIRD.

The provision of Section 4887 that the United States patent "shall be so limited as to expire at the same time with the foreign patent, or if there be more than one, at the same time with the one having the shortest term," means that it shall expire at the end of the current term of the foreign patent in existence at the date of the American grant, without regard to any subsequent extension or curtailment of that term depending upon an uncertain event.

Any other construction would produce most injurious uncertainty. If the expiration of the American patent depended upon the actual future expiration of the foreign patent, then whenever the latter was in the usual form, capable of extension or liable to forfeiture, no one could tell when the American patent would expire; and this would operate to the detriment alike of the inventor's privilege here and the interest of the American public, who are entitled to know when an invention is to become free.

The construction, therefore, uniformly adopted by the courts has been that first stated.

The question first came up before Mr. Justice CLIFFORD in the case of *Henry vs. Providence Tool Co.* (3 Bann. & Ard., 501 ; 14 O. G., 855), who, in deciding that the limitation of the American patent depended upon the current term of the foreign patent, without regard to any prolongation of the latter which the patentee might procure from the foreign government, states the reason for adopting this construction, as follows:

> "What is the true construction of the Act of Congress under which the patent in suit was granted? When granted, the foreign patent was still in full force, and would not expire for the period of three years; nor could any one foreknow whether a petition for prolongation would ever be seasonably presented; or, if presented, whether any prolongation would ever be granted. Congress employs the words 'the foreign' patent, evidently referring to the term of the foreign patent to define the term of the domestic patent. Had Congress intended to grant a patent for an indefinite term, or for an uncertain and undefined duration, they would have employed suitable words to express such an intent. Our Patent Act requires every patentee, before he shall receive a patent, to file in the Patent Office a written description of his invention, and of the manner and process of making and using it, in such full, clear and exact terms as to enable any person skilled in the art to make and use the same.
>
> "Requirements of the kind are enacted for several important purposes:
>
> "I. That the Government may know what they have granted, and what will become public property when the term of the monopoly expires.

"II. That licensed persons, desiring to practice the invention, may know during the term how to make, construct and use the invention.

"III. That other inventors may know what part of the field of invention is unoccupied (*Gill vs. Wells*, 22 Wall., 27).

"Adopt the theory of the complainant and none of those requirements would be of any avail, as none could foreknow whether the term of the patent was for three or seven years, or for some intermediate term of duration ; the effect of which would be to make the rights of property in this country depend upon the discretion exercised by a foreign sovereign. Support to that view is derived from the words of the section, which refer not only to the foreign patent, but, if there be more than one, to the one having the shortest term, which, in effect excludes the theory that the provision in any view can be held to include any subsequent prolongation or extension of the monopoly beyond what was then vested in the foreign patentee. If Congress had intended otherwise the language would have been different, and words would have been employed to signify that the domestic patent should continue as long as the same invention was protected by the foreign government."

The doctrine of *Henry vs. Providence Tool Co.*, was adopted and follwed by Judge Nixon in *Bate vs. Gillett*, 13 Fed. Rep., 553 ; by Mr. Justice Blatchford in *Reissner vs. Sharp*, 16 Blatch., 383, and in *Gramme Co. vs. Arnoux Co.*, 21 Blatch. 450 ; by Judge Colt in the case at bar ; and by Mr. Justice Bradley in *Bate Co. vs. Gillett*, (31 Fed. Rep., 801.)

In considering the word "term" as applied to the foreign patent, the Courts seem, in the decisions cited and others, to have practically interpreted it to mean the grant of the monopoly by the foreign government for a fixed period, which, in the absence of any default upon the part of the grantee, will not be abridged, and which cannot be prolonged without a renewed operation of the granting power.

It makes no difference whether this renewed operation of the granting power be a matter of grace, or procurable as a matter of right, or whether it is evidenced by a fresh grant or by a mere executive act, like the endorsement of an extension upon the original grant. Looking to certainty as the great object in view, the Courts only regard the period at which the current term *must* expire, considering any prolongation dependent upon an *uncertain event* as belonging to a *different* term from the first.

In like manner any forfeiture of an unexpired residue of the term by reason of the failure of the patentee to maintain future payments to the Goverment, is disregarded, as such failures are uncertain events, and the policy and meaning of the act require that regard should be had to the term of the foreign patent *as it exists at the date of the American grant*, which " term " is the fixed period for which the foreign patent will continue without any further operation or exercise of the granting power.

Paillard vs. Bruno, 29 Fed. Rep., 864.

Holmes Co. vs. Metropolitan Co., 21 Fed. Rep, 458.

The meaning of the word " term " thus adopted is in accordance with its legal as well as popular signification in analogous cases.

A lease for five years with a privilege of renewal for a further term of two years would be, during the continuance of the first term, regarded as and called a lease for a term of five years, and it would not be deemed otherwise because it contained a clause of forfeiture and re-entry in case of non-payment of rent.

In appellant's brief (pp. 32, 33, 34) the correctness of this rule is disputed. They state their position to be that " if it had been " necessary for Bate's American patent to have expressed the precise

" state of things in Canada, it would have said that it should expire " at the end of five, ten or fifteen years, as Mr. Bate, in his absolute " right, might determine," (pp. 32, 33) ; or, taking an alternative position that " if it be said a somewhat definite term" (without however pointing out the distinction between a term that is " somewhat definite" and one that is simply " definite") " is intended to be " ascertained at the very moment of issuing a patent, then the term " should in favor of a patent be construed to be fifteen years, with a " defeasance in the power to enforce the patent privilege in case of " non-payment of the fees, rather than a term of five years" (p. 33). No reason is given for this departure from the decisions of the lower Courts. The construction contended for by appellant is merely asserted, not supported by argument.

As far as the first position is concerned, the answer is that such a construction would produce the intolerable uncertainty to avoid which, as already shown, was the reason for adopting the received construction ; and as far as the alternative position is concerned, the answer is that the Bate Canadian patent was not a patent for fifteen years liable to defeasance, but for a term of five years with the privilege of renewal.

The distinction is that the diminution of the term in the first instance does not require any further operation of the granting power ; while its prolongation in the second instance does.

This further operation of the granting power was, in this case, exercised with as much formality as in making the first grant. The original patent " grants to the said John Jones Bate, his executors, administrators and assigns, *for the period of five years* from the date of these presents, the exclusive right" etc., of exercising his invention, (Record p. 21). Prior to the expiration of the five years and in December, 1881, the Canadian government by a new instrument of grant, after reciting that " a patent bearing date," etc., " was granted to John Jones Bate," etc., "for a period of five years from the date of said patent," etc., proceeds:

"*The present patent* grants to the said John Jones Bate, his "executors, administrators and his assigns, for *another period* of five "years to commence and be computed on and from the ninth day of "January," 1882, the exclusive privlege, &c., (Rec. p. 30).

Whether this further operation of the granting power was a special government favor, or a privilege obtainable by all patentees alike, on the payment of certain fees, is wholly immaterial. To say that the second grant was not, in its very language, for "another period," *i. e.*, "term," than the first grant, or that the original grant, because of the law allowing renewals, was a fifteen-year grant, with a defeasance, is a mere misuse of language which carries its refutation upon its face.

The appellants seek shelter from this result behind the Canadian Amendatory Act of 1883 (Rec., p. 63), which they affirm declared that the true meaning of the pre-existing law, under which the said successive grants had been made to Bate, was that the first grant was for fifteen years, with a defeasance, and that this declaration of the Canadian Parliament is absolutely binding upon this Court.

To this we reply:

FOURTH.

The Canadian Legislation subsequent to the grant of Bate's Canadian and also of his United States patent had no effect upon the latter patent, and could not change the date of its expiration.

The Canadian Act of 1883 (Record pp. 63 and 64), either changed the existing law, or it did not.

If it did modify it, then, whether retroactive in its effect or not, it could not affect the American patent, the term of the expiration of which was fixed by the term of the Canadian patent *as it stood when the American patent was granted.*

Says Mr. Justice BRADLEY in *Bate Co. vs. Gillett,* (13 Fed. Rep., p. 809) :

> " I may say at once that I attach no importance to the last mentioned act (Canadian Act of 1883). The American patent received its operative force and effect on the day it was issued, and no subsequent legislation in Canada or elsewhere could change it, whatever might be the effect of such legislation where made. The force and effect of the American patent could only be affected by the Canadian patent as the latter stood when granted ; and not as it was afterwards modified by legislation ". (p. 813).

If, on the other hand, the Canadian act did *not* change the law as it stood, then the " term " of the Canadian patent, in the sense in which that word is used in our statute, expired five years from the date of the first issue of that patent, any mere declaration of the Canadian Parliament, as to the name by which such a patent shall be known, to the contrary notwithstanding.

The question in the latter case is not what the Canadian statute means, but what the United States statute means.

The United States statute applies the word " term " to that fixed period, current at the date of the American patent, for which the foreign monopoly has been granted, and which cannot be prolonged without the further operation of the granting power, which further operation depends upon an uncertain event and may never happen. That, we have already seen, was the case with the Bate patent. The inventor received a specific grant for five years. He then petitioned and received a second specific grant for five years more.

The American patent was issued during the first grant, and the term of that grant, *viz.*, five years, was the "term" of the Canadian patent within the meaning of our statute, without any regard to the fact that the Canadian law gave the patentee the option of obtaining the second grant upon the fulfilment of certain conditions.

The Canada Parliament, subsequent to the grant of the American patent and after its duration was fixed, passed the Act of 1883, whereby it was enacted that " every patent heretofore issued, in respect of which the fee for the whole or for any unexpired portion of the term of fifteen years has been duly paid * * * *has been* and shall be deemed to have been issued for the term of fifteen years " (Record, pp. 63, 64). Now, if this did not alter the substance of the existing law, then it was merely a change of nomenclature—a declaration that, in Canada, certain prior patents, of which the Bate patent was one, which had been originally granted for a term of five years and afterwards, by a further operation of the granting power, extended for ten years, should be there denominated patents issued for the term of fifteen years.

Such a change of appellation could not affect the meaning of the American statute any more than American customs laws imposing a duty upon a particular article by its usual trade name could be evaded by a foreign statute changing that trade name within the foreign dominions.

A fair interpretation of the Canada statute, however, shows that it is not declaratory but amendatory. It ordains that all patents thereafter granted shall be for the term of fifteen years, with a defeasance in case of non-payment of the former extension fees. Obedience to this act would require the Canadian Commissioner of Patents to express the term upon the face of every patent as fifteen years, whether or not the fee to keep up the life of the patent for the whole term of fifteen years was paid at the time of the grant, and no further operation of the granting power would occur, although the patent would cease by act of the law if the remaining installments of fees were not paid. This altered the law as it had previously existed, whereby, as already seen, patents were granted for such a term as the patentee chose to pay for, and were so limited on their face; and a new grant was made if the patentee exercised his option of obtaining an extension. As to these patents, the Act is retroactive. It declares that they " have been and shall be deemed to have been " fifteen-year patents. That is, the expression is tautological; " have been " can only mean shall be " deemed to have been," for no legislation can alter a past fact, it can only affect the light in which it shall be in future regarded. To this end, the Act provides that prior patents, on which the fees have been paid for the full fifteen years, shall be deemed to have been issued for fifteen years, " to cease on the same conditions on which patents hereafter issued are to cease." That is, in effect, the term for which prior patents had been granted was altered so as to conform to the term of patents thereafter granted.

This seems the soundest construction of the statute, and relieves it of the reproach, which would otherwise attach to it, of being an obvious and intrusive attempt on the part of a foreign legislature to usurp the functions of the United States Congress, and extend, by changing the mere names of things, certain American patents which had expired under the operation of our own laws.

The patent in suit, therefore (if on the record the Court shall find that the invention was " patented " in Canada prior to the date of the American patent), expired at the end of the term of the Canadian patent current at the date of the grant of the said American patent, *viz.:* on January 9th, 1882.

Conclusion.

The conclusion of appellants' brief, pp. 26 and following, contains a number of statements intended to enforce the general proposition, that it was the intention of the Statute under consideration, as derived from the whole policy of our patent laws, to make the date of *application* the pivotal date upon which the vesting of the inventor's rights depends, and to point out the supposed hardships which may happen to American inventors or their innocent assignees, if American patents are limited by foreign patents issued before the *grant* in this country.

As to these assumed hardships, it is a sufficient answer to say that the law fixing the date of *grant* as the controlling date has now been in operation for nearly twenty years without producing any of the hardships mentioned. Further than that, the hardships mentioned do not depend upon this change of date, and were just as liable to occur when foreign patents which were issued before the American *application* limited the American patent as they are when those obtained before its *grant* so limit it.

Counsel say, for example, that "if, after the domestic inventor had filed his application, a person knowing of the invention should fraudulently obtain a patent in his own name abroad, and before the American patent was issued, the American patent would be limited to the life of such foreign patent," and then assert that "it could scarcely be contended that this is the law."

The simple answer to this is, that if, *before* the domestic inventor had filed his application, a person knowing of the invention should fraudulently obtain a patent in his own name abroad, the American patent would, in like manner, be limited to the life of such foreign patent, and, moreover, that this is just as liable to happen as the former supposition ; and yet appellants themselves admit that this is the law.

So, too, it is alleged that an American inventor, *after* having filed an American application, might assign his right to the patent, and then cheat his assignee by taking out a foreign patent for a short term before his assignee had actually obtained his American patent. But he might also cheat or injure an American assignee by getting out a foreign patent *before* his assignee had perfected and filed his application. So, any dishonest patentee may cheat his assignee by selling the same patent a second time before the first assignment is recorded. So, any dishonest person may commit a fraud under the statutes for the conveyance of land. The Statute of Frauds and the Statute of Limitations afford similar apportunities for dishonesty. The law seeks to repress such evils by direct penal statutes, or by personal remedies against the wrongdoer. It would be hopeless to frame them so that a rogue might not take advantage of them to do a wrong; and, in the case of patents for inventions, the opportunity is as great where the date of *application* determines the fact of limitation by a foreign patent as where it is determined by the date of the *grant.*

As to appellant's arguments concerning the supposed policy of the law and the alleged vested rights obtained by filing an application, they have already been answered, so far as they have seemed material, in the preceding parts of this brief.

So far as relates to the vested rights acquired by filing an application, those rights do not relate to or affect the *duration* of the patent to be issued on such application, or make the interest of the inventor superior to that of the public. As between a domestic and a foreign patent the public has no interest as to which shall be *applied* for first; it has a very vital interest as to whether an invention shall be first *patented* here or abroad.

The neglect of this consideration, and the assumption that the inventor's interest and not that of the public is the primary object of our patent system, is the fallacy which underlies the appellant's whole reasoning upon this point.

For the reasons above set forth the subscribing parties respectfully submit that the statute under consideration—

(1) Applies to American patents for inventions patented abroad before the *grant* of the patent here, and not merely to American patents for inventions patented abroad before the date of the *application* here; and

(2) Applies whether the patentee be an American citizen or a foreigner; and

(3) Limits the term of the American patent by the current term of the foreign patent existing at the time of the American grant, without regard to any subsequent prolongation dependent upon an uncertain event.

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Saml. A. Duncan,
Leonard E. Curtis,
Of Counsel for the U. S. Electric Lighting Co.
Wm. Bakewell,
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Chauncey Smith,
Thomas L. Livermore,
Frederick P. Fish,
Of Counsel for the Thomson-Houston Electric Co.
R. S. Taylor,
Of Counsel for the Fort Wayne Electric Light Co.

Brief of R. S. Taylor on behalf of the Fort Wayne Electric Light Co.

I join in the foregoing brief, adding the following observations:

The Circuit Courts have followed the plain reading of the law. There are no ambiguous words in it. There is no reason that can be urged for enlarging or for restraining the literal import of its terms except the arguments of hardship. And these arguments are as various as the alleged hardships. One patentee asks that the filing of his application shall be taken as the date of his patent, for the purpose of the statute, because that construction will relieve him. Another that the act shall be taken as applicable only to foreign inventors, because he is a citizen. And another that a patent taken out abroad by the assignor or assignee of the invention ought not to be counted, because no other construction will help him. These suggestions all seem about equally reasonable. If the Court were at liberty to reissue the statute, perhaps they would all be incorporated, with more of the same sort. Certainly the Court would not deal differently with different patentees having equal equities.

Before adopting any construction to relieve hardship in one direction, the Court will feel bound to be sure that it will not by that course inflict equal hardship in another direction. It is familiar doctrine that a decision or line of decisions which has become a rule of property will not be changed although it is found to have been unwisely adopted. Much more should it be that a statute which has become a rule of property when taken in its literal and primary sense, ought not to be given a new meaning by construction which would overturn titles acquired on the faith of its previously accepted interpretation.

In this case both these principles apply. And they apply with more than ordinary force. A patent is a contract to which the patentee is party on one side, and the public on the other. The law under which the patent has been granted is part of the contract. To engraft a new meaning upon the law is to introduce a new term into the contract.

Acting upon the plain letter of the statute as it reads, and as it has been expounded by the circuit courts, people have invested in electric lighting apparatus which is worthless to them if certain patents owned by the Edison Electric Light Company (at whose instance, it is understood, the present cause has been advanced on the docket) cover it. The construction of the law here contended for by counsel for the appellant and the Edison Company would make all those people trespassers *ex post facto*. It would put it in the power of said company to bring ten thousand suits in chancery against men innocent of any intended wrong.

If there is any hardship in the statute it is within the power of Congress alone to remedy it without doing new and greater wrong. By legislation a law can be changed with saving of existing equities. But judicial interpretation necessarily relates back to the enactment of the statute.

Finally, I submit that there is no hardship in the case, and that the law as it reads, and as it has been applied by the circuit courts, stands on solid grounds of justice and reason. A patent statute does not rest, like most other statutes, on some recognized prior right. It creates the right. The patentee pays a consideration for his patent in the description of his invention which he is required to place on file. The theory of the law is that the invention is valuable to the public. The sooner the patent issues, the sooner the patentee's monopoly begins to run, and the sooner the invention will fall into the general stock. Besides this, the information furnished by the patent is of itself valuable to the community. It enlarges the field of human knowledge; it stimulates others to exertion; it may point the way to further invention by others which the patentee never would have reached. On all these accounts there is real gain to the public in the prompt issue of useful patents.

It is for this that the law requires an inventor to take out his patent here before it gives him permission to patent it in other countries without affecting his rights here. It makes our own citizens the preferred recipients of the benefits of the invention, as it makes the government the preferred creditor of a bankrupt.

That there is some good in this is palpable. To say how much is the province of Congress.

R. S. TAYLOR.

Supreme Court of the United States.

BATE REFRIGERATING COMPANY, APPELLANT,

v.

GEORGE H. HAMMOND & COMPANY, APPELLEE.

*Supplementary Brief as to the Construction of Section
4887 of Revised Statutes, filed by leave of Court
on behalf of the United States Electric Lighting Company, the Westinghouse Electric
Company, the Thomson-Houston
Electric Company, and the
Fort Wayne Electric
Light Company.*

Supreme Court of the United States.

BATE REFRIGERATING COMPANY, APPELLANT,

v.

GEORGE H. HAMMOND & COMPANY, APPELLEE.

Supplementary Brief as to the construction of Section 4887 of Revised Statutes, filed by leave of Court on behalf of the United States Electric Lighting Company of New York, the Westinghouse Electric Company of Pennsylvania, the Thomson–Houston Electric Company of Connecticut, and the Fort Wayne Electric Light Company of Indiana.

On behalf of all the above-named parties I desire to submit some considerations which I did not have an opportunity to lay before the respective counsel of the parties in time to be incorporated into the brief which they have filed, and which I fully indorse.

Section 4884, of the Revised Statutes of the United States, declares what every patent shall contain, one of which things is a grant for the term of seventeen years of the exclusive right to make and use and sell the invention.

Section 4886 declares who may obtain a patent, and the conditions of obtaining it.

Any person may obtain a patent if the prescribed conditions exist. No distinction is made between citizens or inhabitants of this country and citizens or inhabitants of other countries.

One of the conditions which must exist is, that the invention for which an application for a patent is made must not have been in public use in this country for more than two years prior to the application.

Section 4887 has two clauses — the first of which declares that the existence of a foreign patent for an applicant's invention shall not debar him from receiving a patent under the act, if the invention has not been introduced into public use in the United States for more than two years prior to the application.

In other words, the conditions which entitle an inventor to obtain in this country a patent for an invention which he has patented abroad are precisely the same as if he had not obtained a patent abroad.

The second clause of the section declares for what *term* an inventor may obtain a patent for an invention which he has previously patented in a foreign country. It declares, for that special case, to what *term* the patent granted shall be limited, in the same manner as Section 4884 does as to patents generally. It contains no reference whatever, as the first clause does, and as Section 4886 does, to the condition, as to public use for two years, upon which the right to obtain a patent depends. It fixes, especially, the *term* for which a patent may be granted, for " every patent for an invention which has been previously patented in a foreign country," and does nothing more.

Every patent, it says, granted for an invention which has been patented abroad, instead of containing, as provided in Section 4884, a grant for the term of seventeen years, " shall be so limited as to expire with the foreign patent, or if there be more than one at the same time, with the one having the shortest term."

It is perfectly certain that the language which we are considering of Section 4887 was intended to limit the terms of some patents to terms less than seventeen years, as provided in Section 4884, and the language, and the only language, by which to determine what patents are to have their terms so limited, is "an invention which has been previously patented in a foreign country." But it is contended by the appellants that not "every patent granted for an invention which has been previously granted in a foreign country" shall be so limited as to expire at the same time with the foreign patent, but *only* those granted for inventions which had been patented in a foreign country previously to the application here. But if those words "previously to the application" are to be interpolated into the section in the face of the explicit language of the clause, it must, at the least, be shown that some object disclosed by the statute is to be secured in cases where inventions had been patented in foreign countries previously to the application in this country, which would not also be secured in cases where the inventions were patented in foreign countries after the applications were made here. It must be shown, in order to justify the limitation of the statute to the class of cases proposed, that the object to be secured by the operation of the statute is limited to that class. And, inasmuch as the limitation of the terms of patents is certainly not for the interest of the patentees themselves, it must be shown that some interest of the public was contemplated by Congress which would be promoted in one case, and not in the other. No such object is pointed out in the statute, and it is impossible to suggest any reason in the interest of the public for the limitation of the term of a patent granted for an invention which has been patented in a foreign country, during any period anterior to the grant here, which does not equally require the limitation to the patenting of the invention at any time during the whole period; to the period between the application and the grant, as well as to the period anterior to the application.

When the necessary operation of the provision of the statute is to limit the privileges of an inventor and enlarge those of the public, the true rule to govern its application is to secure to both the inventor and the public the results contemplated in all cases which come within the terms employed to define its scope, and the statute should not receive a construction which will diminish the privileges of the public and increase those of the inventor. It is safe to say, that if the operation of the provision in question did operate to the benefit of inventors, the appellants of this case would not be contending that it should be restricted to cases where foreign patents were obtained before the application here.

It is suggested that the interests of the applicant may be adversely affected by delays in the Patent Office for which he may not be responsible. The answer is that the limitation, be it greater or less, is not imposed by the statute for his interest, but for the interest of the public; that he takes upon himself the risk in consideration of what he hopes to gain from his foreign patents. If he will forego that gain he can have his patent here for the full term of seventeen years. It is at his own option to take patents in this and in other countries for a period less than seventeen years, instead of taking one in this country alone for the full period of seventeen years, or instead of waiting till after the patent is granted here before patenting abroad.

When an inventor patents his invention in one country he makes it patent to the world, and discloses the knowledge of it to the people of other countries, who may thereupon practise and use the invention at will, unless prevented by patents in their respective countries; and it may well be that Congress considered it to be both expedient for the people of this country, and not unjust to an inventor, to provide that when it armed him with the power to restrain the people of this country from using the knowledge which had become accessible to them through a patent to him in a foreign country, the restraint should continue no longer than it would in the foreign country.

After an invention has been patented in a foreign country the people of this country no longer stand in the same relation to it as they did while the inventor kept the knowledge of it to himself. In the latter case it is beyond the reach of the public, and to induce the inventor to give the public the benefit of his invention, the law offers him the reward of seventeen years' exclusive use. In the former case the invention is within the reach of the people, and the consideration which the inventor can give for a patent here is very much less than that which he gives when it lies wholly within his own knowledge and control. It can make no difference to the people of this country, at the time a patent is to be granted, whether a knowledge of the invention has been accessible to it for a longer or a shorter time, whether it became accessible before the application or afterwards. The only fact which is important is, that the invention is within their reach, and that they are to be restrained from using it.

It is also to be observed that the injury to an inventor by delays in the Patent Office may be much less than might upon first impressions be supposed; for though, until the patent is granted, the invention may be used without the inventor's consent with impunity, yet the right to continue the use is terminated by the grant of a patent, and there can be no doubt that the fact, that at any time during the term of a foreign patent a patent for the invention may be granted in this country, must operate to restrain the people of this country from entering on its use; and, on the other hand, if the people do exercise, it may be for years, their right to use such invention, so long as it remains unpatented, they are liable to be deprived of that right, and to be subjected to loss, by the act of the inventor in obtaining a patent here. And the danger goes still farther, for, after an application is made here, of which the public can have no knowledge, an applicant may by dilatory expedients postpone for years the issue of his patent, and may be tempted to do so if he can finally have a patent for seventeen years, and long after the expiration of his foreign patent. It is fair to presume that Congress never intended to expose the people of this country to this danger, and the Courts should not do so, by importing into the statute language which Congress did not adopt. It should so construe the statute as to diminish the danger, and not increase it.

There is another consideration which is important in this connection.

If the use of an invention patented abroad, but not patented here, will be, as above suggested, attended with peril to a user here, by reason of the right of the inventor to take a patent here, and if a patent when granted here were to be for the full term of seventeen years, it is obvious that the people of this country may be practically restrained from the use of the invention not only for seventeen years, but for seventeen years added to the term for which the foreign patent had run, and it would be a reasonable provision for Congress to prevent this by restricting the term of the patent to the term of a foreign patent, and thus, by deducting the period of delay and two or three years more, perhaps, from the period during which the exclusive right should belong to the inventor, and not from the period when the right to use would otherwise be with the public, make it the interest of an inventor to use the greatest diligence in securing his patent here.

To the suggestion that the rights of an inventor are to be determined by the date of his application, and of his rights at that time, we reply, that he may certainly forfeit or abridge those rights by acts done after the application, and before the grant of the patent. He may, under Section 4894, lose his right to a patent altogether by an unnecessary delay for more than two years in prosecuting his application. He may abridge his rights by an amendment or disclaimer. He may forfeit his right to a patent, even after it has been allowed, by neglecting for more than six months to pay the final fee, and his right to renew his application by waiting more than two years. It can hardly admit of doubt that he might abandon his rights by other acts between his application and the allowance of his application. All that is fixed by his application is the right to have his case examined.

The construction for which we contend is in accordance with that which we understand was applied to a provision of the Act of 1839.

By Sections 6 and 7, of the Act of 1836, an inventor lost his right to a patent for his invention if, "prior to his application," the invention had been in public use or on sale "with his consent or allowance."

By Section 7, of the Act of 1839, it was provided that a purchase, sale, or use of an invention prior to the application should not render a patent invalid, "unless such purchase, sale, or prior use has been for more than two years prior to such application for a patent."

The words of the Act of 1836, that the sale or use of the invention prior to the application, which should defeat an inventor's right to an invention, should be with the "applicant's consent or allowance," were omitted in the Act of 1839.

In Andrews *v.* Hovey, 123 U. S., 267, the question was presented, whether the consent and allowance of an inventor to a sale, or use for two years prior to his application, was necessary, under the Act of 1839, to defeat his right to a patent as it was under the Act of 1836, and the Court held that it was not; that such an effect could not be given to the Act of 1839 without interpolating into it the words "consent or allowance," and that it could "find no warrant for doing this." (Page 274.)

And now, in relation to the effect which a foreign patent shall have in fixing the term of a patent in this country, the Court is asked to interpolate into the words of Section 6, of the Act of 1839, "prior to the application of such patent."

We submit that, as was held in the case of Andrews *v.* Hovey, there is no warrant for doing this.

More especially is this the case when the Act of 1870, in which Section 25 is in substance the same as Section 4887, in terms repeals the Act of 1839.

In this case, as in the case of Andrews *v.* Hovey, the appellant contends that a subsequent statute, from which certain terms of a prior statute had been omitted, must be read as though it contained the omitted words; and we submit that there is no more reason for doing this in this case than there was in the case referred to, and that the manifest purpose of Congress, to restrict the privileges of inventors and increase those of the public, would be defeated by doing so.

CHAUNCEY SMITH.

The phrase "*before the application*" was first used in section 1 of the Act of 1793.

It was there used with reference to the knowledge or use which would bar an applicant's right to a patent.

Its equivalent, "*at the time of the application*," was used in the same connection in section 6 of the Act of 1836, and again with a slight change in section 7, and again in section 15. It was used again in the same connection in the first proviso of section 6 of the Act of 1839.

In section 8 of the Act of 1836 it was used for the first time with reference to a patent in a foreign country taken out and published within six months before the application.

In section 6 of the Act of 1839 it was again used with reference to a foreign patent taken out more than six months prior to the application.

Thus with reference to knowledge or use of an invention, the phrase slightly changed, in words but not in sense, had been used five times in the legislation prior to 1870, and twice with reference to prior patents. The words had become apt words of reference to the application for a patent when the time of that act was to be made legally important.

In the Act of 1870 and in its revision the employment of the phrase was still continued with reference to the use of an invention.

It was discontinued with reference to foreign patents.

The retention of the phrase to fix the period of prior use, and its disuse with reference to foreign patents, is significant. No reason can be assigned for its continued employment with reference to the public use of inventions, and its discontinuance with reference to foreign patents, except that in one case the law was to continue as before, and in the other case it was to be changed.

If the law was to be changed in one case the language must of necessity be changed, and the language was in fact changed with reference to foreign patents.

If in the other case a change was not to be made in the law the language would naturally and properly be retained, and this was what was in fact done with reference to prior use. It is reasonable to believe that the change in the language with reference to foreign patents was made because the law itself was to be changed.

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Supreme Court of the United States.

No. 862.

THE BATE REFRIGERATING COMPANY,
Appellant,

vs.

GEORGE H. HAMMOND & CO.,
Appellees.

Brief Filed by Consent of Court by R. Mason.

In considering Section 4887, R. S., two questions present themselves:

1. Does the section apply at all to the case of a domestic inventor?
2. If it does, how is he affected by it?

The following suggestions relate only to the first of these questions, and contemplate only one aspect of that.

In England patents are given to those who introduce a new manufacture into the realm; the question is not even asked whether the applicant was the inventor or not, and therefore, no such patent raises the implication of invention by the patentee.

In this country the invention must not only be introduced, but the applicant must be the inventor, and his application must bear the tests imposed by Section 4886, R. S.

Inventions are broadly divisible into two classes, viz: domestic and foreign. In all cases in which the question of priority is raised, parol testimony may be introduced to show that the applicant or patentee had produced the invention, in this country, before the date of the alleged anticipation; and if successfully done the rights of the inventor stand intact unless abandoned by him.

There never has been a time when an application or patent could be sustained in the U. S., by parol proof of invention in a foreign land. In such a case the date of invention here is that of the applicantion. The legislation under consideration has relaxed this rule to this extent, and to this extent only, that where a foreign patent has been taken out or description published the applicant or patentee may connect himself with that patent or publication by parol proof, and when that has been done successfully the date thereof becomes the date of his invention.

There is then this distinction between the domestic and the foreign inventor, that the former stands upon his invention, to which time his rights relate back, while the foreign inventor stands upon his application only, unless he had disclosed his invention by foreign patent or printed publication, which then becomes the time to which his rights relate back.

We now see why Section 4887 was introduced. It was that the foreign inventor might not be barred by that patent which otherwise was, or at least was thought by Congress to be, fatal; for if no one was barred by the foreign patent there was no occasion for Section 4887. Certainly the domestic inventor did not need it, for he stood on his invention, and came within the general terms of the law, and if the first as well as the original inventor, was entitled to a patent for the full term of seventeen years under Section 4884.

The exceptional party whose rights were saved by Section 4887, was the foreign inventor, who would be barred by the foreign patent which disclosed his invention before application here, and with which he could only connect himself by parol proof, which he could only introduce by special provision of the law. That grace was, however, conditioned upon another exceptional provision, viz: that the patent upon which he was permittad to rest his date of invention should operate to limit the term of his United States patent to that of the patent under which he derived his rights, or, if there be more than one, to that which had the shortest term.

This clause is not to be construed as though it stood alone, it must be read with the context, and so read with the adjacent clause of the same section, it appears that the section governs the case of the foreign inventor, and that the domestic inventor, whose rights are not only independent of, but are unaffected by, any patent, publication or other disclosure of his invention made after its date and before application, not amounting to abandonment, is not affected thereby, and that he stands under the general provision of Section 4884, entitled to a patent for the full term.

This interpretation is consistent with the section, and makes it consistent with other parts of the act. It saves the laws from the folly of providing that, whereas an American inventor may give all possible publicity to his invention, and permit all the rest of the world to use it freely from the beginning and still have a patent here for seventeen years, any attempt to limit its foreign use, by previous patent abroad, brings upon himself the penalty of having his domestic patent curtailed to the term of his foreign patent. Such is the construction claimed for Section 4887 ; and while if such be clearly its effect its folly will not afford cause for rejecting it, the fact that it would make the law almost wickedly foolish is a conclusive reason for rejecting such a construction where it is a proper case for construction.

R. MASON.

Supreme Court of the United States.

IN EQUITY,

No. 862.

THE BATE REFRIGERATING CO.,
APPELLANT,

VS.

GEORGE H. HAMMOND & CO.,
APPELLEE.

Brief on Behalf of the Appellee.

BENJAMIN F. THURSTON,
GEORGE H. LOTHROP,
Of Counsel for the Appellee.

PROVIDENCE:
E. A. JOHNSON & CO., LAW PRINTERS, 57 WEYBOSSET STREET.
1888.

publicity to his invention, and permit all the rest of the world to use it freely from the beginning and still have a patent here for seventeen years, any attempt to limit its foreign use, by previous patent abroad, brings upon himself the penalty of having his domestic patent curtailed to the term of his foreign patent. Such is the construction claimed for Section 4887 ; and while if such be clearly its effect its folly will not afford cause for rejecting it, the fact that it would make the law almost wickedly foolish is a conclusive reason for rejecting such a construction where it is a proper case for construction.

R. MASON.

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1888.

Supreme Court of the United States

The Bate Refrigerating Co., Appellant,
vs.
George H. Hammond & Co., Appellee.
No. 862.

BRIEF ON BEHALF OF THE APPELLEE.

The questions raised upon the record in this case are:

First: Did the Letters Patent of the United States, No. 197,314, granted to John J. Bate, November 20, 1877, for seventeen years, expire January 9, 1882, for the reason that Canadian Letters Patent for the same invention were previously granted to the same Bate on January 9, 1877, for the period of five years, notwithstanding that such Canadian Patent was extended on the 12th day of December, 1881, for a further period of five years dating from January 9, 1882, and again extended on the 13th day of December, 1881, for a further period of five years dating from the 9th day of January, 1887, (Rec. pp. 30-33), such extensions having been made under the authority of the

Canadian Patent Act of 1872, 35 Vict., c. 26, sec. 17? (Rec. p. 46.)

Second: Are the said United States Letters Patent granted to John J. Bate, No. 197,314, dated November 20, 1877, affected as to their duration under Section 4887 of the Revised Statutes, by the said Canadian patent for the same invention previously granted to the said Bate, in view of the fact that the application for the United States patent was filed in the Patent Office of the United States December 1, 1876, and the application for the Canadian patent was subsequently filed in the Patent Office for Canada on the 19th of December, 1876?

Section 4887, Revised Statutes.

The section of the Revised Statutes under which the appellee claims that the Bate patent expired in the United States on the 9th day of January, 1882, is as follows:

> "No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one,

at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."

Statement of Facts.

Preliminary to a discussion of the questions raised on the record, there are certain facts and dates not in dispute which ought to be stated and carried in mind to enable the argument to be properly applied.

1. It is conceded by the appellant that the defendant did not commit any act complained of as an infringement of the Bate patent prior to April, 1883.

2. December 1, 1876, appellant filed an application for a patent in the United States Patent Office which resulted in the grant of a patent to him dated November 20, 1877, No. 197,314.

3. December 19, 1876, Bate filed an application in the Canadian Patent Office for Letters Patent for the same invention, and Letters Patent were granted to him January 9, 1877, which were sealed and registered on January 11, 1877, and numbered 6,938. Said Canadian Letters Patent were granted for the period of five years from their date, according to the terms of the Canadian Patent Act. (Rec. 28, 29.)

4. December, 5, 1881, Bate filed a petition in the Canadian Patent Office setting up "that on the 9th day

of January, A. D.,1877, your petitioner obtained a patent for the period of five years from the said date, " etc., and praying that the same be extended. In accordance with that petition the Canadian patent No. 6,938 was, on December 12, 1881, extended for five years from January 9, 1882, and on the following day was further extended for five years from January 9, 1887.

5. A suit was commenced under the Bate patent before the Circuit Court for the District of New Jersey against Gillette and others, in which case the patent was sustained. In the summer of 1882, the defendants in that case petitioned the court to dissolve the injunction which had been previously ordered, upon the ground that the Bate patent had expired as the result of the operation of Section 4887 of the Revised Statutes. The injunction was dissolved by Judge NIXON on the ground that the United States patent had expired, in view of the fact that it was limited to the life of the Canadian patent, the duration of which was held to be for only five years. (13 Fed. Rep., 553.)

6. Thereupon the appellant proceeded by collusion and connivance to procure a judgment of the Superior Court of Lower Canada to the effect that the Canadian patent of January 9, 1877, was void *ab initio* in consequence of the omission or failure of Bate to file in the Canadian Patent Office a model of his apparatus until June, 1878. This judgment of vacation was entered July 9, 1883.

7. The appellant next proceeded before the Circuit Court for the District of New Jersey to reinstate the

injunction in the Gillette case, on the ground that it had been judicially decided that there never was in fact any prior Canadian patent, and that therefore Section 4887 had no operation upon the United States patent. Thereupon Judge Nixon restored the injunction. (20 Fed. Rep., 192.)

8. In May, 1883, the Dominion Parliament passed "An Act to Amend the Patent Act of 1872," which received royal assent May 25, 1883, whereby Section 17 of the Act of 1872 was repealed, and in place thereof a new section was substituted, wherein it was provided "that every patent heretofore issued by the Patent Office in respect of which the fee required for the whole or for any unexpired portion of the term of fifteen years has been duly paid according to the provisions of the now existing law in that behalf, has been and shall be deemed to have been issued for the term of fifteen years, subject," etc. (Rec. p. 63.)

9. June 30, 1886, the Superior Court for Lower Canada vacated the prior judgment of July 9, 1883, declaring the Canadian Bate patent void *ab initio*, and decreed that such prior judgment was obtained "through the fraud to the law and collusion of the said John Jones Bate, Bate Refrigerating Company, and Benjamin Holman, deceiving the Attorney-General, the advocates and the court, employing and paying counsel on both sides, as well seemingly against themselves as on their apparent behalf." (Rec. pp. 36-39.) The court further held that the said patent was not void *ab initio*, and that it had never ceased to be, and since the issuing thereof, and still was "in full

force, vigor and effect through the renewal of the 12th of December, 1881, and as moreover declared by the statute of 1883 (46 Vict., c. 19)."

10. The bill of complaint in this case was filed December 16, 1886. On January 22, 1887, the defendant pleaded the Canadian patent. On March 26, 1887, the bill of complaint was amended, whereupon the defendant answered on April 5, 1887, setting up the expiration of the Canadian patent and praying the same benefit of this defence as if it had been formally pleaded.

April 30, 1887, the parties made a stipulation that the case should be heard upon the plea set up in the answer, (Rec. p. 15), and the cause went to hearing, and with the result that the plea was sustained by the Circuit Court for the District of Massachusetts and the bill dismissed. Thereupon an appeal was taken to this court.

The fact that the Bate Canadian Patent was extended Prior to its expiration in Canada for two further Terms of five years respectively, has no effect to Extend the life of the United States Bate Patent.

The "foreign patent" referred to in Section 4887, the expiration of which is to affect the life of the American patent granted for the same invention, is, in contemplation of law, the *then existing* foreign patent, and not any subsequent patent to be granted to such holder of a foreign patent for such invention, either by royal favor or by the effect of acts which the patentee may elect to do or omit to do under the provisions of the general law.

In considering the effect of a foreign patent under Section 4887, reference must be had to the statutory authority under which such patent is granted. If the statute be after the form of the British Patent Act, then the patent is a grant *ab origine* for fourteen years, although its life may be shortened by the non-performance on the part of the patentee of conditions subsequent imposed by the Act. In such case the American patent is not limited by the failure on the part of the holder of a foreign patent to perform such conditions, and for the plain reason that the foreign patent in existence at the time when the American patent was granted was in law an existing grant for fourteen years.

Under the 17th section of the Canadian Patent Act of 1872 (Rec. p. 46), it is not provided that patents shall issue in all cases for a term of fifteen years, with a liability to be shortened as to their duration in the event that certain conditions subsequent are not performed, but by express terms they are issued for a period of "five, ten or fifteen years, at the option of the applicant," with a privilege to the patentee, before the expiration of such period, to obtain an extension for a second period, and before the expiration of such second period, to obtain an extension for a third period. The section requires that "the instrument delivered by the Patent Office for such extension of time shall be in the form which may be from time to time adopted to be attached, with reference to the patent."

Now the construction that was given to this act by the

Canadian authorities has always been, up to the passage of the Act. 46 Vict., c. 19, May 25, 1883, that if the patentee elected to take a patent for five years, a grant should be made to him for that term only. On the other hand, if he elected to take a patent for fifteen years, the grant was for such period. In the present case the Bate patent, No.6,938, was expressly limited for the period of five years from its date (Rec. p. 28), accompanied with the proviso that the patent should cease within that time, and at the end of two years. unless the patentee or his assignee should have commenced and carried on the practice of the invention within the Dominion, and with the further proviso that it should cease at the expiration of one year in case the patentee or his representatives should import or cause to be imported into the Dominion the subject for which the patent was granted.

In this connection, and as illustrative of the interpretation given by the Canadian Patent Office of the meaning of section 17, we call attention to the peculiar form of the extensions of the Bate Canadian patent. They recite the provisions of the Patent Act of 1872 as to the terms of patents and their extensions, recite the grant of the patent, its date, grantee, term, and subject, and then proceed as follows:

> "The *present patent* grants to the said John Jones Bate, his executors, adminstrators and his assigns, *for another period of five years*, to commence and to be computed on and from the 9th day of January, which will be in the year one thousand eight hundred and eighty-two (one thousand, eight hundred and eighty-seven), the exclusive right, privilege and liberty of making, constructing and using, and vending to others to be used, the said invention of John Jones Bate," etc.

It seems to us that it is impossible to dispute the proposition that the original patent granted to Bate January 9, 1877, was a patent for five years and no longer; that there was also subsequently granted to him, to commence at the date of the expiration of that patent, a new independent grant for another period of five years, and also a third independent grant for five years longer, commencing on the 9th of January, 1887.

Inasmuch as the only Canadian patent in existence at the date of the issuance of the Bate American patent was the one which had been granted to him for five years from January 9, 1877, it follows that such patent is the one which is contemplated by Section 4887 of the Revised Statutes, as distinguished from any subsequent grant of Letters Patent for other terms for the same invention.

Emphasis should also be given to the fact that Bate voluntarily elected to take a Canadian patent for five years, when it was in his power, if he had chosen, to have elected to take a patent for fifteen years.

The question whether the words "foreign patent" occurring in Section 4887 could refer to any other patent for the same invention than the foreign patent then existing, was first raised in the case of *Henry* vs. *The Providence Tool Co.*, 14 O. G., 855. In that case a British patent had been granted in November 1860 for fourteen years, and in October, 1871, the inventor obtained an American patent for the same invention. The patentee, before the English patent expired, applied for a prolongation for a further term to the Queen in council. An order of the privy council was made thirteen days after the patent had expired in Great Britain, granting a new patent in prolongation of the patentee's monopoly for a further period of four years. Such prolongation operated under the English law as an extension of the original term, and the four years began to run at the moment when the original term expired. In fact under the English law damages could be recovered for the infringement of the patent during that period of thirteen days in a suit brought after the new grant had been issued.

It was contended before Mr. Justice CLIFFORD that this prolongation operated to extend the foreign patent, and that as a result the United States patent should be upheld on the theory that Section 4887 was to be construed so as to continue the patent in this country throughout the whole period of the existence of the patent protection given to the same invention to the patentee in great Britain. Mr. Justice CLIFFORD held that the patent referred to in section 4887, which would affect the life of a subsequently obtained United States patent, was the then existing grant in Great Britain for a term of fourteen years; and that no prolongation of the patented protection for a further term would operate to extend the period of duration of the United States patent. The learned judge said:

> "Neither the act of a foreign sovereign nor the act of a foreign legislature can have the effect to prolong the term of a patent granted here beyond the term which the Act of Congress prescribes. Nothing short of a special

> Act of Congrees can breathe new life into such patent after the term prescribed by law has expired. Tested by these several considerations, the court is of the opinion that the patent in suit ceased to be operative when the original foreign patent expired."

The next case which arose is that of *Reissner* vs. *Sharpe*, 16 Blatch., 383. In this case the previous patent was one granted in Canada for a period of five years, and such Canadian patent had been duly extended for two further periods of five years each. Mr. Justice BLATCHFORD held that the patent in this country expired with the expiration of the first term of five years, notwithstanding the fact that the patent was still alive in Canada in virtue of the procurement of two extensions for five years each. In the course of the decision the case of *Henry* vs. *The Providence Tool Co.* was reviewed, and its principle adopted. Mr. Justice BLATCHFORD said:

> "But Mr. Justice Clifford held that Congress never intended to extend the term of the United States patent beyond the legal term secured to the foreign patentee when the United States patent was granted; and that no act of a foreign sovereign, nor any act of a foreign legislature, could have the effect to prolong the term of a patent granted here beyond the term prescribed by the Act of Congress. Mr. Justice Clifford refers, with force, to the considerations, that, as the statute refers not only to the foreign patent, but, if there be more than one, to the one having the shortest term, it cannot be held to include any subsequent prolongation or extension of the monoply beyond that vested in the foreign patentee at the time of the granting of the United States patent; that, if Congress had intended otherwise, the language would have been different, and words would have been employed to

> signify that the domestic patent should continue as long as the same invention was protected by the foreign Government; and that, under the opposite rule, neither the authorities of the United States, nor inventors, nor the public, would ever be able to know what the patentee acquired under a patent granted by the United States in a case where the invention had been previously patented in a foreign country. Another view applicable to the present case is, that, before the Canada extensions were granted, the defendant had put in a plea to the bill, and the plaintiff had set down such plea for argument. There would, therefore, under the plaintiff's view, be one rule governing this suit, if it were to be determined according to the state of things existing when it was brought, and there would be another rule governing suits brought on the United States patent after the Canada extensions were granted. The plaintiff suggests a distinction between the case of *Henry* vs. *Providence Tool Co.* and this case, because in this case the Canada patent did not expire before it was extended, and because an extension in Canada is not a matter of favor. But it is not preceived that these considerations are of sufficient force to cause any other conclusion as to the plain meaning of the statute to be adopted than that arrived at by Justice Clifford; and I think such conclusion is the proper one applicable to the present case."

The same doctrine has been applied in dealing with the Bate patent by Judge NIXON, 13 Fed. Rep., 553, and by Mr. Justice BRADLEY in his discussion of the question, 31 Fed. Rep., 813.

We therefore submit that the fact that the Bate patent has been extended in Canada for an entirely new term beyond the original term for which the Letters Patent were granted cannot relieve the Bate patent in this country from the operation of Section 4887.

The Bate United States Patent is not relieved from the Operation of Section 4887 in consequence of the Canadian Statute 46 Vict., C. 19, May 25, 1883.

This Act on its face purports to be "An Act to Amend the Patent Act of 1872," and it proceeds to execute its purpose by repealing in terms the 17th section of the former Act, and substituting a new section in its place. This new law became operative when it received royal assent May 25, 1883, and the necessary implication is that prior to that date the duration of all patents previously issued in the Dominion were limited as to their duration to the periods specifically named in the grants.

The argument is, on the part of the appellant, that the Canadian Parliament on May 25, 1883, had the right to declare that Letters Patent to John J. Bate, granted November 20, 1877, for a specific period of five years, were to be deemed to have been issued for the term of fifteen years; or, otherwise stated, the proposition is, that it was competent for the legislature of Canada to make a declaration that an expired term of a patent according to its own laws was not such so as to control the application by the courts of this country of Section 4887 of the Revised Statutes, and that, too, after the event of the expiration of the patent had taken place according to the uniform decision of the courts in this country as to the meaning of the Canadian Patent Act of 1872.

We are not called upon to deal with the question whether the Act is properly within the power of the Canadian Parliament, nor whether it is retroactive in its effect in the Dominion of Canada, nor whether it ought to be held so binding upon the Canadian courts as to compel such courts to say that a particular patent granted in 1877 for five years, and for five years only, unless a further grant were obtained in extension of the original term, was in fact a grant *ab initio* for fifteen years. We may assume for the argument's sake, and contrary to the truth, that the parliament is as imperial in its character as the parliament of Great Britain. The meaning and effect of the Act of 46 Vict., c. 19, is one thing as to its application to subjects within the jurisdiction of the territory of the Dominion, and quite another thing with respect to the effect of such legislation upon Section 4887 of the Acts of the Congress of the United States. It is this latter matter which interests the appellee in this case, and should engage the attention of the court rather than the former.

We submit, however, that, upon its face, the Act in question does not profess to be a declaratory act, or one which is intended to make intelligible and clear an existing ambiguous statute. So far as the defendants are advised, this act has never been declared by any Canadian tribunal to be a proper declaratory act. If the Act can be so construed as to be intelligible, and furnish a remedy for the future, without the necessity of holding that it is retroactive, even in Canada, to the extent of changing the grant of a patent from five years to fifteen years, this rule of construction should be employed. It is a fundamental rule of construction of statutes wherever the English law prevails. In this case there is no necessity for resorting to any other rule. The statute is intelligible, and it can be made to apply to existing patents without holding that the Canadian Parliament had committed the solecism of declaring that an expired term of five years was in truth an unexpired term of fifteen years.

It must be kept in mind that, instead of professing to be an act explanatory of an existing statute, and declaratory of its true meaning, it is a new piece of legislation. It repeals the 17th Section of the Act of 1872, and substitutes a new Section therefor. It is absurd to say that the thing substituted is the same thing as the part repealed Such is not the form of legislation which is intended to be declaratory. It provides, in the first place, as it may well do, that the duration of all patents subsequently issued shall be for the term of fifteen years, and with the privilege for the applicant to pay an amount in government fees which will uphold the patent for that full term, or to pay lesser amounts, with the condition that the patent shall fall at the end of five or ten years unless additional fees shall be paid. The Act concludes with the following words, which constitute the foundation of the argument of the complainant :—

> "Every patent heretofore issued by the Patent Office, in respect to which the fee required for the whole or for any unexpired portion of the term of fifteen years has been duly paid

> **according to the provisions of the now existing law in that behalf, has been and shall be deemed to have been issued for the term of fifteen years, subject, in case a partial fee only has been paid, to cease on the same conditions on which patents hereafter issued are to cease under the operation of this section."**

Suppose, now, the Bate patent, issued for five years from January 9, 1877, had run its full course and had never been extended. It must be admitted that under the Act of 1872 it would have expired on January 9, 1882. Now it is manifest that the Act of 46 Vict., c. 19, passed May 20, 1883, does not apply to that supposed case, and have the effect to convert that already expired patent into a fifteen year patent. But the Bate patent was in fact extended under the Act of 1872, for two consecutive periods of five years each. Therefore at the date when the Act in question was passed the Bate patent was alive in Canada. But what gave it vitality? The answer is—the Act of 1872. Upon what term was it running? The answer is—upon an extended term of five years next following January 9, 1882. Now the Act does apply to this patent, but how? The answer is—in a litigation or proceedings had within the Dominion of Canada, the courts may treat the extended term or terms under which the patent is running, as if the original grant had been for fifteen years. This is a very different thing from the absurd declaration that the original grant was in fact for fifteen years, contrary to the plain evidence of the senses. Suppose, for example, Bate had, previous to January 9, 1882, asked for an extension for five years only, and paid a corresponding fee. The effect of the Act of 46 Vict.. c. 19, is, we may concede, equivalent to a declaration that the then existing term shall be deemed and taken in law to be a term for ten years, terminable January 9, 1887, unless an additional duty is paid. We can understand how a legislative body can declare that an existing unexpired term of a patent for five years can be deemed and taken in law to be a term for ten years, provided the patentee performs a certain act, but the mind is incapable of conceiving how a term of five years, which expired January 9, 1882, can by any legislation in May, 1883, be revived in fact or in law as to time which has already elapsed.

It is unnecessary, however, to pursue the argument upon the character of the legislation as regarded from a Canadian standpoint. The pertinent inquiry is—one which must not be lost sight of—what is the effect of the Act, no matter how it may be interpreted in Canada, upon section 4887 of the Revised Statutes of the United States, in the application of that statute in determining the rights of the public under it.

The case of *Liverpool Insurance Co.* vs. *Massachusetts*, 10 Wall., 566, is directly in point. The Supreme Court of the United States held that the company was a corporation within the meaning of the statute of Massachusetts, notwithstanding that upon the highest possible judicial authority the company in England, where it was created, was declared not to be a corporation. The question before the court was not so much whether the joint stock association known as the Liverpool Insurance Co. was, in fact, according to the definition of the law, a corporate body, as whether such an organization fell within the definition of a corporation by the Massachusetts statute. Again, while it may be conceded fully that every foreign government, and the courts instituted by it, are of supreme authority in interpreting their own statutes, as was held in *Elmendorf* vs. *Taylor*, 10 Wheaton, 152, there is no principle of international comity which goes to the extent of declaring that a foreign court or parliament can declare, in fact, that under the multiplication table used by all nations, twice two make six, so as to make that conclusion binding upon another nation where the essential inquiry was, whether twice two did in fact make six. Further than this, if the British Parliament had seen fit to declare that the Liverpool Insurance Co. was not a corporation, although it obviously was, under the law of England, a corporate body, such declaration would not have changed the decision of the Supreme Court in the case cited, provided the statute of Massachusetts had declared such an organized body of persons to be in fact a corporation. What the court in this case were engaged in doing, was construing the meaning of the Massachusetts statute, and not ascertaining what that body of persons would be declared to be in England. On the other hand, if that organization had been declared by the Parliament of England to be in fact a corporation, and it did not fall within the definition of a corporate body as defined by the Massachusetts statute, the decision of the Supreme Court would, on the same principle, have been adverse to the claim of the Commonwealth.

The contention now made by the appellant is precisely the same contention that was made before Mr. Justice CLIFFORD in *Henry* vs. *The Providence Tool Co.*, 14 O. G.,

855. Beyond doubt the prolongation of Henry's patent by the Queen in council operated, under the English law, to extend the patent for a period of four years longer, and if Mr. Justice CLIFFORD had upheld the complainant's view in that case, it would have been equivalent to a decision that a foreign power can at its pleasure enact laws which will qualify or affect the interests and vested rights of the American people. Shortly stated, the rights of the public under the plain provisions of Section 4887 would depend not upon the Act of Congress, but upon the contingency of foreign legislation, or upon the accident of royal favor. Undoubtedly Congress would have had the power, if it had seen fit, to have provided in express terms that a patent in the United States based upon an invention previously patented abroad should continue in force in this country so long as the same subject remained under the protection of Letters Patent abroad, whether such protection was the result of an existing general law, or of some subsequent special legislation, or of some special royal grant. Congress, however, did not so frame the law, but, on the contrary, provided that the United States patent should fall with the expiration of the existing foreign patent. If the existing foreign patent is one for fourteen years, then the patent in this country is upheld for that period, notwithstanding that the patent protection abroad may have sooner ceased on account of the failure, on the part of the patentee, to comply with statutory requirements. Beyond doubt it is a question of fact as to what is the duration of a Canadian patent contemplated by Section 4887. It may be conceded also that in Canada it is a question of law competent to be decided by the Parliament and by the courts as to when the patent

did in fact expire. But this is not the present question. The proposition now made by the appellant is, that the Canadian Act of 1873 can have a retroactive effect. This may be true in Canada, and may be properly so decided by the courts, but it cannot *ex post facto* change a condition mentioned in an Act of Congress upon the happening of which rights accrue to the public. It is idle, it seems to us, to argue that there is no reason in the nature of things why the Act of Congress should not have provided that a United States patent based upon a foreign invention should live in this country for as long a period of time within the term of seventeen years from its date as the foreign patent was allowed to live as the result of new grants or extensions in prolongation of a monopoly in such foreign country. The reply is very simple, and is to the effect that such is not the Act of Congress, and there is no basis in the law upon which the court can found a conclusion that such was the intention of Congress as a legal intendment. Mr. Justice BRADLEY, in *Bate Refrigerating Co.* vs. *Gillette*, 31 Fed. Rep., 813, says:

> "I may say at once that I attach no importance to the last mentioned Act. The American patent received its operative force and effect on the day it was issued, and no subsequent legislation in Canada or elsewhere could change it, whatever might be the effect of such legislation where made. The force and effect of the American patent could only be affected by the Canadian patent as the latter stood when granted, and not as it was afterwards modified by legislation."

We ask now, what is the effect of the Act of 46 Vict., c. 19, upon Section 4887. I assume that in the event that the Act in question had not been passed, the courts would have held, without question, under the authority of the cases *supra*, as determined by three independent tribunals, that the American patent to Bate expired January 9, 1882.

We are instructed by the late Mr. Justice CLIFFORD that Section 4887 contemplates the then existing patent grant of a foreign country. He says in his opinion in *Henry* vs. *Tool Co.*:

> "The complainant contends that by the true construction of the Act of Parliament the prolongation of a patent is the same in effect as the extension of the original term, and that the extension, by relation, begins to operate at the moment the original term expired; and the court is inclined to adopt that view as the correct exposition of the Act of Parliament. *Saxby* vs. *Hennet*, Law Reporter 8, Exchequer 313."
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> "Suppose that it is so; still it does not touch the question in this case, the question here being:—What is the true construction of the Act of Congress under which the patent in suit was granted? When granted, the foreign patent was still in full force, and would not expire for a space of three years, nor could anyone foreknow whether a petition for prolongation would ever be seasonably presented, or, if presented, whether any prolongation would ever be granted. Congress employs the words, 'the *foreign* patent,' evidently referring to the term of the foreign patent, to define the term of the domestic patent. Had Congress intended to grant a patent for an indefinite term, or for an uncertain and undefined duration, they would have employed suitable words to express such an intent."

It is too plain for argument that under the statute of Canada, in force at the time when the Bate United States patent was granted, the term of the Canadian patent was expressly limited on its face to five years. Every person wishing to wrap cloth around a piece of fresh meat, for keeping the meat in a refrigerator, which is the subject of the Bate patent, had a right to understand, after the decision of *Henry* vs. *Tool Co.* and *Reissner* vs. *Sharpe*, that the Bate patent in the United States would be terminated as to its life on January 9, 1882. Such was the undoubted law. Suppose, now, that a firm of dealers in fresh meats after that date commenced to envelop their meats in cloth wrappings and prosecute such lawful business until May 20, 1883. After that date let us suppose that firm to be sued for an infringement of the Bate American patent, the complainant insisting, as it does here, that the Parliament of Canada had the right, on May 20, 1883, to do an act the effect of which would be to change the interpretation of the Act of Congress, Section 4887, so that the offence of infringement would be committed by such defendants after May 20, 1883, when confessedly it could not have been committed between that date and January 9, 1882. The proposition would be a startling one, to say the least. But such is the necessary conclusion to which the contention of the complainants in this case must logically lead.

The statutes of every civilized people are intended for the guidance of the people of the country under the jurisdiction of its laws. Such laws can neither be enlarged, modified, or affected by the legislation of any foreign power. The statutes are intended to be intelligible and certain on their face, for the guidance of the people subject to them, or as the same shall be made certain by the judicial interpretation of the courts within the country enacting them. Upon this matter Justice CLIFFORD says, in *Henry* vs. *Tool Co.*—

> "Great inconvenience would result from the opposite rule, as neither the authorities of the United States nor inventors or the public, would ever, in such case, be able to know what the patentee acquired under a patent granted here, in a case where the invention had previously been patented in a foreign country. Neither the act of a foreign sovereign, nor the act of a foreign legislature, can have the effect to prolong the term of a patent granted here, beyond the term which the Act of Congress prescribes. Nothing short of a special Act of Congress can breathe new life into such a patent after the term prescribed by law has expired."

It may be pertinent to ask, what was the condition of the Bate patent in this country between January 9. 1882, and May 20. 1883, when the Act of 46 Vict., c. 19, received royal assent. Beyond doubt it was not in force as a legal instrument in this country. The complainants say: True, such was the fact according to the legal lights that existed at that time both in Canada and in this country, but it now turns out that the Canadian patent was contrary to the Act of 1872, and contrary to the limitation expressed upon its face—a patent in law for fifteen years. The reply is: This fact, or legal intendment, whichever it may be, had no existence until May, 1883, because the supposed fact was made such by a new statute in derogation of a former statute. Otherwise put, there was nothing to support the American patent between January 9, 1882, and May 20, 1883. The condition of things is exactly parallel with that which existed in the case of *Henry* vs. *Tool Co.* In the last named case there was an actual interval of thirteen days which occurred between the expiration of the patent and the decision of the Queen to prolong it. Now it cannot be said that the Bate patent, within the interval between January, 1882, and May, 1883, was in a state of suspended animation. It was in force in this country, or inoperative, for that period. The legislation under the effect of which it is now claimed it was in force, is *ex post facto*, so far at least as its effect upon Section 4887 is concerned, and nothing can give vitality to the patent, except some special legislation of Congress which shall revivify it from the time when such special legislation is had.

The clause of the Canadian Statute of 1873 (46 Vict., c. 19) which is supposed to have the meaning contended for by the appellant, is, however, in fact not an arbitrary and untrue declaration that five is fifteen, but is merely a saving clause rendered proper and necessary by the change at the time made in the Canadian Patent Law. Under the former law Section 17 (Rec. p. 46) prescribed the three terms for which patents might be granted at the option and voluntary election of the applicant, and also authorized an extension of those terms, in case the applicant should elect a term less than fifteen years, for a total period not exceeding fifteen years, and this was the only section of the law which gave this right. The Act of 1873 (46 Vict., c. 19) repealed this section, and thereby took away from the holders of previously granted short term patents all right to an extension, and also all power, on the part of the Commissioner, to grant the extension. The effect of simply repealing this statute would be that a prior patent for five years would end absolutely with the five years. Therefore the last clause of 46 Vict., c. 19, provides that patents theretofore issued and then living under the former law should be deemed as issued for fifteen years, whereby such patents were brought under the provisions of the new law as to the prolongation of the term, and could be kept alive under the new law; and this was the only necessity for the clause, and the only construction which renders it intelligible and consistent with rational legislation.

It is no sufficient argument to say that as the result of the extensions applied for by Bate there was no period of time when the invention became public property in Canada, and that, as a consequence, in contemplation of Section 4887 the foreign Canadian patent has not yet expired. The statement in such argument is not complete. The true statement is, that the invention has been covered in Canada by three successive patents to Bate for terms of five years each, the period of the second term commencing on the instant of the expiration of the first term, and the period of the third term commencing on the instant of the expiration of the second term. The case would be very different if the original patent under the existing law for Canada had been, upon the election of the patentee, taken for fifteen years. As the case stands, Bate was undecided for a period of more than four years whether he would take a further patent in Canada to commence on January 9, 1882, or not. He finally decided to procure such new patent, and it was granted to him. But our argument is that such new patent is not the patent contemplated by Section 4887.

The fact that the Bate Patent was applied for in the United States prior to the application for a patent for the same invention in Canada does not relieve the patent granted in the United States subsequent to the grant of the Canadian patent from the operation of Section 4887.

The appellants contend that the literal, plain and natural meaning of Section 4887 is not its true meaning, and that to make its letter conform to what they contend is its spirit, the words "upon an application previously filed" should be read into the section after the words "foreign country." A court of last resort is undoubtedly qualified to exercise a very large discretion in giving a meaning to the words of a statute, and sometimes words are interpolated into a statute by judicial construction for the purpose of giving effect to an intent on the part of the law-making power. An authority so great and so serious in the effect of its application in the majority of instances ought never to be exercised by a court except upon cogent reasons sufficient to control the conscience and point out, not by supposition, that such interpretation at variance with the language is consistent with what the legislature *ought to have done*, but forcibly enough to satisfy the intelligence that that is what the legislature *did in fact do.*

It is a fundamental doctrine that the words of a statute are to be interpreted according to their ordinary meaning, and that the intent of the law-making power was properly expressed by the words which it saw fit to use.

Mr. Dwarris, in his Treatise on Statutes, p. 694, says:

> "In the exposition of a statute, then, the leading clue to the construction to be made is the intention of the legislator, and that may be discovered from different signs. As a primary rule, it is to be collected from the words; when the words are not explicit, it is to be gathered from the occasion and necessity of the law—being the causes which moved the legislature to enact it. But in arriving at a conclusion from these premises the greatest care and circumspection, and the exercise of the soundest judicial discretion, are required."

Again:

> "Where the object of the legislature is plain and unequivocal, courts ought to adopt such a construction as will best effectuate the intentions of the law giver; but they must not, in order to give effect to what they may *suppose* to be the intention of the legislature, put upon the provisions of a statute a construction not supported by the words, though the consequence should be to defeat the object of the Act. (*Rex* vs. *Stoke*, 7 B. & C., 569)."

Again:

> "Where the legislature has used words of a plain and definite import, it would be very dangerous to put upon them a construction which would amount to holding that the legislature did not mean what it has expressed. The fittest course in all cases where the intention of the legislation is brought in question, is to adhere to the words of the statute, construing them according to their nature and import in the order in which they stand in the Act of Parliament. (*Rex* vs. *Ramsgate*, 6 B. & C., 712)."

And again (p. 703):

> "They are not (as the most learned members of a learned body best know) to *presume* the intentions of the legisla-

> ture, but to *collect them* from the words of the Act of Parliament, and they have nothing to do with the policy of the law. This is the true sense in which it is so often impressively repeated, that judges are not to be encouraged to direct their conduct 'by the crooked cord of discretion, but by the golden metwand of the law'; *i. e.* not to construe statutes by equity, but to collect the sense of the legislature by a sound interpretation of its language according to reason and grammatical correctness."

Lord Tenterden said, in *Rex.* vs. *Barham*, 8 B. & C., 104:

> "Our decision may perhaps in this particular case operate to defeat the object of the statutes, but it is better to abide by this consequence than to put upon it a construction not warranted by the words of the Act, in order to give effect to what we may suppose to be the intention of the legislature."

And again the same Judge said, in *Notley* vs. *Buck*, 8 B. & C., 164:

> "The words may probably go beyond the intention, but, if they do, it rests with the legislature to make an alteration. The duty of the court is only to construe and give effect to the provision."

There is not the least doubt or ambiguity in the phraseology of Section 4887. It is as direct a statement as can be made that the life of a patent issued in this country subsequent in date to a patent granted for the same invention in a foreign country shall depend upon the period of duration of the foreign patent in existence at the date when the United States patent was granted.

A review of our patent system will show plainly that there are two classes of patentees whose rights stand in rt upon provisions of our system common to both, and in part upon sections of the statute peculiar to each. These two classes are, *first*, all persons who procure patents in this country without first securing a patent for the same invention in a foreign country, and *second*, all persons who, having first received a patent for their inventions in a foreign country, procure patents for their same inventions subsequently in this country. Before the Act of 1836 no patent taken in this country upon an invention previously patented abroad by the same patentee, or upon his procurement, was a valid patent. It could be defeated at once by proof that the patentee had first patented the same invention abroad. By Section 8 of the Act of 1836, the rights of such class of patentees were enlarged, and it was provided that no such patent procured in this country should be held invalid if applied for within six months after the publication of the foreign patent. By Section 6, of the Act of 1839, the rights of this class of inventors were still further enlarged, and the additional privilege was given to such class to procure valid patents in this country for their inventions more than six months after the publication of their foreign patents, provided that such inventions had not been introduced into public and common use in the United States prior to the application for such patents in this country; and the further provisions was made that all such patents should be limited to the term of fourteen years from the date or publication of such foreign Letters Patent.

It was manifestly the intention of Congress that any person, whether a citizen of this country or a foreigner, who saw fit to procure a foreign patent for his invention more than six months prior to his application for a patent for the same invention in this country, should have a limitation imposed upon the duration of his American patent. Such limitation of time was measured by reference to the date of publication of the foreign patent.

It is certain that for twenty-seven years our patent laws have contained no discrimination in favor of American citizens as against foreigners. The citizen of this country and the people of all nationalities stand upon an equal footing and are subject to the same body of law with respect to their right to procure patents for their inventions. The fundamental object of our patent system is, as the Constitution declares, "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." Beyond doubt the reward is given to inventors for their promotion of the useful arts, but the principal purpose of the constitutional power referred to, and the Acts of Congress under the same, is not the reward of inventors, but the promotion of the useful arts among the people by encouraging inventions to be made, the benefits of which will, after a limited period of time, accrue without price to the people.

It is impossible to extract any policy from the statutes which shall be in accord with everybody's ideas of natural justice in all cases that can be imagined. A good illustration of this is found by the comparison of the provisions of the Act of 1836 with the provisions of the Act of 1839 upon the question of the forfeiture of the right to Letters Patent as the result of two years public use prior to the application for the patent. Under the Act of 1836, a patent could issue to an original inventor in case his invention had not been in public use with his consent or allowance before his application. By the Act of 1839, an original inventor's right to Letters Patent became forfeited in case the invention had been in public use for two years prior to his application, even though such use was without his consent or allowance. For many years, the view had been held by some of the Circuit Courts that the forfeiture was not incurred unless such public use was with the consent and allowance of the patentee, but this court, upon a review of the law held that there was no warrant for the interpolation of this qualification into Section 7 of the Act of 1839, but that it was the intent of Congress to alter the law in that regard, and this intent was ascertained from a comparison of the phraseology of the section in question with the antecedent statutes *in pari materia*. (*Andrews* vs. *Hovey*, 123 U. S., 267.) It must necessarily happen that statutes are arbitrary in their provisions. It is impossible to make all legislation square with a satisfactory reason to every mind.

The Act approved July 8, 1870, introduced upon the subject of the duration of patents based upon prior foreign patents a new rule. The statute is entirely consistent with the former policy upon this subject in this, that its effect is, as the effect of the Act of 1839 was, to possibly curtail the life of a United States patent based upon a foreign patent previously obtained. The change which it makes consists in abolishing any reference to the date of the application for the American patent relatively to the time of the granting of the previous foreign patent, and substituting in place thereof the fact of a previous grant of a foreign patent, without any regard to the question whether the application for such foreign patent was prior to the application for the American patent or not. Both the Act of 1839 and the Act of 1870 impose limitations as to the duration of patents procured in this country on patents previously taken abroad. In the former case the limitation is fourteen years from the date of the foreign patent, in case such foreign patent had been procured more than six months before the application for the United States patent. In the Act of 1870 the limitation upon the American patent is the period of life of the previously obtained foreign patent. The principle of limitation is the same in both Acts ; the rule for computing the period of such limitation was changed.

It is impossible, we submit, to gather from the Act of 1870 any other conclusion than that this change was intentional.

If we compare Section 6 of the Act of 1839 with Section 25 of the Act of 1870, we shall see that the word "application" occurs twice in the Act of 1839, and only once in the Act of 1870. The Act of 1836 says "that no person shall be debarred from receiving a patent * * * by reason of the same having been patented in a foreign country more than six months prior to his *application*, provided that the same shall not have been introduced into public and common use in the United States prior to the *application* for such patent"; whereas the Act of 1870 provides that "no person shall be debarred from receiving a patent for his invention or discovery * * * by reason of its having been first *patented* or caused to be patented in a foreign country."

It seems to us impossible to come to any other conclusion than that the prior foreign patent which was to be taken into the account was not limited to a patent that had been procured at any time prior to the application for the American patent, but that the foreign patent to be taken into account was one which had been first obtained from a foreign country. In other words, the date of application for the American patent under the Act of 1839 is material; under the Act of 1870 it is entirely immaterial, and the statute shows evidence that any reference to the application was designedly omitted.

The Act of 1870 is substantially the same in legal effect as Section 4887 of the Revised Statutes. The latter statute is more express and definite in the framing of its second clause, but its meaning is substantially the same. There are two subjects comprehended under Section 6 of the Act of 1839 and Section 4887. The first branch relates to the effect of the introduction into use in this country of an invention patented abroad prior to the application for a patent for the same invention in this country. In this particular the rights of patentees in this country based upon previously obtained foreign patents were greatly enlarged by the Act of 1870. Surely this was the fruit of design. By the Act of 1839 any public and common use in the United States for however short a period prior to the application for the American patent would be a bar to its grant, but by the Act of 1870 the public use may be free and unrestricted for any period less than two years before the application.

The second subject comprehended in both sections is the effect of the previously obtained foreign patent upon the duration of a subsequently obtained United States patent. In the one case the period ot duration was measured by a fixed number of years dating from the publication of the foreign patent. In the latter case, the duration is coextensive with the foreign patent. It cannot be said that as to this latter clause the rights of this class of patentees were curtailed. If the foreign patent were previously obtained in Russia, or in any other country granting patents for periods of more than seventeen years, the United States patent would run its full legal period ; but if the foreign patent, at the election of the American applicant, was obtained for a period of only five years, then the life of his American patent would be curtailed as the result of his own act.

The meaning of the Act of 1870 and of Section 4887 has been judicially construed at the circuit in the case of *Bate Refrigerating Co.* vs. *Gillette*, 13 Fed. Rep., 553, by Judge NIXON. In this case the court says :

> "We do not see how any language could have been employed that would more clearly express the legislative design that the life of the domestic patent should expire with the term of any outstanding patent. But the counsel for the complainant contended at the argument that the present case did not fall within the limitation of the statute, because the application for the United States patent was filed antecedent to the application for or the grant of the Canadian

> patent. We are at a loss to understand what the time of filing the application for the patent has to do with the matter."

And adds later, in discussing a contrary opinion by the Commmissioner of Patents:

> "But this seems to be wresting the language of the section from its plain and obvious meaning, and we are not able to follow the reasoning by which such an interpretation is reached."

Again, the same question was decided in *Gramme Electrical Co.* vs. *Arnoux et al.*, by Mr. Justice BLATCHFORD, 17 Fed. Rep., 839, in which the following language occurs:

> "It is contended for the defendant that, under the foregoing provisions, No. 120,057 expired either on December 30, 1871, or on December 30, 1880, the date of the expiration of the Austrian patent, accordingly as that patent is to be regarded as a patent for one year or for ten years. To this the plaintiff replies that the application for No. 120,057 was filed before the application for the Austrian patent was filed. But the date of the application for No. 120,057 cannot affect the question. Under the Act of 1870 a patent takes effect from the time when it is granted, and cannot be antedated. The meaning of Section 25 of the Act of 1870 is that the United States patent shall expire at the same time with the foreign patent having the shortest time to run which was granted before the United States patent was granted, and not that it shall expire at the same time with the foreign patent having the shortest time to run which was granted before the time when the application for the United States patent was made."

It may indeed be argued as a matter of proper policy that Congress ought not to have made the duration of a United States patent depend upon the life of a previously granted foreign patent for the same invention in case the application for the patent in this country was made prior to the application for the foreign patent. There is no reason, however, in the nature of things, why such should be the law unless Congress so chooses to declare it. The statute is within the knowledge of every one, and every patentee can, in the light of the statute, protect himself against a shortening of the United States patent by exercising reasonable care in the prosecution of a patent for the same invention in a foreign country.

In case it were the fact that the language of Section 4887 would work an unreasonable hardship upon patentees in this country, then it would be a proper subject for Congressional relief. It would also furnish an inducement to a court of last resort to endeavor to gather from the whole statute a legislative intent which would not work such hardship. But in truth no such hardship is occasioned. Under the provisions of Section 4885 an applicant for a patent is allowed fully six months after his application has been passed for issue before he is required to make his invention public by paying his final fee and taking his parchment. During all that time the description of his invention remains in the secret archives of the Patent Office and is inaccessible to the public. Having ascertained, after a crucial investigation on the part of the Patent Office, covering an inquiry into all previous domestic and foreign patents on the same subject, what the scope of his invention can legally be, he has the opportunity, during the period of six months, to make application for Letters Patent in foreign countries, and, as he has the power to take his patent from the United States Patent Office on any date which he may select out of the regular days of issue during such six months, he can easily so time the issue of his American patent relatively to the issue of his patents from foreign countries as to escape any curtailment of the period of life of his patent in this country.

So far as Canada is concerned, even this is not necessary, for the inventor may there file his application at any time within twelve months after taking a patent elsewhere without in any way shortening the term of his Canadian patent. (Rec. p. 44). If he chooses to first patent in Canada, it was at his option, before the Act of 46 Vict., c. 19, to take his patent for fifteen years, and thus shorten the life of his American patent by only two years.

The Act of 1870 was not a Mere Revision of the prior Statutes.

It is undoubtedly true that the same presumption of intention on the part of the legislature to alter the existing law does not arise in case the previous work of legislation was limited to a mere revision or codification of prior statutes, as distinguished from a declared intention to amend a pre-existing statute. If, however, in the case of a mere revision of a body of law the language employed in a particular statute is so palpably different from the phraseology of a former Act, and especially if there be considerable omissions from the old law and considerable new matter introduced into the new statute, then it is clear evidence of an intent on the part of the legislature to amend the prior statute. It is always proper, in construing a statute, the language of which is ambiguous or or doubtful, to refer to the antecedent statutes which the new Act displaces, in order to ascertain from a survey of all the pertinent facts the legislative intent. In the present case the rule of this court in respect to ascertaining the meaning of ambiguous language in a revision, stated in *Meyer* vs. *Car Co.*, 102 U. S.. 111, has no application to the present case, for the reason that the language of Section 4887 is not only free from all ambiguity, but because a comparison of its phraseology with that of Section 6 of the Act of 1839 makes it clear that the language employed in the section was not the result of blunder or an accident, but was intentional and designed.

The Act of 1870 was, as its title expresses, "To revise, consolidate and *amend* the statutes relating to patents and copyrights." Moreover, the Act of 1870 in its last section (Sec. 111) repeals in express terms the Act of 1839.

The Argument that it is the policy of our Patent System to Discriminate in favor of American Citizens against Foreigners.

We submit that it is plain that whatever may have been a former policy, since the Act of 1870 there is no distinction whatsoever made between citizens of the United States and foreigners as to their rights in acquiring and holding Letters Patent for inventions which are to promote the progress of the useful arts in this country.

By the Act of 1790 (1 Stats., 109) there is no restriction as to the rights of an alien to acquire Letters Patent which does not equally apply to a citizen.

By the Act of 1793 (1 Stats., 318) there was a discrimination in favor of citizens, and the privilege of procuring patents was limited to citizens of the United States.

By the Act of 1800 (2 Stats., 37) the privileges of the Act of 1793 were extended to aliens who at the time of petitioning for patents for their inventions had resided for two years within the United States.

The effect of the proviso of the first section of this Act was to prevent any person, citizen or foreigner, from obtaining a patent in the United States in case the same invention had been previously patented by the applicant in a foreign country. The words of the proviso which would operate to create this bar against obtaining a United States patent for an invention previously patented in a foreign country, are :

> "*Provided always* that every person petitioning for a patent for any invention, art, or discovery pursuant to this Act, shall make oath or affirmation before some person duly authorized to administer oaths, before such patent shall be granted, that such invention, art, or discovery hath not to the best of his or her knowledge and belief been known or used either in this or any foreign country, and that every patent which shall be obtained pursuant to this Act for any invention, art or discovery which shall afterwards appear to

> have been known or used previous to such application for a patent, shall be utterly void."

It was held in *Shaw* vs. *Cooper*, 7 Peters, 316, that after the passage of this Act, citizens and aliens were placed substantially upon the same ground.

> "In either case, if the invention was known or used by the public before it was patented, the patent is void. In both cases the right must be tested by the same rule."

By the Act of 1832, (4 Stats., 577) the privileges of the Act of 1800 were extended to every alien who at the time of petitioning for a patent was a resident in the United States and had declared his intention to become a citizen thereof.

By the Act of 1836 (5 Stats., 117) all distinctions as to the right to procure Letters Patent between citizens of the United States and foreigners were abolished, except that foreigners were required to pay a larger government fee than was required of citizens, and aliens were required to put their inventions on sale on reasonable terms within eighteen months from the date of their patents.

By the Act of 1861 (12 Stats., 246) all laws previously in force fixing the rates of Patent Office fees to be paid, and discriminating between the inhabitants of the United States and those of other countries which should not discriminate against the inhabitants of the United States, were repealed. (Sec. 10.)

In no subsequent legislation has any discrimination been made between citizens and foreigners in any particular whatsoever, either as to the terms upon which their patents could be procured, or as to the conditions under which the rights secured by such patents were to be enjoyed.

The Bar against procuring an American Patent in consequence of a Foreign Patent for the same invention having been first obtained.

It appears from a review of the previous Patent Acts that from the Act of 1793 down to the Act of July 4, 1836, the procurement of a patent in a foreign country was a bar to the granting of a patent for the same invention in this country. The Act of 1836, Section 8, raised this bar to the extent of allowing a person who had previously taken out Letters Patent in a foreign country to receive a lawful patent in the United States, provided he applied for the same within six months after the publication of the foreign patent. By the Act of 1839, Section 6, the bar was still further raised by allowing a party who had procured a foreign patent to receive a lawful patent in this country upon an application made more than six months after the publication of the foreign patent, but in such case a limitation was imposed upon the life of the patent of fourteen years from the date of the foreign patent. But the patent would not be valid in case the invention had come into public and common use in the United States for any period of time, however short, before the application for the patent.

By the Act of 1870 and the Revision of 1873 this still existing bar was qualified by allowing a person who had procured a patent from a foreign country to receive subsequently a lawful patent in the United States, notwithstanding that the invention had been in public use in this country before his application for any period less than two years. In this respect the privilege of such patentees was enlarged by making the period of public use depend upon proof of a definite period of its existence. The further change was introduced of requiring the American patent to expire at the same date with the previously procured foreign patent. The Act of 1839 required that the foreign patent should have been procured prior to the application for the American patent. By the Act of 1870 this requirement is withdrawn, and in place of it the priority of the foreign patent in date relatively to the United States patent when issued is the material fact.

Sections 4886 and 4887.

It has sometimes been argued that there was a direct conflict between Sections 4886 and 4887. There is no such supposed conflict. The former section allows an original and first inventor to procure a patent unless it shall appear that it had been patented by some other person, or described in some printed publication prior to his invention. Section 4887 is to be read in connection with the preceding section, and the two sections together describe the two classes of persons who are authorized to receive Letters Patent; that is to say, any applicant, being an original inventor, who has not previously obtained a foreign patent for his invention, shall be entitled to receive a patent, unless it appears that his invention had been previously known or used by others in this country, or patented as the invention of some other party in this or a foreign country. Again, any original inventor, notwithstanding that he has first obtained a patent abroad, shall be entitled to receive a patent in this country under the conditions and for the period specified in Section 4887.

We have already shown that there is no hardship which results to a patentee who desires to patent his invention in a foreign country, in view of the privilege and the protection afforded to him by Section 4885. Neither is it true that if the construction contended for by the appellee to be given to Section 4887 is approved by this court, a hardship will result by reason of a foreign inventor obtaining a patent abroad for the same invention. Section 4887 clearly relates to a foreign patent previously obtained by the applicant for a patent from the United States. If knowledge of the invention set forth in the American application be surreptitiously obtained and made the subject of a patent in a foreign country by another party, the true inventor is not prejudiced, under the doctrine of this court in *Kendall* vs. *Winsor*, 21 How., 322, and of Judge SHEPLEY in *Kendrick* vs. *Emmons*, 9 O. G., 201.

If the argument on the part of the appellant be, that the fact that Bate applied for a Canadian patent after filing his application for an American patent is clear evidence of an intent that the Canadian patent should be later in date than his American patent, and that the circumstance that the patent issued more promptly from the Canadian

Patent Office than it issued from the United States Patent Office ought not to prejudice him, then we reply that it was the duty of Bate to know the law upon the subject, and that he must be presumed to contemplate the possible consequences from his act of filing an application in the Canadian Patent Office before his patent in the United States had been passed to issue and the six months period of grace provided in Section 4885 had commenced to run. Again, for this supposed argument on the part of the appellant to have any force, it must go to the extent of claiming that the fact whether the application for the patent was first made in the United States or in a foreign country is the test whether Section 4887 should apply to the United States patent, or not. This test, if held conclusive, would necessitate, in a case where the United States patent was the first in date, the conclusion that it had terminated in case a patent had been procured of later date for the same invention in a foreign country, in the event that it should appear that the application for such later foreign patent was in fact made prior to the application for the domestic patent. On the theory that the time of the making of the application should govern, it is plain that the conclusion above stated must logically follow, and it can hardly be supposed that any court would be willing to so strain the language of the statute as to invalidate a domestic patent by the fact of the expiration of a subsequently granted foreign patent, with no other guide to such conclusion than that which Section 4887 and the Acts relating to patents in this country can afford.

It is a proper exercise of the judicial function for a court of last resort to read into a statute words which are plainly required in order to make a particular section consonant with other portions of the same act *in pari materia*, and where a literal construction would render the section absolutely nugatory. An instance of the application of this rule is found in *Pennock* vs. *Dialogue*, 2 Peters, 1, in which case the words "not known or used before the application" were interpreted to mean, not known or used by others before the application, and for the reason that if the words were literally construed, it would be impossible for an original inventor to procure a patent under Section 1 of the Act of 1793 then in force, inasmuch as the ability to apply for a patent presupposes a prior knowledge on the part of the inventor himself of the thing which he was required by law to describe. In this case the rule, where such necessity arises, is fully stated by Mr. Justice STORY in delivering the opinion of this court.

> "We are not at liberty to reject words which are sensible in the place where they occur, merely because they may be thought in some cases to import a hardship or tie up beneficial rights within very close limits. If an invention is used by the public with the consent of the inventor at the time of his application for a patent, how can the court say that his case is nevertheless such as the Act was intended to protect? * * * In such a case, if the court could perceive no reason for the restrictions, the will of the legislature must still be obeyed. It cannot and ought not to be disregarded where it plainly applies to the case. * * * It is not wholly insignificant in this point of view that the first Patent Act passed by Congress on this subject (Act of 1790, ch. 34), which the present Act repeals, uses the words "*not known or used before*," without adding the words "*the application*," and in connection with the structure of the sentence in which they stand might have referred either to the time of the invention or of the application. The addition of the latter words in the Patent Act of 1793 must therefore have been introduced *ex industria*, and with the

> **cautious intention to clear away a doubt and fix the original and deliberate meaning of the legislature."**

The appellee invokes the application of the principles enunciated in this early case in the interpretation of the meaning of Section 4887. The appellee denies that it is necessary, in order to make the section intelligible or sensible as a piece of legislation, that any words should be interpolated into the section which should restrict the prior "foreign patent" referred to in the section to one which had been granted previous to the application in the United States for a patent for the same invention. The appellee insists that the language of the section is plain and free from the least ambiguity as to its meaning, and that no hardship whatever is worked, as the result of the interpretation contended for by the appellee, upon any person who desires to patent an invention both in foreign countries and in the United States.

BENJ. F. THURSTON,

GEORGE H. LOTHROP,

Of Counsel for the Appellee.

[illegible] Supreme Court U. S.
FILED
DEC 2 1888
JAMES H. McKENNEY,
Clerk.

In the Supreme Court of the United States.

THE BATE REFRIGERATING COMPANY,
Appellant,

vs.

GEORGE H. HAMMOND & CO.

No. 862 substituted for No. 145.

Argument in Support of Position taken by Appellees.

JOHN R. BENNETT,
Counsel for GILLETTE *et al.* and appellees
and JOSEPH EASTMAN.

LIVINGSTON MIDDLEDITCH, Printer, 26 Cortlandt St. (Law Telephone 505.)

> cautious intention to clear away a doubt and fix the original and deliberate meaning of the legislature."

The appellee invokes the application of the principles enunciated in this early case in the interpretation of the meaning of Section 4887. The appellee denies that it is necessary, in order to make the section intelligible or sensible as a piece of legislation, that any words should be interpolated into the section which should restrict the prior "foreign patent" referred to in the section to one which had been granted previous to the application in the United States for a patent for the same invention. The appellee insists that the language of the section is plain and free from the least ambiguity as to its meaning, and that no hardship whatever is worked, as the result of the interpretation contended for by the appellee, upon any person who desires to patent an invention both in foreign countries and in the United States.

BENJ. F. THURSTON,

GEORGE H. LOTHROP,

Of Counsel for the Appellee.

Office Supreme Court U.S.
FILED
DEC 2 1888
JAMES. H. McKENNEY,
Clerk.

In the Supreme Court of the United States.

THE BATE REFRIGERATING
COMPANY,
Appellant,

vs.

GEORGE H. HAMMOND & CO.

No. 862 substituted
for No. 145.

Argument in Support of Position taken by Appellees.

JOHN R. BENNETT,
Counsel for Gillette *et al.* and Appellees
and Joseph Eastman.

Livingston Middleditch, Printer, 26 Cortlandt St. (Law Telephone 505.)

In The Supreme Court of the United States.

OCTOBER TERM, 1888.

No. 862.

THE BATE REFRIGERATING COMPANY,
Appellant,

vs.

GEORGE H. HAMMOND & COMPANY.

Argument in Support of Appellee's Contentions.

May it Please the Court :

The purpose of this appeal is to have this Court review the opinion of his Honor Judge Nixon, given in the cause of the Appellant against Gillette & others (13 Federal Reporter, pp. 553–559), pending in the Circuit Court for the District of New Jersey, holding that the United States patent issued to Bate, November 20, 1877, No. 197,314, was subject to the provisions of Section 4887 of the Revised Statutes, and to have expired January 9th, 1882, with the expiration of the Canadian patent issued to the said Bate, for the same invention, January 9th, 1877, No. 6938, for the term of five years from the date thereof—that being the term in force when the United States patent was issued. In arriving at that conclusion—the question being presented on petition praying for the dissolution of the injunction theretofore issued—Judge Nixon was required to construe, for the first time, Section 4887 of the Revised Statutes, and he held that the provisions of that section extended to a United States patent, the application for which was filed before, but the patent issued subsequent to the issuance of a foreign patent to the same inventor, for the same invention, and that in such a case the United States patent expired with the said foreign patent; the controlling and determining date being the date of the United States patent, and not the date of the filing of the application for the United States patent.

Subsequently, owing to the illness of Judge Nixon, the same questions were, on another petition, in the same cause, presented to Mr. Justice Bradley, who, after hearing extended argument thereon, said:

> "But I am very urgently pressed, in the argument of the able counsel for the "complainant, to revise the rulings of Judge Nixon, and to take up the case *ab integro*, both as to the construction of section 4887 Rev. St. U. S., in reference to the "time when a foreign patent must have been granted in order to affect the term of "an American patent, and as to the time when the Canadian patent took effect, so "as to have any operation under our law; and, finally, as to the term of the Canadian "patent,—whether it was for five years or fifteen years,—especially in view of the "amendatory act of May 25, 1883."

The two latter contentions were thus disposed of:

> "I may say at once that I attach no importance to the last mentioned act" (Canadian amendatory act of May 25, 1883). "The American patent received its "operative force and effect on the day it was issued, and no subsequent legislation in "Canada or elsewhere could change it, whatever might be the effect of such legislation where made. The force and effect of the American patent could only be "affected by the Canadian patent as the latter stood when granted, and not as it was "afterwards modified by legislation.
>
> "I may also say that I entirely agree with Judge Nixon in his view of the Canadian patent, that it took effect at its date, January 9, 1877, and not at the time of "filing the model in 1878. It was granted on the ninth of January, 1877, after "which time the patentee could take it out of the office whenever he chose to file the "model. The term of the patent commenced to run at its date; and I agree with "Judge Nixon that the term was for only five years, which expired in January, 1882, "notwithstanding the privilege which the patentee had of continuing it for a longer "period."

In disposing of the first contention—as to the construction of Section 4887,—he said:

> "I feel constrained, sitting at the circuit, to follow the law of the case as held by "Judge Nixon, especially as his judgment has been followed in other circuits."

* * * * * * *

> "Therefore, without having come to any decided conclusion on the question in "hand, considered as an original one, I feel bound to follow the previous rulings of this "Court, confirmed as they are by those of other circuit courts, as safe precedents, until "the law shall be differently settled by the appellate tribunal."
>
> (31 Fed. Rep., pp. 809-816, Aug. 9, 1887.)

The bill in this cause was filed on the 16th day of December, 1886, and thereafter, the defendants availing themselves of the ruling of Judge Nixon, that the Bate patent had expired, filed a plea denying the jurisdiction of the Circuit Court, which plea was sustained by his Honor, Judge Colt, for the reason set forth in the rescript filed by him September 24, 1887:

> "The questions raised under the stipulation in this case having recently been decided by Mr. Justice Bradley in favor of the defendant in the suit by this complainant "v. Gillett and others, in the Circuit Court for the District of New Jersey, and both "parties desiring to appeal the case to the next term of the Supreme Court, a "decree may be entered sustaining defendant's plea and dismissing the bill." (Rec. p. 17).

And from the decree entered in accordance therewith this appeal is taken.

So that it appears, as to the construction of Section 4887, that both Mr. Justice Bradley and Judge Colt followed "the law of the case as held by Judge Nixon," and that this appeal involves the correctness of Judge Nixon's interpretation of the law.

The questions raised by this appeal, and which I assume will be presented to this Court for its determination, have been thus enumerated by Mr. Justice Bradley:

> 1. "As to the construction of Section 4887, Rev. St. U. S. in reference to the time "when a foreign patent must have been granted in order to affect the term of an "American patent."
>
> 2. "As to the time when the Canadian patent took effect, so as to have any oper- "ation under our law."
>
> 3. "As to the term of the Canadian patent—whether it was for five years or fif- "teen years—especially in view of the amendatory act of May 25, 1883."

And I shall consider them in that order, and under those heads.

The facts upon which those questions arise are recited at length, and with great accuracy in the petition filed in the cause of this appellant against Gillett and others, printed at p. 113 of the Record; being the petition upon which these questions were presented to Mr. Justice Bradley.

As to the Construction of Section 4887.

Is Judge Nixon's interpretation of that section its true interpretation?

I shall insist that it is, although it has been termed a "misinterpretation without judicial reason." I shall certainly not be wanting in respect if I assume that his Honor Judge Nixon's interpretation of that section will receive the very greatest consideration from this Court, especially since it is the interpretation of a Judge of the greatest learning and experience, and has been followed and approved by other Judges in well considered cases. Certainly this Court will not reject that interpretation unless it is clearly erroneous.

It is to be noted, that it is nowhere asserted that Judge Nixon's interpretation is not warranted by, and in exact accordance with, the wording of the section. But, it is said, or was said, on the argument before Mr. Justice Bradley, that

> "the only light in which Judge Nixon viewed or considered this Section 4887 was the "grammatical one,"

which resulted in his giving to the section a literal interpretation, entirely overlooking, and not in harmony with the intention of Congress as manifested by the previous legislation *in pari materia*. It is against the grammatical and literal interpretation of the section in question that counsel for the appellant are contending, and it was even admitted by Mr. Seward (one of the counsel for the appellant) in the argument before Mr. Justice Bradley, that

> " by a literal construction of this section, it can be read so as to make it adverse to this " (his) argument, and to the interpretation which we (they) hope your Honor will " clearly see your way to reach ;"

that is, that a literal construction leads to the construction given to the section by his Honor, Judge Nixon, which, I contend, is its true construction.

As I understand the argument of the counsel for the appellant, they are contending for an interpretation based solely upon supposed considerations and intention of Congress as manifested, not by the language of the section in question, but by the previous legislation *in pari materia*, and to escape the effect of Judge Nixon's interpretation, they argue that his interpretation was arrived at without taking those matters into consideration. Such, however, is not the case, as clearly appears from a reading of Judge Nixon's opinion, and Mr. Justice Bradley's interpretation of that opinion. The fact is that every question that is here presented, and every argument here advanced in support of the appellant's contentions, were there presented and advanced, and were considered and determined by his Honor, Judge Nixon, and such is Mr. Justice Bradley's interpretation of Judge Nixon's opinion.

The opinion of Judge Nixon, after reciting the facts, says :

> " The case obviously turns upon the question whether the invention was patented " in Canada previous to the issuing of the patent in the United States, in the sense in " which the word *patented* is used in Sec. 4887 of the Revised Statutes, the limitation " of the statute being applicable only in such a case.
>
> " The provisions of the section are as follows :
>
> " ' No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first " ' patented or caused to be patented in a foreign country, unless the same has been " ' introduced into public use in the United States for more than two years prior to the " ' application. But every patent granted for an invention which has been previously " ' patented in a foreign country shall be so limited as to expire at the same time with " ' the foreign patent, or, if there be more than one, at the same time with the one " ' having the shortest term, and in no case shall it be in force more than seventeen " ' years."
>
> " The phraseology here used materially differs from the previous legislation on the " subject. The power of the Commissioner of Patents is defined and abridged. Where " a foreign patent has been granted for the same subject matter, he is expressly required to limit the term of the domestic patent to the period of time that the foreign " patent has to run ; or, if there be more than one, then to make it expire at the same " time with the one having the shortest term. We do not see how any language could " have been employed that would more clearly express the legislative design, that the " life of the domestic patent should expire with the term of any outstanding foreign " patent."

Even at this point it appears that Judge Nixon did consider the prior legislation on the subject, and that he did interpret the section in view of the previous legislation *in pari materia*, for he distinctly states :

> "The phraseology here used materially differs from the previous legislation on "the subject;"

showing that he had before him the previous legislation on the subject, and interpreted the section in view thereof. He found, however, as is the fact, that the phraseology used in section 4887 differed very materially from the corresponding sections in the previous legislation, and it is that difference which makes section 4887 a very different section, in its meaning and effect, from the corresponding sections on the same subject in all previous legislation

In all previous legislation on this subject, the date of the filing of the application for the United States patent was made the controlling and determining date, because it was so stated; whereas, in the present section, the date of the issuance of the patent is made the determining and controlling date, because it is so stated.

In section 6 of the Act of 1839, it was stated:

> "by reason of the same having been patented in a foreign country more than six "months prior to his application;"

whereas, in section 4887, it is stated:

> "by reason of its having been first patented, or caused to be patented in a foreign "country,"

the change consisting in the introduction of the word *first*, and the omission of the words,

> "more than six months prior to his application;"

and it is to those changes that his Honor Judge Nixon there refers; and he so states, later on in his opinion.

To show the marked character of the change in phraseology referred to by Judge Nixon, I have grouped together the clause from Section 6 of the Act of 1839, and that from Section 4887, of the Revised Statutes, printing in red those words found in the former, and omitted in the latter, and in blue those words found in the latter, and not found in the former:

*** * * BY REASON OF THE SAME ITS HAVING BEEN FIRST PATENTED OR CAUSED TO BE PATENTED IN A FOREIGN COUNTRY MORE THAN SIX MONTHS PRIOR TO HIS APPLICATION. * * ***

The foregoing illustration demonstrates, not only the marked character of the change, but the absolute intention of Congress to make that change. This change first appeared in Section 25 of the Act of 1870, which is the basis of Section 4887 of the Revised Statutes, and had it not been the intention of Congress to change the law there would be no necessity whatever for the change in phraseology, especially when it is evident that Congress had before it, at the time, Section 6 of the Act of 1839.

The opinion proceeds:

> "But the counsel for the complainant contended on the argument that the present "case did not fall within the limitation of the statute, because the application of the "United States patent was filed antecedent to the application for, or the grant of, the "Canadian patent;"

precisely as is here contended on the part of the appellant.

In disposing of that contention, **JUDGE NIXON** said:

> "We are at a loss to understand what the time of filing the application for the "patent has to do with the matter. It is true that the 8th Section of the Act of 1836, "and the 6th Section of the Act of 1839, made the date of filing the specifications and "drawings, in the one case, and the date of the application for the home patent, in "the other, the point of time from which to reckon the six months intervening between the issue of the foreign and domestic patent. It is also true that by Section "4886, and the first clause of Section 4887, of the Revised Statutes, an inventor is required to file an application for his patent within two years after his invention or "discovery has been in public use, or on sale, from all of which the late Commissioner "of Patents (Payne) was led to the opinion that the word 'previously,' used in the "last clause of Section 4887, had reference to the time prior to the filing of the application, rather than to time prior to the granting of the patent (see 17 Off. Gaz., 330). "But this seems to be wresting the language of the Section from its plain and obvious "meaning, and we are not able to follow the reasoning by which such an interpretation is reached."

It was the opinion of Judge Nixon that the reading of the Section was so plain and obvious that nothing was left for interpretation, and that to adopt the interpretation contended for, and that had been given to the Section by the Commissioner of Patents (Payne) would be

> "wresting the language of the Section from its plain and obvious meaning,"

which he was prohibited from doing under the rule as repeatedly announced by this Court.

This Court said, in the case of the United States *vs.* Union Pacific Railroad, 91 U. S., p. 72:

> "The act itself speaks the will of Congress, and this is to be ascertained from the "language used,"

which is to be taken in its

> "natural and obvious sense;"

and the language of Section 4887 was so taken by Judge Nixon, he declining—as this Court did in the case referred to—to give to the language used a forced or unnatural construction.

Said this Court, in dealing with that question:

> "But this is extending, contrary to all legal rules, the operation of words "by a forced construction beyond their real and ordinary meaning. Courts "cannot supply omissions in legislation, nor afford relief because they are supposed "to exist. 'We are bound,' said Justice Buller in an early case in the King's Bench, "'to take the act of Parliament as they have made it: a *casus omissus* can in no "'case be supplied by a Court of law, for that would be to make laws; nor "'can I conceive that it is our province to consider whether such a law that has "'been passed be tyranical or not.' *Jones* v. *Smart*, 1 T. R. 44–52.
>
> "Lord Chief Baron Eyre, in *Gibson* v. *Minet*, 1 H. Bl., 569–614, said, 'I venture "'to lay it down as a general rule respecting the interpretation of deeds, that all "'latitude of construction must submit to this restriction; namely, that *the words* "'*may bear the sense* which by construction is put upon them. If we step beyond

> " 'this line, we no longer construe men's deeds, but make deeds for them.' This
> " rule is as aplicable to a statute as to a deed."

On the argument before Judge Nixon, the opinion of the Commission of Patents, in *ex parte* Mann, 17 Off. Gaz., 330, was cited in support of the contention that the date of application and not the date of the patent was made the controlling and determining date under section 4887, and the same case is cited in support of the contention here made on the part of the appellant. It was in reference to the interpretation of that section, as announced by the Commissioner of Patents in that case, that Judge Nixon said—

> " but this seems to be wresting the language of the section from its plain and obvious
> " meaning, and we are not able to follow the reasoning by which such an interpreta-
> " tion is reached."

Nor will this Court be able to follow the reasoning by which that interpretation was reached, since I believe a careful reading of that opinion will satisfy this Court that the construction given by the Commissioner of Patents to the section is erroneous, and is not to be followed; and it never has been followed. It was not even followed by the Patent Office, for within a few months after the retirement of Commissioner Payne, the question was reconsidered by his successor, in connection with the then Secretary of the Interior and the Attorney General, and the section read and applied as subsequently interpreted by Judge Nixon.

Commissioner Payne, in interpreting the section seems to have been guided almost entirely by what he considered would be the hardships of the case and the difficulty of the Patent Office in executing its provisions, and not by the language of the section itself. In fact, he admits that if the section is to be considered by itself, and given a literal interpretation, Judge Nixon's interpretation is the only one of which it is susceptible.

He says:

> " The last clause of Sec. 4887, standing alone, is evidently susceptible of such an
> " interpretation as would restrict the American patent to the term of the foreign pat-
> " ent if the American patentee had obtained his foreign patent after his American
> " application was filed, but before his American patent was granted."
>
> " Such is its meaning if the word 'previously' refers to time anterior, not to the
> " filing of the application, but to the grant of the patent."

That the word "previously" does refer to "time anterior" to the grant of the patent, and not to the filing of the application, seems to me to be beyond question. How can it be said to refer to "time anterior" to the filing of the application when no reference whatever is made to the filing of the application in that clause of the section? It is neither mentioned, nor made a determining date for any purpose. True, the word "application" is used in the preceding clause of the section, but only with reference to the statutory bar created by more than two years public use, the language being:

> " Unless the same has been introduced into public use in the United States for " more than two years prior to the application;"

which was taken from section 4886.

The Commissioner continues :

> " This may be the more obvious meaning of the clause when separated from its " context. But the statute as a whole shows, I think, that the word 'previously ' here " used refers to the time prior to the filing of the application."

An admission that "the more obvious meaning of the clause" refers to "time anterior" to the grant of the patent; to overcome which he goes beyond the language of the section, using the words "statute as a whole," but he does not explain why he thinks the word "previously" refers to time prior to the filing of the application, nor in what part of " the statute as a whole" he finds authority or justification for such a conclusion. Certainly no such authority is found in any of the preceding sections referred to in the opinion.

In justification of his most unnatural interpretation of the section, he says :

> "A literal construction of the clause would restrict the American patentee to the " term of the foreign patent granted after the American application was filed, but before the American patent was granted, even if the American patentee had no connection directly or indirectly with the foreign patent ;"

Clearly an erroneous statement, for such would not be the case if the American patentee had no connection directly or indirectly with the foreign patent. It would only be the case where the foreign patent was for the same invention and by the same inventor, and by him patented or caused to be patented in a foreign country. Where the American application was filed before the grant of the foreign patent for the same invention by a *separate and independent inventor* the American applicant would be the prior inventor, and subsequent acts by others would in no way affect his rights to a patent, nor would the term of his patent, when granted, be restricted or limited by such foreign patent ; but no such question could possibly arise where the American application and the foreign patent are for the same invention, by the same inventor.

I submit that the last statement quoted from the opinion clearly shows that the Commission was laboring under a misapprehension, and that his conclusion was arrived at by a total disregard for the language of the section ; but the most convincing fact of the unsoundness of the Commissioner's reasoning is found in this statement :

> " So construed as to limit the American patent to the term of the foreign patent " granted after the American application was filed, the paragraph is obviously repugnant to Sec. 4886, which does not permit a foreign patent to bar the grant of an " American patent for seventeen years to the foreign patentee, or to any one else, if " the foreign patent is not granted until after the American application is filed."

So construed, however, the paragraph is not repugnant to section 4886, as that section merely specifies when the invention is patentable, and when found to be so, that the inventor may, upon due proceedings had, obtain a patent therefor; but the term for which the patent shall be granted is a very different matter indeed, and is fixed either by section 4884 or section 4887; and no difference for what term the patent is granted, whether for a longer or shorter term, it would in no way interfere with, or be repugnant to the provisions of section 4886; nor is there any authority for the statement that

> " section 4886 does not permit a foreign patent to bar the grant of an American
> " patent for seventeen years to the foreign patentee or any one else, if the foreign patent
> " is not granted until after the American application is filed,"

as that section makes no reference whatever to foreign patents, except where the invention has been patented by others before the date of the supposed invention upon which the American application is based.

Under section 4886, a foreign patent to the inventor who has applied for a patent for his invention in this country is no bar to the grant of an American patent

> " unless the same has been in public use or on sale for more than two years prior
> " to his application, or should prove to have been abandoned;"

but the term for which a patent shall be granted is a subsequent matter.

If he obtains his foreign patent prior to obtaining his United States patent, then the United States patent comes within the limitations of section 4887, and expires with the foreign patent; but if he obtained his United States patent prior to obtaining his foreign patent, then the United States patent does not come within the provisions of section 4887, and is for the term of seventeen years, as provided for in section 4884.

That the Commissioner had no conception as to the true meaning of sections 4886 and 4887 is shown by the following statement in his opinion:

> " If an American patent is not restricted to the term of a foreign patent granted to
> " a different patentee after the American application is filed, certainly an American
> " patent should not be restricted to the term of a foreign patent granted to the same
> " patentee after the American application is filed, for if an American application
> " is not to be prejudiced by a foreign patent to an independent inventor, he clearly
> " ought not to be prejudiced by a foreign patent to himself."

The reason why an American patent is not restricted to the term of a foreign patent granted to a different inventor after the American application is filed, is due to the fact that they are to different inventors, and thus the question of priority of invention is presented, and the American application being filed first, creates a presumption of priority of invention as against a foreign patent of subsequent date. But where the foreign patent and the American application are for the same invention, and by the same party, the question of priority of invention of course cannot arise. This fact seems to have been entirely overlooked by the Commissioner.

There can be no doubt as to what prompted the Commissioner,
interpreting the section as he did, for he says:

> “ If the last clause of section 4887 is to be literally construed, the attempt as a pa
> “ of the practical execution of the law, to refer in American patents to forei
> “ patents granted before and up to their dates would, of course, be ineffectual.
>
> * * * *
>
> “ Its object seems to be to relieve citizens of the United States from monopoli
> “ from which foreigners are exempt. But in that view the statute is a failure. I
> “ object is only effected when the foreign monopoly is secured first. If the inventi
> “ is absolutely free in every other country, or if the foreign patent is obtained last, t
> “ monopoly here is complete.”

The Commissioner seems to have thought that if he construed se
tion 4887 to mean precisely what it says, it would be impossible f
him to carry out its provisions in the granting of patents, thereb
admitting that the literal construction of the section referred to th
date of the grant, and not to the date of the filing of the applic
tion, and that where the inventor had patented, or caused to b
patented, his invention in a foreign country, before issuanc
of his American patent, the American patent is to be so limite
as to expire with the foreign patent, and if there be more tha
one such prior foreign patent, to expire with the one having th
shortest term.

The difficulties of properly executing the law, which the Commis
sioner said would result from literally construing the section—an
which appears to have been his only reason for not properly constru
ing it—were overcome by his successor, as clearly appears from th
correspondence between Commissioner of Patents Marble, and th
then Secretary of the Interior, Mr. Kirkwood, copy of which corres
pondence I shall annex; for they not only literally interpreted th
section, but put that interpretation into practical execution, withou
the least difficulty, and it has so remained to the present day.

That the question as to the proper interpretation of section 488
was fully and carefully considered by Commissioner of Patents Mar
ble and the Secretary of the Interior, advised by the Attorney Gen
eral, clearly appears from the correspondence referred to.

It was never held by the Patent Office, except in *ex parte* Mann
that under section 4887, the date of the application was the deter
mining date; on the contrary, the date of the issuance of the pat
ent was always held to be the determining date, as appears from
the statement:

> “ the construction now put upon the statute is the construction it received since i
> “ was enacted, except during a short interval of the term of my predecessor, Mr. Com
> “ missioner of Patents, Payne. I will state, however, that Mr. Commissioner Payn
> “ addressed to me a letter within one month after he retired from office, stating tha
> “ he believed his construction of section 4887 was erroneous.”

In the letter of the Commissioner of Patents to the Secretary o
the Interior, dated March 17, 1882.

Had the Commissioner of Patents (Payne) omitted from consid-
eration, as did Judge Nixon, the possible consequences of a litera

interpretation of the section in question, he would not have given it the erroneous interpretation which he did. As to any supposed consequences, inconveniences and hardships that have or may result from a literal interpretation of the section, the responsibility rested solely with Congress.

It was stated by this Court in United States *v.* Union Pacific Railroad, 91 U. S. p. 91 :

> " Counsel have dwelt with special emphasis upon the consequences which would " result from a decision adverse to the appellant. We cannot consider them in dis- " posing of the question arising upon this record. The rights of the parties rest upon " a statute of the United States. Its words, as well as its reason, spirit and intention, " leave, in our opinion, no room for doubt as to its true meaning. We cannot sit in " judgment upon its wisdom or policy. When we have interpreted its provisions, if " Congress has power to enact it, our duty in connection with it is ended."

In this case we are left to judge of the intention of Congress by the language used, and the presumption is that Congress chose the most suitable language at its command for properly expressing its true intention, and in interpreting that chosen language, the words used should be given their ordinary meaning. So, judging of the intention of Congress, and interpreting its chosen language, it would seem that Judge Nixon's interpretation of the section in question is its true interpretation. Rarely, indeed, is the true intent and meaning of Congress so clearly expressed as in this section. It is a clear and positive statement of the legislative intent, that a United States patent issued subseqent to the issuance of a foreign patent for the same invention, to the same inventor, should be subject to and expire with such foreign patent, and the language used admits of no other interpretation. To interpret the section as asked for by the appellant, and as interpreted by Commissioner of Patents Payne, it is necessary not only to " wrest the language of the section from its plain " and obvious meaning "—using the language of his Honor Judge Nixon—but to import into the section words which are not there, and which a careful consideration of the previous legislation *in pari materia* shows it was the intention of Congress to exclude, and the fact is that with the acts of 1836 and 1839 before it, Congress did exclude the very words which you are now asked to read into section 4887, in order to give to it the interpretation contended for by the appellant. If the previous legislation throws any light on the legislative intent, it is in favor of Judge Nixon's interpretation of the section.

I have no hesitation in basing my argument upon Judge Nixon's interpretation of the section, for if Judge Nixon's sound reasoning will not satisfy and convince this Court as to the correctness of that interpretation of the section—which I insist is its true interpretation, it is scarcely possible that I can add anything that will.

If, however, anything further is needed to so satisfy and convince this Court, it will be found in the opinion of Mr. Justice Blatchford, given in the case of *Gramme Electrical Co.* v. *Arnoux & Hochhausen Electric Co.*, 17 Fed. Rep. pp. 838–841, where, subsequently, and upon substantially the same state of facts, he was called upon to, and did, interpret section 25 of the Act of 1870, which is the basis of section 4887 of the Revised Statutes, giving to that section the same interpretation as Judge Nixon had given to the section of the Revised Statutes.

True, Mr. Justice Blatchford did, in the Gramme case, approve of Judge Nixon's interpretation of section 4887, but he did not "adopt" it, in the sense that he followed it without coming to a decided conclusion for himself. It clearly appears from the opinion that he approved of Judge Nixon's interpretation of the section, because, upon investigation he found it to be its true interpretation, and that, having himself interpreted section 25 of the Act of 1870, he found Judge Nixon's interpretation of the section of the Revised Statutes, based thereon, in harmony with his construction.

In the Gramme case, the patent was granted under the provisions of the Act of July 8, 1870, and the United States patent, although applied for before, was issued after the issuance of the foreign patent, and Mr. Justice Blatchford was called upon to interpret for the first time section 25 of that Act. After quoting that section, he said :

> " It is contended for the defendant that, under the foregoing provisions 120,057
> " expired, either on December 20, 1871, or on December 30 1880, the date of the expira-
> " tion of the Austrian patent, accordingly as that patent is to be regarded as a patent
> " for one year or for ten years. To this the plaintiff replies that the application for
> " No. 120,057 was filed before the application for the Austrian patent was filed. But
> " the date of the application for No. 120,057 cannot affect the question. Under the
> " Act of 1870 a patent takes effect from the time when it was granted and cannot be
> " antedated. The meaning of section 25 of the Act of 1870 is that the United States
> " patent shall expire at the same time with the foreign patent having the shortest
> " time to run, which was granted before the United States patent was granted, and
> " not that it shall expire at the same time with the foreign patent having the shortest
> " time to run, which was granted before the time when the application for the United
> " States patent was made. *Bate Refrigerating Co.* v. *Gillett,* 13 *Fed. Rep.* 553."

Such is the accepted interpretation of section 25 of the Act of 1870, and section 4887 of the Revised Statues at the present day, and in accordance with which the Patent Office has been, and is now, administering the law.

A careful reading of the brief for Appellant discloses no reason why this Court should not accept Mr. Justice Blatchford's and Judge Nixon's interpretations of Section 25 of the Act of 1870, and Section 4887 of the Revised Statutes, and no attempt is made to point out wherein their interpretations are incorrect.

I respectfully insist that Mr. Justice Blatchford's interpretation of section 25 of the Act of 1870, and Judge Nixon's interpretation of section 4887 of the Revised Statutes are the true interpretations, and as such should be adopted by this Court.

Coming now to a consideration of the question as to the true interpretation of section 4887, apart from the opinions of Mr. Justice Blatchford in the Gramme case, and Judge Nixon in the Gillett case, I would first call your attention to the previous legislation on the subject, recognizing, as I do, the rule that in arriving at the true interpretation of a statute, all statutes *in pari materia* are properly to be considered. No useful purpose, however, will be served by referring to the legislation on the subject of patents prior to the year 1836, as the Act of 1836 was the grouping together of all prior legislation, with suitable amendments and additions. It is worthy of note, however, that the Act of 1836, as the embodiment of our patent laws, to that date, was largely copied after the English patent law, and that subsequently, when the English law was amended, our law was thereafter amended to largely correspond.

In England, prior to 1623, all letters patents and grants of privieges were for a term of twenty-one years, and such patents and rivileges were granted alike to subjects and aliens. By the Statute f Monopolies (21 James I., 3, 1623) it was enacted that all Letters atent and grants of privileges should thereafter be for a term of ourteen years, and all such patents and privileges were for

> " The sole working and making of any manner of new manufactures within this realm to the true and first inventor or inventors of such manufactures which others at the time of making such letters patent and grants shall not use."

nd this without reference to whether the inventor had or had not btained a patent for his invention beyond the realm, the essential onditions being that he was the "true and first inventor" and that is invention was not in use "at the time of making such letters atent and grants." If the applicant was the "true and first inventor" and his invention was not in use "at the time of making such letters patent and grant" he received a patent for the term of fourteen years, and this whether he was a subject or alien. No attention seems to have been paid to the acts of the true and first inventor or inventors beyond the realm, nor was the term of the English patent in any way limited by either the prior or subsequent acts of the inventor beyond the realm. The English patents were for a term of fourteen years, alike to subjects and aliens, without limitation or restriction.

Thus the English law remained from 1623 until 1835, when the Statute of Monopolies was amended so as to provide for the extension of English patents for a further term of seven years from and after the expiration of the original term of fourteen years, and authorizing and empowering the Crown, upon proper petition and showing to grant such extensions.

No further amendment of material consequence was made to the Statute of Monopolies from 1835 until 1852, when a substantially new Patent Law was enacted, known as the Patent Law Amendment Act of 1852, which contained the following:

> " 25. Where, upon any application made after the passing of this Act, letters patent " are granted in the United Kingdom for or in respect of any invention first invented " in any foreign country, or by the subject of any foreign power or state, and a " patent or like privilege for the monopoly or exclusive use or exercise of such invention in any foreign country is there obtained before the grant of such letters patent " in the United Kingdom, all rights and privileges under such letters patent shall (not-

> " withstanding any term in such letters patent limited) cease and be void, immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such foreign country shall continue in force, or where more than one such patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges: Provided always, that no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid, shall have been obtained in any foreign country, and which shall be granted in the said United Kingdom, after the expiration of the term for which such patent or privilege was granted, or was in force, shall be of any validity."

Our Patent Law has its origin in that provision of the Constitution which provides:

> " Congress shall have power to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to the respective writings and discoveries,"

and the first exercise of that Constitutional power by Congress was the Act of 1790, entitled "An Act to promote the progress of useful Arts." By that provision of the Constitution the power of Congress to promote the progress of science and useful arts is limited to the granting of monopolies for a limited time to authors and inventors for their respective writings and discoveries. While it gave to Congress the power to promote, it limited the exercise of that power to inventors for their own inventions. It is a positive constitutional requirement that patents granted under the provisions of the Acts of Congress must be to inventors for their own inventions and discoveries, and it would be a clear violation of that provision of the Constitution for Congress to authorize the granting of a patent to other than inventors for their own inventions. Hence in determining the right of a party to a patent, the inquiry is, Is he the inventor of that for which he desires to secure a patent?—and his right to receive a patent for his invention or discovery is to be determined by his status at the date of his invention; and this without reference to the conditions which Congress may prescribe as necessary to be performed in order to secure a patent for an invention or discovery, and to the term for which the patents shall be granted.

The inchoate right to a patent is created with the invention or discovery, and therefore the inventor's right to receive a patent is to be determined by his status at that date.

Having made an invention or discovery, the inventor is undoubtedly vested with an inchoate right to obtain a patent; but the obtaining of a patent, and its term, depends entirely upon his thereafter complying with the requirements of the law. He must not only make an application, but his application must be in proper form, and he must have complied with the other requirements of the law, whereupon the "Commissioner shall issue a patent therefor."

While it is undoubtedly true that the date of the invention is *prima facie* the date of the application, nevertheless, the controlling date is the date of invention, and the inventor's right to a patent is to be determined by his status at that date. That date may, or may not, be the date of his application; usually it is a much earlier date and the inventor is to show the actual date of invention.

Both by the Constitution, and all subsequent legislation, an inventor's right to receive a patent is to be determined by his status at the date of his invention. He may forfeit his right to receive a patent, and that forfeiture may be created by reason of his acts subsequent to the date of his invention and prior to the date of his application, the date of the application being made the determining date for that purpose; but his inchoate right to receive a patent springs from, and is to be determined by, his status at the date of his invention.

The act of 1836, following closely after the English patent law, provided that patents should be for a term of fourteen years, subject to an extension of seven years; and this right was given alike to citizens and aliens, the only distinction made being in the fees to be paid:

> "if he be a citizen of the United States, or an alien and shall have been resident in "the United States for one year next preceding, and shall have made oath of his "intention to become a citizen thereof, the sum of thirty dollars; if a subject of the "King of Great Britain, the sum of five hundred dollars; and all other persons the "sum of three hundred dollars."

It was further provided that if the invention

> "had been patented or described in any printed publication in this or any foreign "country,"

it was a bar to the grant of a patent; with a proviso:

* * * * * * *

> "But nothing in this Act contained shall be construed to deprive an original and "true inventor of the right to a patent for his invention by reason of his having pre-"viously taken out letters patent therefor in a foreign country, and the same "having been published at any time within six months next preceding the filing of "his specification and drawings."

Under that proviso, the existence of a foreign patent was no bar to the grant of a United States patent if the application for the United States patent was filed within six months from the date of the publication of the foreign patent; otherwise the existence of the foreign patent was a complete bar to the grant of a United States patent; precisely as was the case under the English law, and under our Act of 1800. So that under the Act of 1836, the determining point was made the date of "the filing of his specification and drawings," and there was no limitation by reason of the existence of a prior foreign patent. All patents were for fourteen years, and the right to a patent was absolutely lost by the existence of a prior foreign patent unless the application for the United States patent was filed within six months from the date of the publication of such foreign patent, and thus the law remained until amended by the Act of 1839.

By that amendment the six months limitation was removed, and the right to receive a patent no longer barred by the existence of a prior foreign patent, only the term of the patent was limited to expire with such prior foreign patent :

> "Section 6 * * That no person shall be debarred from receiving a patent for any
> " invention or discovery, as provided in the act approved on the fourth day of July,
> " one thousand eight hundred and thirty-six, to which this is additional, by reason of
> " the same having been patented in a foreign country more than six months prior to
> " his application : Provided, That the same shall not have been introduced into
> " public and common use in the United States, prior to the application for such
> " patent : And provided also, that in all cases every such patent shall be limited tc
> " the term of fourteen years from the date or publication of such foreign letters
> " patent."

The object of this amendment was to remove the bar which existed under the Act of 1836, and to permit an inventor to obtain a patent for his invention in this country at any time during the existence of his foreign patent, so long as his United States patent expired with the existing term of his foreign patent, and in no case to exceed the limit of fourteen years.

Here again the date of the application was made the determining date ; so that a United States patent, first applied for but issued subsequent to the issuance of the foreign patent, was not subject either to the provisions of Section 6 of the Act of 1836, or Section 6 of the Act of 1839. Only such United States patents as were applied for after the publication of the foreign patent were subject to the provisions of those sections and their term limited in accordance therewith.

It is to be observed that under the Act of 1839, while a United States patent applied for and issued subsequent to the foreign patent was made to expire with the foreign patent, thus simultaneously terminating the monopolies both here and in the foreign country, yet, if no foreign patent was obtained, the citizens of this country were subject to the monopoly for fourteen years, while during the same period, the use of the invention was absolutely free in the foreign country. So that, at that early date, we find that what must have been the object of Section 6 of the Act of 1839, viz., to have the monopoly terminate here with its termination in a foreign country, was defeated in all cases where the invention was not patented in a foreign country, for in all such cases there at no time existed a monopoly in the foreign country, while one did exist here for a period of fourteen years. Nor did the Act of 1839 make any provision for more than one foreign patent.

In 1852 the English law was amended by the addition of the above quoted twenty-fifth section, and there, for the first time, it was provided that a patent granted for a foreign invention so to speak, and first patented in a foreign country, should expire upon the expiration or other determination of such foreign patent, and where there was more than one foreign patent, to expire with the foreign patent first expiring.

This section of the English law was under consideration in the case of Daw *v*. Eley, L. R. 3 Eq. 496, and in speaking of its purpose, Vice Chancellor Wood said :

> "Now, in looking at Section 25, one sees at once that the object was to prevent the subjects of this kingdom from being fettered in their right to compete with each other in the production and manufacture of different articles, when it was open to foreigners to enter into such competition without being fettered with any exclusive rights claimed by an inventor and patentee, or by the additional price which must be imposed upon the article in consequence of the patent right. The object, I say, is to prevent the English manufacturer from being fettered while the foreigner remains free. The provision was, singularly enough, not pursued to its proper logical consequence in the Act, which only deals with the case in which a foreign patent has been granted and determined ; whereas if no foreign patent has ever been granted any number of foreigners may be manufacturing the article abroad, while English manufactures might be exposed, by the existence of a patent in this country, to the very difficulty from which this very section professes to relieve them. It does undoubtedly appear very harsh to prevent the English mauufacturer from having the benefit of manufacturing that which all the rest of the world can manufacture at their pleasure, and yet to say that if it is protected for a certain limited time abroad, then, and then only, when that protection has ceased shall the English manufacturer become free. However, that is the statute."

This is precisely what has been, and no doubt will be said as regards section 4887 of the Revised Statutes. Nevertheless, the answer to it is as stated by Vice Chancellor Wood—"However, that is the statute."

By the Act of March 2, 1861, it was provided :

> "That all patents hereafter granted shall remain in force for the term of seventeen years from the date of issue, and all extension of such patents is hereby prohibited."

In the case of De Florez *v*. Reynolds, 17 Blatch., p. 437, this provision of the Act of 1881, and its effect upon sections of the Act of 1839, was considered by Mr. Justice Blatchford, and he held that the effect of the 16th section, taken in conection with the 17th section, was not to repeal section 6 of the Act of 1839, but only to so modify it that United States patents granted subject to its provisions, were to remain in force for seventeen years from the date of the prior foreign patent. He said :

> "What is 'the date of issue?' Under Section 8 of the Act of 1836, in force when the Act of 1861 was passed and when the patents in this case were issued, the patent could 'take date' from a date earlier, though not exceeding six months earlier, than the 'actual issuing of the patent.' The actual date of issuing was one thing, one date. The date from which the patent took date, or its term began to run, was another thing, another date. The latter date may very properly be called 'the date of issue.' Such latter date need not, necessarily, be a date expressed on the face of the patent. Under section 6 of the Act of 1839 such latter date is 'the date or publication' of the foreign patent. Looking at the state of legislation before 1861 and at the evident scope of section 16 of the Act of 1861 as aimed at extensions of patents, it would be reasonable to say that 'the date or publication" of the foreign patent spoken of in section 6 of the Act of 1839 might be regarded, in reference to patents issued under such section 6 (as the one in this case was), as 'the date of issue" intended by section 16 of the Act of 1861, the date from which, under such circumstances, the United States patent is to take its departure. And that, as before in practice, United States patents were granted for fourteen years, and patents for inventions previously patented abroad to the same inventor were before limited to fourteen years from the date or publication 'of the foreign patent,' so now, under the new system introduced

"by the act of 1861 such a patent (still to be granted, otherwise, in accordance with "the provisions of the Acts of 1836 and 1839) was to remain in force for seventeen years "from 'the date of publication' of the foreign patent, while the United States patents "were to remain in force for 17 years instead of 14 years from their 'date of issue,' "the privilege of having them 'take date" from a date not exceeding six months prior "to the actual issue, as the 'date of issue,' under section 8 of the Act of 1836, being still "preserved and such patents expiring seventeen years from such 'date of issue,' and "not 17 years from the actual issuing. There is nothing in these "views that is inconsistent with or does violence to the language of section "16 of the Act of 1861, and they are in harmony with the course "of legislation. Contrary views would determine that there was, by "section 16 of the Act of 1861, a sudden, unexpressed and only implied change of the "policy of section 6 of the Act of 1839, then in force for 22 years; such policy making "the terms of patents, like those in the present case, take date from the date of "publication of the foreign patent, and run from that time for the same time other "United States patents ran, from their time of beginning to run. And such contrary "views would establish an enlargement of term, by the Act of 1861, in favor of an "invention previously patented abroad; such enlargement remaining in force till 1870, "and then curtailed in 1870, so as to be more narrow than under the act of 1839, and "to make the United States patent expire at the same time with the foreign patent "having the shortest term."

It was his opinion that the contrary view, viz., that all patents were to remain in force for seventeen years from the date of issue, the effect of which would have been to enlarge the term in favor of an invention previously patented abroad, was inconsistent with the subsequent legislation, wherein the term in favor of an invention previously patented abroad was made narrower than under the Act of 1839; the force of which is, as I understand it, that the tendency of legislation has been to curtail, rather then enlarge the term of patents granted for inventions first patented in a foreign country; and such undoubtedly has been the course of all legislation subsequent to 1836.

Not until the Act of 1870, which was "An Act to Revise, Consolidate and amend the Statutes relating to Patents and Copyrights," were provisions similar to those contained in Section 25 of the English Act of 1852 incorporated into our patent laws. Section 25 of the At of 1870 provides:

"That no person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first "patented or caused to be patented in a foreign country: *Provided*, the same shall "not have been introduced into public use in the United States for more than two "years prior to the application, and that the patent shall expire at the same time with "the foreign patent, or, if there be more than one, at the same time with the one having the shortest term; but in no case shall it be in force more than seventeen years;"

and it undoubtedly had its origin in Section 25 of the English Act of 1852. As Section 25 of the English Act of 1852 introduced a new policy into the English patent law, so did Section 25 of our Act of 1870 introduce a new policy into our patent law.

By the Act of 1870, all existing laws on the subject of patents were repealed, and whereas under section 8 of the Act of 1836 and Section 6 of the Act of 1839, the controlling and determining point was the date of the application, under Section 25 of the Act of 1870, the date of the issuance of the patent was made the controlling and determining date, and the United States patent, without reference to the date of the application, was made to expire at the same time with the prior patent having the shortest term. As section 8 of the Acts of 1836 and section 6 of the Act of 1839 referred to an inventor who had previously patented his invention in a foreign country, so does section 25 of the Act of 1870 refer to an inventor who has previously patented his invention in a foreign country.

Judge Wallace said, in *Canan* v. *Pound Mfg. Co.* (23 Fed. Rep. 185), when speaking of section 25 of the Act of 1870:

> "Section 25 relates to the rights which may be acquired by an inventor or discov-
> "erer who has previously patented his invention in a foreign country."

That a change was intended in the policy of the law is clearly shown by the change in phraseology; otherwise, why the necessity for the change, and why not a reiteration of the language of section 8 of of the Act of 1836 and section 6 of the Act of 1839, which very clearly made the date of the filing of the application the determining and controlling date? Instead of which they introduce the word "first" before the word "patented," so it would read, "having been first patented," and omit the words "more than six months prior to his application."

This Court said, in St. Paul Plow Works, *v.* Starling, 127 U. S., 377, where the expression

> **"actions, suits, controversies and cases arising under any law of the United States "granting or confirming to inventors the exclusive rights to their inventions or dis- "coveries,"**

in the Act of 1836 had been changed, in the Act of 1870, to

> **"any action, suit, controversy or case at law or in equity touching patent rights."**

and in the Revised Statutes,

> **"in any case touching patent rights,"**

speaking through Mr. Justice Grey—:

> **"But in the Act of 1870, as in the Revised Statutes, Congress, while using similar "language in defining the jurisdiction of the Circuit Court, substituted (it must be "supposed purposely) the new phrase 'touching patent rights,' in defining the juris- "diction of the Court."**

And in the case of section 25, of the Act of 1870, Congress changed (it must be supposed purposely) the phraseology, the result of which was a change in the law.

It was said by Judge Shipman, in *Weston* v. *White*, 13 Blatch. 564:

> **"The act of July 8, 1870, 16 U. S. Statutes at Large, 198, introduced a new princi- "ple, and provided that the American patent should expire at the same date with "the foreign patent, but should not exceed a term of seventeen years;"**

a new principle, changing all pre-existing statutory provisions in that respect.

It was also said by the late Mr. Justice Clifford in the case of *Goff v. Stafford*. 14 *Off. Gaz.*, 748, in construing the Act of 1861, that the Act of July 8, 1870, changed the Act of 1861 and was different from all pre-existing statutory provisions as to American patents being limited by prior foreign patents. And of this there can be no doubt, since the sole purpose of section 25 of the Act of 1870 was to introduce a new policy and effect a radical change in the law as it existed under the Acts of 1836, 1839 and 1861.

As early as September 19, 1870, section 25 of the Act of 1870, received the attention of the Patent Office in re Robert Mushet, for extension (Commissioner's Decisions of 1870, p. 106). The then Commissioner of Patents, Mr. Fisher, said:

> “The Act of July 8, 1870, section 25, reads as follows:” (Quotes the section) * * “but the clause of the act of 1870, under consideration, presents another question of a different character. * *
>
> “The intention of Congress obviously was to obtain for this country the free use of the inventions of foreigners as soon as they became free abroad. This is indicated by the use of the phrase ‘first patented’ or caused to be patented in a foreign country” for it was presumable that American citizens would obtain their first patent here, while a foreigner would first patent his invention in his own country.
>
> “The statute was designed to prevent a foreigner from spending his time and capital in the development of an invention in his own country, and then coming to this to enjoy a further monopoly when the invention had become free at home. The result of such a course would be, that, while the foreign country was developing the invention and enjoying its benefits, its use could be interdicted here; while, if the term of the monopoly could be further extended here, the market could be controlled long after the foreign nation was prepared to flood this country with the unpatented products of the patented process.”

In October, 1870, the same section was again before the then Commissioner of Patents, Mr. Fisher, *in re Ward* (Commissioner's Decisions of 1870), and again *in re Boyer*, Administrators of Evans, deceased (Commissioner's Decisions of 1870, pp. 30), when the then Commissioner of Patents, Mr. Fisher, said:

> “In the case of Mushet it was a foreign inventor, and in the case of Ward an American inventor, who were seeking the extension: but in both cases letters-patent were first obtained in the foreign country. Section 25 of the act of July 3, 1870, is as follows:
>
> Quotes section:
>
> “I was and am of the opinion that the policy which Congress plainly declares in this section is that if a foreigner obtain a patent in his own country and permits it to expire there, it shall also expire in this country, so that the right to use the invention without liability to the inventor shall be simultaneous in this and in the most favored foreign nation * * *
>
> “It is urged, however, that Congress intended only to reach the case of the foreign inventor who first patented his invention in his own country, and that they did not intend to put the American inventor who obtained a patent abroad in a worse position than if he had obtained no patent at all in a foreign country. It is said, with much force, that if the American patentee had not obtained an English or French patent the invention would be free in those countries, even during the lifetime of his original patent, and that the fact that it was free there would be no bar to the grant of an extension.
>
> “This may be true, but we have no means of judging of the intention of Congress in this case, except by the language employed in the declaration of their will. The language of the statute is, ‘first patented, or caused to be patented, in a foreign country.’ This, by its terms, includes American citizens as well as foreigners who

> "*first* take out a patent abroad. The term 'patented' may well be construed as apply- " ing to foreigners obtaining patents, in their own country, and the phrase, 'caused to " be patented,' to such persons, not citizens of the same country, including Americans, " as should cause their inventions to be introduced or patented there. It does not in- " clude either foreigners or citizens who first obtain their patents in this country. It " was supposed that American inventors would first obtain their patents here, in which " case they would not have been within the terms of the section, but if, on the other " hand, they chose to obtain patents abroad before doing so in their own country, they " were to be placed upon the same platform as the foreign patentee.
>
> " It is reasonable to suppose that the inventor will follow up his earliest patent with " the greatest vigor, and that, other things being equal, he will protect his invention " first in that country where he expects to make the most use of it. If, therefore, the " American inventor chooses to exhibit this preference for a foreign country, and to " give them the first information respecting his invention, and the earliest opportunity " of using it, the law makes no distinction between him and the foreign inventor who " obtains his first patent at home.'

The soundness of this reasoning will, I feel satisfied, commend itself to this Court. It certainly is a very clear exposition of the section in question. Under Mr. Commissioner Fisher's interpretation of the section the date of the patent is made the controlling and determining date; and from that time until the decision of Mr. Commissioner Payne in *ex parte Mann* decided in 1880, the practice of the Patent Office was in accordance with that interpretation, and the most diligent research has failed to find that a different interpretation was given to that section prior to the decision in *ex parte Mann*, or that the practice of the Patent Office was other than in accordance therewith.

As has been repeatedly said by this Court the interpretation given to the law by an officer charged with its administration is " entitled " to the most respectful consideration, and ought not to be overruled " without the most cogent reasons."

I know it is contended on the part of the appellant that the practice of the Patent Office, prior to Judge Nixon's interpretation of the section in October, 1882, was otherwise, that is, in accordance with the interpretation contended for by the appellants, that the date of application is the controlling and determing date. No decision of the Patent Office prior to *ex parte Mann*, decided in 1880, is cited in support of that contention. Reference, however, is made to the rule of the Patent Office, promulgated in 1881, that " an applicant whose " invention has been patented abroad should state the fact that a " foreign patent has actually been obtained, giving its date, and if " there be more than one, the date of each;" which rule was thereafter repeated each year until 1878. But that rule does not support the contention on the part of the appellant, nor does it in any way tend to show the interpretation of the section acted upon by the Patent Office. That rule would be a perfectly proper rule under either interpretation of the section. Of course the Patent Office could only call upon an applicant at the date of his application to state if he had at that time actually obtained a foreign patent or patents for his invention, and if so, to so specify; and in so doing the Office certainly did not indicate its interpretation of the section. In fact the Patent Office at that date could not call for any other information since the fact that the applicant may have made application for foreign patents was a matter of no moment, and he could not well say that he should obtain a foreign patent before the grant of his United States patent. The law under either interpretation made no reference to the date of the filing of an application for a foreign patent; the only reference made was to the foreign patent.

In November, 1881, the following rule was promulgated:

> "In every original application the applicant must distinctly state under oath "whether the invention has been patented to himself or to others with his consent "or knowledge in any country, and if it has been, the country or countries in which "it has been so patented, giving the date and number of each patent, and that it has "not been patented in any other country or countries than those mentioned, and that "according to his knowledge and belief the same has not been in public use in the "United States for more than two years prior to the application in this country."

And this, too, after the Patent Office had reversed the interpretation given to the section by Mr. Commissioner Paine; and such I understand to be the present rule. It may also be said that the present rule, like the rule promulgated in 1871, would be just as applicable under either interpretation of the section.

In June, 1884, the Act of 1870, was repealed by the Revised Statutes, Section 25 of that act having been incorporated into the Revised Statutes as Section 4887. That section is:

> "No person shall be debarred from receiving a patent for his invention or discovery, "nor shall any patent be declared invalid by reason of its having been first patented, "or caused to be patented in a foreign country, unless the same has been introduced "into public use in the United States for more than two years prior to the application. "But every patent granted for an invention which has been previously patented in a "foreign country shall be so limited as to expire at the same time with the foreign "patent: or, if there be more than one, at the same time with the one having the "shortest term; and in no case shall it be in force more than seventeen years."

True there are a few slight verbal differences,—and differences in punctuation—between the wording of this section and Section 25 of the Act of 1870, but their provisions are the same. This Court so said in the case of *Siemens v. Sellers*, 123 *U. S. p.* 284; and it was so held by Mr. Justice Blatchford in the case of the *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co. and another*, 17 Fed. Rep. 838.

A reading of the sections together will show the differences both in wording and punctuation. The words and punctuation-marks printed in blue indicate those found in section 25 of the Act of 1870 and omitted from section 4887 of the Revised Statutes, while those printed in red indicate the words found in section 4887 and not found in section 25 of the Act of 1870.

THAT NO (NO) person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented in a foreign country; **PROVIDED THE** (UNLESS THE) same **SHALL NOT HAVE** (HAS) been introduced into public use in the United States for more than two years prior to the application, (BUT EVERY PATENT GRANTED FOR AN INVENTION WHICH HAS BEEN PREVIOUSLY PATENTED IN A FOREIGN COUNTRY SHALL BE SO LIMITED AS TO) and that the patent shall expire at the same time with the foreign patent, or, if there be more than one at the same time, with the one having the shortest term; **AND** (BUT) in no case shall it be in force more than seventeen years.

Apart from these slight changes, there is the same difference between section 4887 of the Revised Statutes and section 8 of the Act of 1836, and section 6 of the act of 1839, as there is between section 25 of the Act of 1870, and section 8 of the Act of 1836, and section 6 of the Act of 1839.

It is immaterial what may be the effect of the slight differences in wording between section 25 of the Act of 1870, and section 4887 of the Revised Statutes, since the questions here presented are to be determined solely by section 4887 of the Revised Statutes, as that was the section in force when the Bate patent was applied for and granted.

It was said by this Court in *U. S.* v. *Bowen*, 100 U. S., 508, speaking through Mr. Justice Miller:

> "The Revised Statutes must be treated as the legislative declaration of the statute "law on the subjects which they embrace on the first day of December, 1873. When "the meaning is plain the Courts cannot look to the statutes which have been re-"vised to see if Congress erred in that revision, but may do so when necessary to "construe doubtful language used in expressing the meaning of Congresss."

There is no doubtful language used in section 4887 in expressing the meaning of Congress, and consequently there exists no reason or authority for recourse to the original law. Certainly the old law cannot be resorted to for the purpose of changing the language. And yet such is the argument of the counsel for the appellant. They are not asking to have language, the meaning of which is in doubt, construed, but to have that which was in the Acts of 1836 and 1839, and intentionally omitted from the Act of 1870 and the Revised Statutes, read into section 4887 so as to give it an entirely different meaning from that given to it by the language used. The section of the Revised Statutes is expressed in clear, concise and intelligible language, leaving nothing for interpretation. That Congress did intend to take away the benefit of the date of application specified in the Acts of 1836 and 1839, and the subsequent provisions of the Act of 1870 and section 4887 is clearly shown by the change in language; and this Court has repeatedly said that change in language indicates a change of intention.

If section 4887 means precisely what it says it refers solely to the date of the grant of the United States patent, and the Bate patent is subject to its limitations and consequently expired at the same time with the term of the Canadian patent in force at the date of the grant, to wit, January 9th, 1882.

The section refers to United States patents granted for an invention which has been "previously patented in a foreign country" by the same inventor; and by "previously patented" is meant previous to the date of the grant of the United States patent for the same invention, and without reference to the date of the application; the words "previously patented" referring to the preceding words "patent granted" in the same sentence. Some benefit will undoubtedly be derived by first considering the provisions of the preceding sections 4884 and 4886.

Section 4884 relates to the contents and duration of patents and provides that every patent shall contain "a grant to the patentee, his heirs or assigns, for the term of seventeen years;" certainly seventeen years from the date of the grant, and not from the date of the application. And when the patent is issued it contains a grant for the term of seventeen years, not from the date of the filing of the application, but from the *date of the grant.*

Section 4886 relates to what inventions are patentable, and is as follows:

> "Any person who has invented or discovered any new and useful art, machine, "manufacture or composition of matter, or any new and useful improvement thereof, "not known or used by others in this country, and not patented or described in any "printed publication in this or any foreign country, before his invention or discovery "thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the "fees required by law, and other due proceedings had, obtain a patent therefor."

"May obtain a patent" depending, of course, upon his making an application and complying with the other requirements of the law; but if the invention has been "in public use, or on sale for more than two years prior to his application," his right to a patent is barred, notwithstanding the fact that he may be the true, original and first inventor, and that the same "was not known or used by others in this "country and not patented or described in any printed publication in "this or any foreign country *before his invention or discovery* "*thereof.*" The words of the section "not patented or described in "any printed publication in this or any foreign country before his "invention or discovery thereof" refer to what has been done by OTHERS "*before his invention.*"

If, however, the invention has been patented or described in this or any foreign country "*before his invention,*" then he is not THE *inventor* and does not come within the provision of the constitution entitling him to a patent.

But such is not the case if the invention has been patented or described in a printed publication in this or any foreign country by the inventor himself, since his right to a patent is in no way affected by such action on his part unless his invention has been in public use or on sale for more than two years prior to his application, or is proved to have been abandoned by him. This section makes no provision for anything transpiring subsequent to the date of the invention upon which the application is based except as to public use and sale and abandonment of the invention. Nor has the section any reference to the term for which a patent shall be granted—the term being fixed by section 4884—the concluding clause of the section being: "May, upon payment of the fees required by law and "other due proceedings had, obtain a patent therefor;" without reference to the term for which the patent is to be granted.

If upon an application filed the applicant is found to be the inventor, and his invention patentable, the provisions of this section would be complied with by the mere issuance of a patent, without reference to its term.

Considering sections 4884 and 4886 alone, if an application for a patent was made for an invention, which answered the requirements of section 4886, a patent would thereupon issue for a term of seventeen years from the date of its grant, in accordance with section 4884, notwithstanding the fact that the inventor may have first patented his invention in a foreign country. The bar created is by reason of its being patented, or described in any printed publication before the applicant's invention or discovery.

Thus we see that sections 4884 and 4886 make no provision for inventions first patented in a foreign country by the applicant for a United States patent, nor is his right to a patent in any way affected, or its term limited by such action on his part. This however is expressly provided for by section 4887, which relates to acts of the inventor subsequent to the date of his application.

That section is composed of two parts. The first part:

> "No person shall be debarred from receiving a patent for his invention and discovery, nor shall any patent be declared invalid, by reason of its having been first "patented or caused to be patented in a foreign country, unless the same has been "introduced into public use in the United States for more than two years prior to the "application,"

is a statement of the negative of section 4886, with the added clause taken from section 4887: "Unless the same has been introduced into "public use in the United States for more than two years prior to "the application;" which under all circumstances constitutes a statutory bar to the grant of a patent.

The only reference there made to the date of application is as to the two years' public use, the reason for inserting which is quite obvious, as otherwise, if the inventor first patented his invention in a foreign country, it would seem to relieve him from the statutory bar created by public use or sale in the United States for more than two years prior to his application ; it was to guard against such a possibility.

So plain is the wording of the first part of this section that do argument should be needed to show that the determining point is the date of the grant, and not the date of the application. The language is "by reason of its having been first patented or causeed to be patented in a foreign country," and applies to all United States patents granted for the same invention which has been first patented or caused to be patented in a foreign country by the same inventor. The fact that the application is filed prior to the grant of the foreign patent does not relieve the United States patent granted subsequent to the date of the foreign patent from the provisions of this clause of the section, as at the date of the grant of the United States patent the same invention had been *first patented or caused to be patented in a foreign country* by the same inventor. Were it otherwise or intended to be otherwise, it certainly would have been so expressed.

It is not to be doubted that Congress well knew the difference between the date of application and the date of grant, and that it did, is shown by the reference to the other sections of the Revised Statutes wherein the distinction is several times drawn. Had Congress intended the determining point to be the date of application, it would have been so expressed, and the clause made to read, "*by reason of* its having been patented or caused to be patented in a foreign country *prior to his application for a patent, unless,*" etc. There was no reason whatever for the addition of the word "first" to, and the omission, of the word "application" from that clause, except for the purpose of fixing the date of the grant as the determining point as to what patents are within its provisions.

The second part, or concluding clause of the section:

> "But every patent granted for an invention which has been "previously patented in a foreign country shall be so limited as to expire at the same time "with the foreign patent, or if there be more than one, at the same time with the one "having the shortest term, and in no case shall it be in force more than seventeen "years."

like the first clause, is so plain and unambignous as to leave no doubt as to its proper meaning, that the determining point is, as in the first clause, the date of the grant of the patent. In this latter clause the words, "previously patented" are used in precisely the same sense as the words "first patented" in the first clause. The words "previously patented" can only refer to the preceding words "every patent granted," and neither the "patent granted" nor "previously patented" refer to the date of the application. The word "application" is not used nor referred to in this clause of the section, nor is it referred to throughout the entire section, except in the sentence "unless the same has been introduced into "public use in the United States for more than two years prior to the "application;" and certainly it cannot be argued that the words "previously patented" have any connection with, or refer to, that clause, or the word "application" used therein. The very words, "But every patent granted," as well as the punctuation of the sentence, preclude any such possibility. This latter clause is the limiting clause, and the sentence "unless", etc., has no application to this clause, which is confined to limiting the time of the "patent granted."

The omission, from the first clause of the section, of the sentence "unless the same has been introduced into public use in the United "States for more than two years prior to the application," would in no way change the meaning or construction of the section as to the determining point of what patents are included within its provisions. Leaving out that provision of the section "unless" etc.—which is taken from section 4886, and which is not pertinent to the present inquiry—it reads:

> " No person shall be debarred from receiving a patent for his invention or discovery,
> " nor shall any patent be declared invalid by reason of its having been first patented or
> " caused to be patented in a foreign country. But every patent granted for an inven-
> " tion which has been previously patented in a foreign country shall be so limited as to
> " expire at the same time with the foreign patent, or if there be more than one, at the
> " same time with the one having the shortest term, and in no case shall it be in force
> " more than seventeen years ;"

and such is its correct reading, since the provision omitted was placed there to preserve the bar created by section 4886, and it was intended to have this bar apply alike to all patents, whether the invention was first patented here or in foreign countries; hence the reason for restating that provision in section 4887.

By section 4886, an inventor was only entitled to a patent in case his invention had not been "in public use or on sale for more than two years prior to his application." In no way, short of an actual change in both the wording and punctuation of the section, is it possible to so connect the word "application" with the other language of the section as to give to it the interpretation contended for by the appellant. If it was not for the purpose of making the determining point the date of the grant, without reference to the date of the application, why did Congress insert the words "first" and "previously" in front of the word "patented," and omit the word "application"? Is there any reason other than to make the determining point the date of the grant? Had it been intended to make the date of the application the determining point, how easy it would have been to so express it; in which case it would have read: "But every patent granted for an invention " which has been patented in a foreign country prior to his appli- " cation shall be so limited as to expire at the same time with the " foreign patent," etc. Not only was the date of the grant fixed as the determining point in the first clause of the section by the insertion of the word "first," and the omission of the word "application," but the same date was fixed as the determining point in the limiting clause, and in the same way, namely, by the use of the word " previously," and the omission of the word "application." Had such not been the intention of Congress, it is impossible to conceive how all reference to the date of the filing of the application was omitted, and the words conveying an opposite meaning used.

In the case of the United States *v.* Bowen, above cited, the controversy grew out of the revisors having interpolated the word "such" between the words "all" and "pensioners," the old law reading "all pensioners," and the Revised Statutes reading "all such pensioners;" and it was there contended that the words "all such pensioners" in the Revised Statutes should be interpreted the same as "all pensioners" in the old law; in reference to which this Court said:

> "If the construction claimed by counsel for the Government be correct, that word "is useless, for it would express the idea with precision by reading, 'But all pension- "'ers shall surrender their pensions to the Soldiers' Home during the time they re- "'main therein and voluntarily receive its benefits.' The question, therefore, is "whether we shall read the section 'all pensioners' or 'all *such* pensioners.'
>
> "The word, however, as there used, has an appropriate reference to the class of pen- "sioners who have not contributed to the funds of the Institution, and no sound "canon of construction will authorize us to disregard it, when to do so changes very "materially the meaning of the section."

So here if the construction contended for by the appellant be correct, the change in phraseology in section 4887 is useless, for it would have expressed the idea with great precision by reading it precisely as it was stated in the Acts of 1836 and 1839. To disregard the change would be to change very materially the meaning of the section which would be contrary to all sound canons of construction.

Section 4887 is clearly a proviso or limitation to section 4884, and not, as has been said, a proviso added to section 4886. It has no reference whatever to section 4886, as that section has no reference to the term for which a patent shall be granted. How, then, can it be said that section 4887, which provides for limiting the term for which certain patents shall be granted, is a proviso added to a section which has no reference whatever to the term for which a patent shall be granted. By adding the limitation clause of section 4887 to section 4884, its true meaning will be at once apparent.

(Section 4884.)

Every patent granted shall contain * * a grant to the patentee, his heirs, or assigns, for the term of seventeen years.

(Section 4887).

But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years.

It is obvious that the only possible construction that can be given to section 4887 is that it refers to the date of the grant and not to the date of the application, and that "every patent granted for an invention which has" at the date of its grant "been previously patented in a foreign country" comes within its limitations. It seems to me that not even a forced construction could make the language refer to the date of the application, nor to any date other than the date of the grant.

It is impossible to see by what course of reasoning the construction contended for by counsel for the appellant can be given to the section. The only way would be to bodily interpolate into that section that which is not there, and which was never intended to be there. Appellant's contended interpretation would be legislation, not interpretation.

An extended argument is based upon the word "debarred," found in section 4887, and an attempt made to in that way connect the section with section 6 of the Act of 1839, wherein the word "debarred" first occurred, and give to it the same meaning. There is not the slightest foundation for any such argument. It is true that the word "debarred" does first occur in section 6 of the Act of 1839, and that it was very properly used, since a bar was created by section 8 of the Act of 1836; and section 6 of the Act of 1839 was to remove that bar and impose a limitation. Undoubtedly the expression, "No person shall be debarred," found its way from section 6 of the Act of 1839 into section 25 of the Act of 1870 and section 4887 of the Revised Statutes, and it may be that under the changed condition of affairs it was not the best selection of expression that could have been made.

It is said that no person was debarred. In other words that no bar had been created by the preceding sections which was removed by section 4887.

Quite true; and the purpose of section 4887 was not the removal of a bar, but the imposing of a penalty by placing a limitation upon the term of the patent where the invention was first patented in a foreign country.

Sections 4884 and 4886 provided for the granting of patents for a term of seventeen years, and section 4887 provided that while no person shall be debarred from receiving a patent, yet if he obtains his foreign patent first, the term of his United States patent shall be limited. It was equivalent to saying: You shall have a patent for seventeen years; but if you obtain your foreign patent first, you shall then only have a patent for a term equal to the term of your foreign patent. The expression "No person shall be debarred from receiving a patent" is used in no other sense.

It was like saying: I will take you to Washington for a given sum of money, and then you shall not be debarred or prevented from going to Washington for that amount; but if you ride in the parlor car, I shall charge you an additional sum. While no bar was there created to his going to Washington for the given sum, there was a penalty imposed in case he took the parlor car.

Suppose this Court should say that in every case the argument of counsel should be limited to two hours on each side; while there would be no bar to counsel's arguing the case for two hours, it would still be proper to say that counsel shall not be debarred from arguing their case; but if two counsel appear on one side, their argument shall be limited to an hour each; or if no brief is filed, counsel shall not be heard; thus permitting them to argue, but imposing a penalty. Precisely as with Section 4887 giving them a patent; not preventing or barring them from receiving a patent, but imposing a limitation upon the term if they obtain a foreign patent first. In either case a misuse of the word "debarred," but still clearly expressive as indicating, not that a bar existed, but the intention to impose a penalty.

It may very properly be said, no person is debarred from entering a theatre, but if he enters he must pay. It may be said first, all persons may enter the theatre, and then, no person shall be debarred from entering the theatre; but if the person retires before the performance is over he shall not be permitted to return. Clearly no bar was there created to the entering of a theatre, and the use of the expression "No person shall be debarred" did not so indicate; it was simply the use of an unhappy expression in imposing a penalty in case of retirement.

It is impossible to understand what force there is in the argument advanced, based upon the word "debarred," and the fact that Congress in making use of the expression "No person shall be debarred," which is found in Section 6 of the Act of 1839, indicates absolutely nothing, much less an intention to make Section 4887 the same as Section 6 of the Act of 1839.

It is admittted that the Acts of 1836 and 1839 made the date of application the determining point, for the reason that section 8 of the Act of 1836 and section 6 of the Act of 1839 expressly stated that the date of application was the determining point; but no such statement is found in section 4887. A comparison of those sections will show that section 4887 was intended to, and did, change the determining point from the date of application, as under the Act of 1839, to the date of the issuance of the patent. It is as totally different in its effect and policy from section 6 of the Act of 1839 as it is possible for language to make it. It introduced, as I have already stated, a new policy which finds no analogy in any pre-existing statutory provision. In fact, the Acts of 1839, 1861 and 1870, in their order, effected radical changes in the pre-existing provisions as to the effect of a previous foreign patent upon a subsequent United States patent for the same invention by the same inventor.

It is of no consequence what has been the construction placed upon section 4887 by patent solicitors generally, or what may be the effect upon patents obtained by them, believing in the correctess of their interpretation. If they have misconstrued the section, and based their practice upon such misconstruction, they and those for whom (acting as agents) they obtained their patents will have to accept the consequences. Still, I do not believe the practice has been to first apply for the United States patent and then to make application for the foreign patents and obtain the same pending the American application; certainly not where the invention is to be patented in the Dominion of Canada, as section 7 of the Canadian Patent Act of June 4, 1872, states:

> " But an inventor shall not be entitled to a patent for his invention if a patent there-
> " for in any other country shall have been in existence in such country more than
> " twelve months prior to the application for such Canadian patent ;"

allowing a period of twelve months from and after the issuance of the United States patent within which to apply for a patent in Canada. So, certainly, there is no reason who anyone should have pursued such a practice in obtaining a Canadian patent and taking the risks incident thereto. Why Bate did so is not apparent. That there was no necessity nor compulsion is evident from a reading of the foregoing section, which allowed him one year from and after the issuance of his United States patent within which to apply for his Canadian patent.

It is said that "section 4887 cannot properly be construed as "meaning 'previous to the American patent;' so to construe it "would open the door to fraud and unintended hardship." Certainly no such considerations will prompt this Court to give an incorrect interpretation to that section. If a proper construction of the section opens the door to fraud and unintended hardship, the remedy rests with Congress; but it seems to me that whatever hardship there may be cannot be said to be unintended in view of the very plain language used; nor is it apparent how the door to fraud would be opened by giving to the section its true interpretation.

As to the time when the Canadian patent took effect so as to have any operation under our Law.

Bate's invention was patented in Canada on the 9th day of January, 1877, which was previous to the issuance of his United States patent for the same invention, within the meaning of section 4887.

Of this there can be no doubt, as it appears upon the face of his Canadian patent that it was granted on the 9th day of January, 1877, whereas his States patent was not granted until November 20, 1877. The comparison contemplated by the section is a comparison of the date of the grant as appears upon the face of the respective patents, and does not contemplate any other comparison.

Under the Revised Statutes a patent is completed when it is signed by the Secretary of the Interior, countersigned by the Commissioner of Patents, and sealed with the seal of the Patent Office, and in law becomes a patent from and after the date of its signing, sealing and granting. The delivery of the patent is a subsequent act, and has no reference to the date of the grant and issue, nor does the date of its delivery in any way effect the date of the grant and issue, or limit the grant; in fact, a patent must have been *granted and issued* before there can be a delivery.

After the grant and issue of a patent, its delivery is a mere ministerial act, and a refusal on the part of the Commissioner to perform that act would in no way affect the patent, or the inventor's rights secured thereby, and should the Commissioner persist in his refusal, a mandamus would lie to compel him to deliver the deed.

The same is equally true as to Canadian patents.

Under the Canadian law, a patent is completed and becomes in law a patent and avails to the grantee from and after the date of its signing, sealing and registration.

This is expressly provided for by section 18 of the Canadian Patent Act:

> " Every patent and instrument for the extension of time as aforesaid, shall, before its " signing by the Commissioner, or any other member of the Privy Counsel, and before " the seal hereinbefore mentioned is affixed to it be examined by the Minister of " Justice, who, if he finds it comformable to law, shall certifiy accordingly, and such " patent, or instrument, may then be signed and the seal affixed thereto, and being " duly registered, shall avail to the grantee thereof."

It appears on the face of the Bate Canadian patent, that all the requirements of said section, viz: signing, sealing and registration, were complied with, on the 9th day of January, 1877; by reason thereof it became a patent on that day; and the grant dating from the date thereof, secured the monopoly to him for the period of five years thereafter.

The Canadian law makes no reference whatever or provision as to the time when the patent shall be delivered, that being left to the discretion of the Commissioner.

The delivery of the Bate Canadian patent was a subsequent and independent act, that in no way referred to, or affected the grant, or the date of the patent.

Section XVI of the Canadian Patent Act:

> " Every patent granted by this act, shall contain the title or name of the invention, " with a reference to the specification, and shall grant to the patentee, his executors, " administrators or assigns, for the period therein mentioned, *from the granting of the* " *same*, the exclusive right, privilege and liberty of making, constructing and using, " and vending to others to use the said invention,"

contains an express statutory provision that a Canadian patent dates and becomes in fact and law a patent from the date of its grant; the date of its grant being the date of the signing and sealing of the patent.

The Bate Canadian patent, on its face, is a perfect grant, and contains a recital that *all the requirements* of

> " 'The Patent Act of 1872' have been complied with, and, therefore, 'the present " 'patent grants to the said John J. Bate, his executors, administrators and assigns, " 'for a period of five years from the date of these presents,"

&c. (as provided for by section XVI), bears the seal of the Patent Office, and the signature of a member of the Privy Council for Canada (as provided for by section VI.) with no condition or requirement whatever contained or expressed in the grant. The fact that the grant contains a recital that *all the requirements* of the act had been complied with on the 9th day of January, 1877, is conclusive.

The patent was complete at the date of its grant, signing and sealing, and was in full force and secured the monopoly to Bate from and after that date; no difference when the patent was actually delivered to him, it was in force and he held the monopoly, and any one using the same was liable to him for infringement from the date of its grant. If it was intended that the patent should not be considered as complete until its delivery, it would have been so expressed in the grant. The very term of the patent is fixed by and from the date of its grant, without reference to the date of delivery, and the monopoly was absolutely secured to him from that date: it was then ready for delivery, and it was by no act on the part of the Canadian Patent Office that the patent was not then delivered to Bate; the delay in delivery was occasioned solely by his own act. His patent was from the date of its grant open to examination by the public, and the fact that a patent had been granted to him was published to the world by the Canadian Patent Office, and certified copies of the same could be obtained by any one.

What more was requisite or necessary to make the patent complete? Nothing provided for by the Canadian patent laws.

Complainant contends that the Bate Canadian patent did not, in point of fact or law, become a patent until the 26th day of June, 1878, as the patent was not delivered to him until that time. A careful reading of the argument made to establish that proposition will, we feel satisfied, convince the Court that it cannot be sustained. That the patent was not delivered to Bate before, was, as already shown, owing entirely to his own acts.

The papers submitted show, after the grant and issue of the patent to Bate, a model was required, and the patent was not delivered to him until the same had been filed. It does not appear,

> "as stated by complainants' counsel, that he (Bate) was notified that [his application "was granted, with the exception that he was called upon to furnish a working model "of his invention, and that the patent would be retained or withheld in the office until "the delivery of such model;"

but, on the contrary, Bate was notified that *a patent had been granted him* for his invention, and that same would be forwarded to him on receipt of a model; so that the grant and issue was prior to the request for a model. A very different case would be presented had Bate been notified that his application was allowed or granted, and a model was required before a patent would be granted, in which case, the model would have been a prerequisite to the grant of the patent, and the patent would not have been granted and issued until the model had been filed.

If, at the date of the allowance there existed a condition precedent to the actual grant of the patent, it was complied with prior to the grant, as appears upon the face of the patent itself; but as already stated, a model was not demanded until after the grant and issue of the patent, and Bate had received notice to that effect.

The 15th section of the Canadian Patent act does not make the filing of a model a condition precedent to the *grant and issue* of a patent; the model may or may not be dispensed with; it is entirely optional with the commissioner. When a model is demanded it is not as a condition precedent or prerequisite to the grant and issue of the patent; nor is it specified as to when a model, in cases where it is required, shall be delivered to the commissioner—whether before or after the grant.

The fact that the Bate Canadian patent was granted and issued without a model being required, and that the model was dispensed with and not made a condition precedent to the grant by the commissioners, is conclusively established by the fact that the commission did not require a model until after the grant and issue of the patent. Why, subsequent to the grant and issue of the patent a model was required, is not known.

We fail to see the analogy between the delivery of a model *after* the grant of a Canadian patent, and the payment of the final fee *before* the grant of a United States patent, which is a condition precedent to its grant. An American applicant receives notice that his application for a patent has been allowed and a patent will be granted and issue on payment of the final fee; but in the case of the Bate Canadian patent, he was notified that his *patent had been granted*, and the monopoly secured to him from that date, the same as if the patent had been delivered to him on that very day. In the one case there is a notice of allowance and a condition precedent stated to the grant and issue of the patent; in the other there was no condition precedent to its grant, but an actual announcement that the patent had been granted and issued.

The monopoly is not secured to an American applicant from and after the notice of allowance, nor does he secure any privileges by reason therefor, but only from and after the date of the grant of the patent. In the United States the commissioner may or may not require a model, but if a model is required it is before the patent is allowed, and all action upon the application is suspended until the model has been supplied. Rule 55 of the Patent Office especially provides, "when a model shall be required the examination will be suspended until it shall be filed," showing clearly that when a model is required it is a condition precedent to the grant, and that the grant will not be made until that condition has been fulfilled. In no case, except in cases of interference, can copies of the application papers, or patent as allowed, be obtained until the patent has been actually granted and issued—all such matters being preserved in secrecy until after the grant of the patent (see Rule 15).

An American patent becomes a patent, in the sense of the patent law, from and after the date of its grant, without regard to the date of delivery, and it would be none the less a patent although it did not reach, or was not delivered to the inventor until weeks after the date of its grant and issue, for the reason that the monopoly is secured from the date of its grant, and the rights and privileges secured thereby are in no way affected by the date of delivery. It is not necessary to the validity or binding force or effect of a contract that it should be actually delivered so long as it has been properly signed and sealed by the parties in interest. Its validity and binding force and effect is given to it by the signing and sealing, and dates from that date. From and after the 9th day of January, 1877, the date of the signing and sealing, there was no doubt whatever that the Canadian patent had already been granted and issued; there may have been some doubt as to when the patent would be actually delivered to Bate, but this could be solved at any time by his complying with the request of the office to furnish a model.

It may be added that a model can only be made a prerequisite or condition precedent to the grant and issue of the patent by the Commissioner of Patents demanding it prior to that time.

As already stated, the grant and issue of the Bate patent without requiring the model is conclusive that it was dispensed with by the Canadian Commissioner.

The claim of the patent in controversy is for a process of preserving meat. Bate's Canadian patent consisted of three parts or inventions. The first part with the first claim, was for the process of preserving meat, the same as described and claimed by the patent in controversy, and so far as relates to that part of the invention it admitted of no model, and hence the request of the Canadian Commissioner of Patents for a model, *at any time*, did not apply to that part of the invention; section XV expressly omits such cases where the invention does not admit of a model. A model could only have referred to the second and third part of the invention, with the second and third claims.

Said Judge Nixon, in disposing of this question in the Gillette case:

> "It was further insisted that the grant of the Canadian patent was to be determined, "not by its date or issue, but by the time of its delivery to the patentee; that although "dated January 9, and issued January 11, 1877, it was not delivered until June 26, "1878, a long time after the date of the American Patent. Hence, it was said, 'the "invention had not been previously patented in a foreign country' when the patent "was granted here. But this position will not stand the test of of analysis or examination. It appears upon the face of the Canadian patent that it was granted and dated "on the ninth and issued on the eleventh of January, 1877, and was to continue in "force for five years from its date. By the eighteenth section of the Canadian patent "act it is provided that:
>
> "Every patent and instrument for the extension of time, as aforesaid, shall, before "it is signed by the commissioner, or any other member of the privy council, and "before the seal hereinbefore mentioned is affixed to it, be examined by the minister "of justice, who, if he finds it conformable to law, shall certify accordingly, and such "patent or instrument may then be signed and the seal affixed thereto, and, being "duly registered, shall avail to the grantee thereof."

If, at the date of the allowance there existed a condition precedent to the actual grant of the patent, it was complied with prior to the grant, as appears upon the face of the patent itself; but as already stated, a model was not demanded until after the grant and issue of the patent, and Bate had received notice to that effect.

The 15th section of the Canadian Patent act does not make the filing of a model a condition precedent to the *grant and issue* of a patent; the model may or may not be dispensed with; it is entirely optional with the commissioner. When a model is demanded it is not as a condition precedent or prerequisite to the grant and issue of the patent; nor is it specified as to when a model, in cases where it is required, shall be delivered to the commissioner—whether before or after the grant.

The fact that the Bate Canadian patent was granted and issued without a model being required, and that the model was dispensed with and not made a condition precedent to the grant by the commissioners, is conclusively established by the fact that the commission did not require a model until after the grant and issue of the patent. 'Why, subsequent to the grant and issue of the patent a model was required, is not known.

We fail to see the analogy between the delivery of a model *after* the grant of a Canadian patent, and the payment of the final fee *before* the grant of a United States patent, which is a condition precedent to its grant. An American applicant receives notice that his application for a patent has been allowed and a patent will be granted and issue on payment of the final fee; but in the case of the Bate Canadian patent, he was notified that his *patent had been granted*, and the monopoly secured to him from that date, the same as if the patent had been delivered to him on that very day. In the one case there is a notice of allowance and a condition precedent stated to the grant and issue of the patent; in the other there was no condition precedent to its grant, but an actual announcement that the patent had been granted and issued.

The monopoly is not secured to an American applicant from and after the notice of allowance, nor does he secure any privileges by reason therefor, but only from and after the date of the grant of the patent. In the United States the commissioner may or may not require a model, but if a model is required it is before the patent is allowed, and all action upon the application is suspended until the model has been supplied. Rule 55 of the Patent Office especially provides, " when a model shall be required the examination will be suspended until it shall be filed,'' showing clearly that when a model is required it is a condition precedent to the grant, and that the grant will not be made until that condition has been fulfilled. In no case, except in cases of interference, can copies of the application papers, or patent as allowed, be obtained until the patent has been actually granted and issued—all such matters being preserved in secrecy until after the grant of the patent (see Rule 15).

An American patent becomes a patent, in the sense of the patent law, from and after the date of its grant, without regard to the date of delivery, and it would be none the less a patent although it did not reach, or was not delivered to the inventor until weeks after the date of its grant and issue, for the reason that the monopoly is secured from the date of its grant, and the rights and privileges secured thereby are in no way affected by the date of delivery. It is not necessary to the validity or binding force or effect of a contract that it should be actually delivered so long as it has been properly signed and sealed by the parties in interest. Its validity and binding force and effect is given to it by the signing and sealing, and dates from that date. From and after the 9th day of January, 1877, the date of the signing and sealing, there was no doubt whatever that the Canadian patent had already been granted and issued ; there may have been some doubt as to when the patent would be actually delivered to Bate, but this could be solved at any time by his complying with the request of the office to furnish a model.

It may be added that a model can only be made a prerequisite or condition precedent to the grant and issue of the patent by the Commissioner of Patents demanding it prior to that time.

As already stated, the grant and issue of the Bate patent without requiring the model is conclusive that it was dispensed with by the Canadian Commissioner.

The claim of the patent in controversy is for a process of preserving meat. Bate's Canadian patent consisted of three parts or inventions. The first part with the first claim, was for the process of preserving meat, the same as described and claimed by the patent in controversy, and so far as relates to that part of the invention it admitted of no model, and hence the request of the Canadian Commissioner of Patents for a model, *at any time*, did not apply to that part of the invention; section XV expressly omits such cases where the invention does not admit of a model. A model could only have referred to the second and third part of the invention, with the second and third claims.

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> "The invention is patented so as to be available to the patentee when signed, sealed, and registered. Owing to the neglect of the inventor in not forwarding a model to the office, it was not delivered to him until June, 1878, but it was no less a patent, securing to him the benefits of the invention, and protecting him against infringement. This becomes manifest by referring to section 16, of the act, wherein it is enacted that 'the patentee shall have the exclusive right, privilege, and liberty of making, construing, and using, and vending to others to use, the said invention for the period mentioned *from the granting of the same.* Again, the proofs of the complainant show that the patent was absolutely granted as early as January, 1877, although the delivery was withheld owing to the laches of the grantee. The certificate of the assistant patent clerk of the Canadian office, the affidavit of Mr. Simpson, the solicitor employed by Mr. Bate to procure the letters patent, and the notice sent by the deputy commissioner, all reveal upon their face that the requirements of the Canadian law had been fully met, and that the invention had been in fact patented before the model was required."

And subsequently said Mr. Justice Bradley, in disposing of the same question in the same case :

> "I may also say that I entirely agree with Judge Nixon in his view of the Canadian patent, that it took effect at its date, January 9th, 1877, and not at the time of filing the model, in 1878. It was granted on the 9th of January, 1877, after which time the patentee could take it out of the office whenever he chose to file the model."

Certainly I would not be justified in extending the argument upon this question in view of the rulings of Mr. Justice Bradley and Judge Nixon.

As to the term of the Canadian Patent, whether it was for five years or fifteen years, especiallv in view of the Amendatory Act of May 25th, 1875.

It was held by Judge Nixon in the Gillette case, that the Bate Canadian patent was for a term of five years, so far as affecting the term of his United States patent, notwithstanding the fact that his Canadian patent was subsequently extended for two further periods of five years each. He said :

> "It was further maintained by the learned counsel of the complainant that even if it were conceded that the American patent should be construed to terminate with the Canadian patent, the extension of the latter under the provisions of the Act operated to lengthen the term of the domestic patent to the period of 15 years from the date of the first issue of the foreign patent. The seventeenth section of the Canadian law enacts that :
>
> "Patents of invention issued by the Patent Office shall be valid for a period of five, ten, or fifteen years, at the option of the applicant ; but at or before the expiration of the said five or ten years. the holder thereof may obtain an extension of the patent for another period of five years, and after those second five years may again obtain a further extension for another period of five years, not in any case to exceed a total period of fifteen in all."
>
> "By virtue of these provisions, the inventor, Bate, exercised his option, and first took out Letters Patent for five years. He afterwards procured extensions ; first on December 12th, 1881, for five years, from January 9th, 1882 ; and secondly on December 13th, 1881, for another five years, to be computed from the expiration of the prior extension, to wit, from January 9th, 1887.

> “ What effect had these extensions on the life of the United States patent? Under
> “ the provisions of Section 4887 must its terms be made to expire with the terms of
> “ the foreign patent in force when the Letters Patent were granted, or do these exten-
> “ sions of the foreign patent save the domestic patent from lapsing when the term
> “ ends which was running at the grant of the domestic patent?
>
> “ The question is an interesting one, and has already received examination and
> “ answers in other circuits. It first came before the late Justice CLIFFORD, in the
> “ first circuit, in the case of *Henry v. Providence Tool Co.*, decided in 1878, and re-
> “ ported in 14 O. G., 855. In that case the United States patent had been issued
> “ under the act of July 8, 1870, for the full term of 17 years, although at the time of
> “ the grant there was an English patent for the same invention in force, which had
> “ been granted to the patentee in Great Britain for 14 years from the fifteenth of No-
> “ vember, 1860. The defendants claimed that the United States patent expired, by
> “ operation of law, at the same time with the English patent. The complainant, on
> “ the other hand, insisted that the language of the statute extended not only to the
> “ term of the foreign patent in force when the United States patent was obtained, but
> “ also to the term of any prolongation which the patentee might secure from the
> “ foreign government; and that, as he had obtained an extension of four years to the
> “ original term, the owners of the domestic patent were entitled to add these four
> “ to its life.
>
> “ Judge CLIFFORD refused to accede to such a construction of the law, but, on the
> “ contrary, held (1) that by the provisions of the act of July 8, 1870, Congress never
> “ intended to extend the term of the domestic patent beyond the legal term secured
> “ to the foreign patentee when the domestic patent was granted; (2) that the prolon-
> “ gation of the English patent for a further term, after the expiration of the original,
> “ did not save the domestic patent from lapsing under the statute. He was followed, in
> “ this construction of the section, by Judge BLATCHFORD, of the second circuit, in
> “ 1879, in the case of *Reissner v. Sharp*, 16 Blatchf., 383. A patent had been granted
> “ by the United States, on the twentieth of October, 1874, for seventeen years from
> “ that date. It appeared that, under the authority of the patentee, letters patent had
> “ previously been obtained in Canada, for the same invention, for five years from
> “ May 15, 1873. After careful consideration, the learned Judge held that the United
> “ States patent expired on the 15th of May, 1878, although it appeared that in March,
> “ 1878, the Canadian patent had been extended for five years from May 15th, 1878,
> “ and also for five years from the 15th of May, 1883.
>
> “ There was an attempt made to distinguish the case from *Henry v. Providence*
> “ *Tool Co., supra,* (1) because the Canadian patent had not expired when the exten-
> “ sion was granted; and (2) because the extension, by the terms of the Canadian law
> “ was not a matter of favor, as it was under the English act. But the Judge could
> “ not perceive that these considerations were of sufficient force to cause any other
> “ conclusion as to the plain meaning of the statute than that arrived at by Mr. Justice
> “ CLIFFORD.”

Subsequently when the same question came before Mr. Justice Bradley in the same cause, he said:

> “ The term of the patent commenced to run at its date, and I agree with Judge
> “ Nixon that the term was for only five years, which expired in January, 1882, notwith-
> “ standing the privilege which the patentee had of continuing it for a longer period.”

Section XVII. of the Canadian Patent Act provides:

> “ Patents of inventions issued by the Patent Office shall be valid for a period of
> “ five, ten or fifteen years, at the option of the applicant.’

Bate exercised this option and obtained his patent for the period of “five years,” as appears on the face of his Canadian patent.

That being the term of the Canadian patent in force at the date of the grant of his American patent, his American patent expires with that term, notwithstanding the fact that the Canadian patent may have been subsequently extended for a further period of five or ten years.

The subsequent extension of the term of the patent was an entirely separate and distinct grant, having no reference to or connection with the original term; the Canadian law does not provide that the patent, when extended, shall have the same force and effect as though originally granted for that term, but merely that if the inventor, before the expiration of the first term of the patent, applies and complies with the requirements of the act, he may obtain an extension of the patent for a further period of five or ten years.

This precise question was first presented and considered by Mr. Justice Blatchford, in case of Reissner *v.* Sharpe, 16 Blatchford, 383, and section 4,887 was construed by him to refer to the term of the foreign patent in force at the date of the grant of the American patent, and as in no way effected by the subsequent acts of extension. As that question is so fully and ably discussed by Mr. Justice Blatchford, in his opinion, it is not thought necessary to further refer to it here, but merely request the Court to carefully consider that opinion.

The same question, so far as relates to United States patent being limited to the term of a prior foreign patent in force at the time of the grant of the United States patent, was also passed upon by the late Mr. Justiae Clifford, in case Henry *v.* Providence Tool Company, 14 Off. Gaz., p. 855. The reasons given by the Court for the conclusions arrived at are so unmistakable and convincing as to need no further explanation.

It was to fix definitely, or as near as it was possible, the term of American patents, that that provision was incorporated in section 4887.

~~Complainant~~ appellants's counsel argues that the intent of the act was that the American public should not be prevented from using the patented article when its use was open to the foreign public in that country. That such was not the intention of the Act of 1870 is very clearly stated by both Judges Clifford and Blatchford, in the following language:

> "The statute refers not only to the foreign patent, but, if there be more than one, to
> " the one having the shortest term; it cannot be held to include any subsequent pro-
> " longation or extension of the monopoly beyond that vested in the foreign patentee
> " at the time of the granting of the United States patent; that if Congress had in-
> " tended otherwise the language would have been different, and words would have
> " been employed to signify that the domestic patent should continue as long as the
> " same invention was patented by the foreign government; and that under the
> " opposite rule, neither the authorities of the United States, nor inventors nor the
> " public, would ever be able to know what the patentee acquired under a patent
> " granted by the United States, in a case where the invention had been previously
> " patented in a foreign country."

There is a very great distinction between a Canadian patent which, by the very words of the act, is granted for an absolute term of five, ten or fifteen years, at the option of the applicant, and an English patent that is granted on its face for a term of fourteen years, subject, however, to certain conditions which are made precedent to and embodied in the grant.

The English patent is a grant for fourteen years, so far as the government is concerned, and its termination sooner is due to the failure of the inventors to comply with the conditions precedent to the grant, subject to which he took the patent.

There is a very material difference between a Canadian grant and an English grant.

The Canadian grant is a fixed and positive term without any condition whatsoever, either precedent or subsequent to the grant. The wording of the grant in the Bate Canadian patent being:

> "The present patent grants to the said John Jones Bate, his executors and assigns
> " for a period of five years from the date of these presents."

It appears upon the face of the extension of the Bate Canadian patent that it was a separate and independent grant, having no reference to the original grant.

The grant after reciting

> "And whereas, a patent bearing date of the ninth day of January,
> "in the year of our Lord one thousand eight hundred and seventy-seven,
> " was granted John Jones Bate," proceeds:
>
> " The present patent grants to the said John Jones Bates, his executors, adminis-
> " trators or assigns, for another period of five years,"

showing conclusively that it was and is considered by the Canadian authorities as a corporate and distinct grant.

Attention is also called to the fact that the grant of the extension recites that a patent had previously been granted to Bate on the *9th day of January*, 1877. This extension being subsequent to the delivery of the patent, if the patent did not, in point of law, became a patent until after its delivery, why should not that fact have been recited in the extended grant, giving Bate the benefit of the full term of five years from and after the date of the delivery. The original grant of five years to Bate, was in no way dependent upon the payment of any fees, or the performance of any condition whatsoever, as in the case of English patents.

The term for which Bate's Canadian patent was originally granted expired January 9, 1882, and that is the term which governs the subsequent United States patent granted to Bate for the same invention.

As to the effect of the Canadian Amendatory act of May 25, 1883, upon the term, of the Bate Canadian patent, Mr. Justice Bradley said, in disposing of the question, in the Gillette case:

> " I may say at once that I attach no importance to the last-mentioned Act. The
> " American patent received its operative force and effect on the day it was issued, and
> " no subsequent legislation in Canada or elsewhere could change it, whatever the
> " effect of such legislation where made. The force and effect of the American patent
> " could only be affected by the Canadian patent as the latter stood when granted, and
> " not as it was afterwards modified by legislation."

The Amendatory Act referred to is printed at page 63 of the Record, and is as follows:

CHAP. 19.

" AN ACT TO AMEND THE PATENT ACT OF 1872.

" [Assented to 25th May, 1883.]

" Her Majesty, by and with the advice and consent of the Senate and House of " Commons of Canada, enacts as follows:

" I.—Section 17 of 'The Patent Act of 1872,' is hereby repealed, and the following " is substituted therefor:

" The term limited for the duration of every patent of invention issued by the " Patent Office shall be fifteen years; but at the time of the application therefor it " shall be at the option of the applicant to pay the full fee required for the term of " fifteen years, or the partial fee required for the term of ten years. In case a partial " fee only is paid the proportion of the fee paid shall be stated in the patent, and the " patent shall, notwithstanding anything therein or in this act contained, cease at the " end of the term for which the partial fee has been paid, unless at or before the expiration of the said term the holder of the patent pays the fee required for the " further term of five or ten years, and takes out from the Patent Office a certificate " of such payment (in the form which may be from time to time adopted) to be attached to and to refer to the patent, and under the signature of the Commissioner, " or, in case of his absence, another member of the Privy Council; and in case of " such second payment, together with the first payment, makes up only the fee required for ten years, then the patent shall, not withstanding anything therein or in " this act contained, cease at the end of the term of ten years, unless at or before " the expiration of such term the holder thereof pays the further fee required for " the remaining five years, making up the full term of fifteen years, and takes out a " like certificate in respect thereof. Every patent heretofore issued by the Patent " Office in respect of which the fee required for the whole or for any unexpired portion of the term of fifteen years, has been duly paid according to the provisions of " the now existing law in that behalf, *has been and shall be deemed to have been " issued for the term of fifteen years,* subject, in case a partial fee only has been " paid, to cease on the same conditions on which patents hereafter issued are to " cease under the operation of this section."

It will not be denied that the passage of this Act was procured for no other purpose than to overcome, if possible, the effect of Judge Nixon's opinion in the Gillette case, which opinion was given in Oct. 1882, and this Act was passed May 25, 1883.

It is contended, as I understand it, that this Amendatory Act of May 25, 1883, is not only a declaratory Act, but is a judicial construction of section 17 of the Act of 1872.

Is that act of the Dominion Parliament a construction "by the courts" or "proper tribunal" of Canada, of Sec. 17 of the Act of 1872, and if so, is it such a construction as shall be binding upon this Court? or is it legislation establishing a new rule of law?

In determining the first question, it will be necessary to inquire into the Canadian form of government, to ascertain precisely what position the Dominion Parliament occupies.

Fortunately Canada has a written Constitution which prescribes its form of government and divides the powers of government into three separate and independent heads, viz., executive, legislative and judicial, and defines the province of each of these three separate departments,—precisely our form of government; and the functions performed by these three separate branches of the government in Canada are substantially the same as in our form of government. The Dominion Parliament has, within its jurisdiction, exclusive legislative power; so also has the Congress of the United States, but that the Dominion Parliament is *not omnipotent* is shown by the fact that there are certain subjects on which it has no power whatever to legislate, as for instance, the British North American Act, Sec. 92, reserves certain subjects upon which alone the Provincial Legislature can legislate, and as to those subjects, it is supreme. Substantially the same relation exists between the Provincial States and the Dominion of Canada as exists between our separate States and the United States. The Dominion Parliament is not a judicial tribunal and has no judicial functions, such under the British North American act of 1867 being vested *exclusively* in the judiciary. So long as the Dominion Parliament does not transcend the powers given it by the Constitution, it has supreme legislative power, but the constitutionality of its acts are always subject to be questioned in the courts; there is no act of Parliament of which the courts have not a right to inquire, is it constitutional; if constitutional, to properly construe and apply it. Parliament having passed a law within its jurisdiction, undoubtedly, that law is supreme, but to say what that law is, belongs *exclusively* to the judiciary; as has been forcibly stated by a recognized writer, "the interpretation of statute law belongs to the judiciary alone," and no principle is more definitely settled in Canada than this. By reason of the British North American Act the Dominion of Canada has its Supreme Court of Appeal, to which an appeal may be taken from the courts of original jurisdiction, and if an appeal be taken to that court, it is the court of last resort, and is, "within its jurisdiction," supreme; but instead of appealing to that Supreme Court of Appeal, an appeal may be taken direct to the Privy Council of England, in which case the Privy Council is supreme. The Dominion Parliament forms no part of the judicature, and there is no appeal from any Court to the Dominion Parliament; and the Supreme Court of Appeal or the Privy Council of Great Britain, as the case may be, is the supreme authority as to the constitutionality of any statute passed by the Dominion Parliament, and as to the interpretation and application of the law is absolutely supreme.

British North American Act of 1880.
Constitution of Canada, by Joseph Doutre, Q. C., published by John Lovell & Son, Montreal, 1880.

Though in England there is no written Constitution, and it has been said that Parliament is omnipotent, nevertheless the construction and application of the laws is left entirely to the judiciary; and though the power and authority of Parliament to enact laws cannot be questioned yet, as to what may be the true interpretation of such laws is a question left to the courts, and when the judiciary has constructed and applied the laws, there is no appeal to Parliament.

It is well settled in Canada, that while the law making power is exclusively vested in Parliament, within its jurisdiction, Parliament can neither construe or enforce its own acts; the enactment of laws belongs to Parliament, their construction and application to the judiciary and their enforcement to the executive.

The foregoing facts clearly establish (1), that the judiciary of Canada is constitutionally a separate and independent branch of the Government; (2), that the powers of the Dominion Parliament are exclusively legislative; (3), that it has no power whatever to construe a former statute; (4), that as to the construction and application of the statutes, the courts of Canada are supreme; (5), and that in no sense is the Dominion Parliament a court of judicature.

The case of St. Andrew's Church, &c., appellants, *v.* Board of Managers, &c., respondents, *Legal News*, Vol. 4, No. 4, page 27, cited by appellant's counsel, to show that the Dominion Parliament is supreme in the sense of being omnipotent, and therefore has the power, and is the proper tribunal to construe a former statute, does not establish any such position. In that case the Dominion Parliament passed an act ratifying and confirming the actions and doings of a Board of Directors elected under prior acts which were held to be unconstitutional, and the questions considered in that case were, was the act confirming the authority and ratifying the acts of the board constitutional? If so, what was the interpretation of that act? The court states,

> *"Everywhere there is a supreme power which decides what is constitutional and "what is not,"*

showing that the question involved was as to the constitutionality of the act.

> *"In England it is the Imperial Parliament which is supreme. When it has once decided in clear and emphatic terms, no court of justice can alter the decision. In the "United States the Supreme Court is the supreme power"*

to decide what is constitutional and what is not. So, also, in the Dominion of Canada, the Supreme Court of Canada or the Privy Council of Great Britain, as the case may be, is the supreme power to decide what is constitutional and what is not. In this case it is said

> *"The court is not to decide whether it is a moral law or not, but only whether the "Dominion Parliament had a right to pass it or not; it is not enough to say that it "trenches on private rights."*

The St. Andrew's case merely decides that the Dominion Parliament, within the limits of its jurisdiction, has the right to pass retroactive laws, which is not disputed; but not that the Dominion Parliament is the proper tribunal or the power or the supreme power to construe a former statute. It does, however, establish that in Canada the judiciary is the proper tribunal and the supreme power to decide what is constitutional and what is the law ; and in the case referred to the Dominion Parliament *did not attempt* to construe the former acts or declare what they had been, but simply ratified and confirmed certain actions and doings. The cases cited in that opinion are to the same point, and show that while the Dominion Parliament, in its jurisdiction, has the right to pass retroactive laws, they are confined to the enaction of remedial and limitation laws, and such laws as effect rights beneficially—the legitimate province of retroactive legislation.

Not only did the court in the St. Andrew's Church case decide the constitutionality of the act, but proceeded to interpret it, the language of the court being:

> "The law is not so carefully worded as it might have been, but the court has to in-"terpret it."

Now, if my understanding of the opinion in that case is correct, no authority has been presented establishing the proposition that the Dominion Parliament is the "proper tribunal to construe a former statute." And it is not, as has been stated, precisely similar to the case at bar ; nor can there be said to be any analogy between the two cases, as will be apparent upon examining the act of Parliament in question in that case, which is recited at length in the dissenting opinion of Ramsey, *Judge ;* it falls entirely short of the proposition the complainants are endeavoring to maintain.

The question in the Donegani case cited was as to an act passed to remove the disabilities of an alien.

The Act of May 25, 1883, is not a declaratory act, and had it been intended as a declaratory act, to declare the true intent and meaning of sec. 17 of the Act of 1872, it certainly would not have repealed that section and substituted a new one therefor, as a declaratory act always maintains and explains the former law, never repeals it; and furthermore, it would have been in the recognized Canadian form of a declaratory act, the wording of which would have been of this character: Whereas, by sec. 17 of the Act of 1872, etc., and whereas, doubts have arisen as to the true intent and meaning of that section, therefore, her Majesty, by and with the advice and consent of the Senate and House of Commons of Canada, declare and enact as follows: That the true intent and meaning of sec. 17 of the Patent Act of 1872 has been and shall be deemed to be, &c., &c. (For references to Canada declaratory acts see last page.)

Then, truly, it could have been said to be a declaratory act, as an arbitrary legislative construction of a former act, the force of which I shall discuss hereafter. It is undeniable that the Act of May 25, 1883, when compared with the repealed section, establishes an entirely new rule of law, and it is absurd to say, as a matter of fact. that it is a construction, to use that word in its strictest sense, of sec. 17 of the Act of 1872; so great is the change, that it amounts to saying that what was law is not law; or, to use the language ot the court in the case of Greenough *v.* Greenough,

> "to enact that white meant black and black meant white, and ask the court to be "bound by it."

So plain was the wording of sec. 17 of the Act of 1872 that it was impossible to misconstrue its meaning, and it had never been questioned in any court in Canada, but had been uniformly understood and administered by the Patent Office and courts of Canada, and it is monstrous to maintain that where the words and intent of an act were so plain that no court had ever been appealed to for the purpose of declaring their meaning, and the law had been uniformly understood and administered, it is in the power of the Legislature by retrospective law to put a construction upon them contrary to the obvious letter and spirit, and bind the courts, and yet this is what has been attempted to be done in this case. No doubt could possibly exist as to the meaning of this new act, were it not for the use of the words "has been," and it was upon those words that the entire argument of the complainant was based. Now, those words have heretofore been used in declaratory legislation, but the undeniable rule of construotion has always been applied to give to those words a prospective, and not a retroactive effect, if it could be done without rendering the law inoperative. In this case it can and should be done; for, no difference what interpretation be given to the words "has been," it in no way affects Canadian patents; interpret them either retroactive or prospective, the result is the same, and it in no way affects the Canadian patents. In the one case, they are five, ten, and fifteen year patents, renewable as a matter of right at five and ten years, on payment of the fees; in the other case, they are fifteen year patents, defeasable on non-payment of the fees at five and ten years. But, it is said, it effects American patents granted to Canadian subjects in that it prolongs the United States patent to a period of fifteen years. If such be the case, it more clearly shows and establishes the fact that it was legislation—legislation for the express purpose of extending the term of American patents, and it has been decided in this country, country which decision has been recognized, that a foreign government can enact no legislation that in any way extends the term of the American patent.

Henry *v.* Providence Tool Co., 14th Official Gaz.

They may legislate sq as to extend their own patents, but such extension of a foreign patent does not extend and carry with it the term of an American patent, and the only way in which they are able to break the force of this well settled rule is by saying that this new act is a construction by the court or proper tribunal of Canada of sec. 17 of 1872.

This *new* Act repeals sec. 17 of the Act of 1872, and substitutes instead thereof a new section. It is not, and does not, on its face purport to be a construction of sec. 17, and by what reasoning can it be said that an act which absolutely repeals a former section and substitutes a new action therefor is and must be treated as a construction of that former section. The old section no longer exists, and the section substituted therefor makes as radical a change in the law as it was possible to make; but it is said that, the latter part of the substituted section 17 is declatory of the old section of the Law of 1882, by reason of the use of the words "has been;" but, section 17, as already stated, has been absolutely repealed and erased from the statute books.

Suppose the Dominion Parliament had the power to use the words "has been" it is still for the Canadian Courts to say what is the true intent and meaning of those words as used in that act, and they alone have the power so to do, and in construing *that act*, they would not be construing section 17 of Act of 1872 repealed, but this *new legislative act*. The Dominion Parliament having no power to construe a former statute as already shown, the use of the words "has been" in this new act, is of no force as declaratory of the true intent and meaning of section 17 repealed of the Act of 1872.

Admitting, for argument, that the Act of May 25, 1883, is a declaratory act, and would bind the Canadian Courts to hereafter hold that the law always "has been" as therein stated, that does not make it a judicial construction of the old section repealed, or a construction such as would bind this court. This court is not bound to follow or take any notice whatever of a legislative construction, for Parliament within the limits of its jurisdiction may declare what the law "has been" when notoriously such *has not been the law*, as in this case. It never "has been," as therein stated, and the mere use of those words cannot make that law which, in fact, has not been law.

The words "has been" in that act indicate that it was the intention of Parliament, naving changed the law as to the term of patents *to be granted*, to make the term of all patents in force uniform, and for that purpose used those words, assuming such to have been the law, not intending, however, to make it declaratory of the repealed section or to give it the force and effect of a construction of the repealed section; otherwise why should they have said "*has been and shall be deemed to have been*," implying that if it has not been as assumed, then it "*shall be deemed to have been*" so, in order to establish a uniform term for all patents. It is, and should be treated simply as a legislative assumption.

Certainly it could not have been contemplated in announcing the rule that our courts should adopt, the construction which foreign courts give to their own laws, to have included a legislative construction, that is, that legislative bodies should have the right after a law had been enacted, to declare by reason of their supreme legislative powers what that law is and must be construed to be, and so bind our courts, for such a rule would be to suppose that our courts intended to put themselves at the mercy of foreign legislative bodies.

The language of the court in the case Elemendorf *v.* Taylor, on this subject, is very precise ; it says :

> " the construction which the courts have given to the laws, that the judicial power of
> " every government where such department exists is the proper ordinance for con-
> " struing the legislative acts of that government,"

there drawing a very sharp distinction between the court or judicial departments for construing the laws, and the legislative department; they say,

> " we receive the construction given by the courts of a nation as to the true sense
> " of a law,"

not the construction given by the legislative power of a nation.

As already shown the Dominion Parliament is in no sense a court of judicature ; a judicial department however, does exist in Canada, and, in the language used in the case of Elmendorf *v.* Taylor, the judiciary is the proper organ for constructing the legislative acts of that Government.

I know of no principle of law that compels this court to follow the Dominion Parliament's construction of a former act although it arbitrarily says what the law has been, and which may perhaps, in its effects, be binding upon the Dominion court ; but even then it remains for the Canadian courts—the judicial tribunals to construe and apply that legislative construction of the law.

Granting, as has been been argued; that an act of Parliament, within its jurisdiction, cannot be questioned or controlled by any Canadian court, still, that does not make Parliament a court of judicature, nor the acts of Parliament, even though they be declaratory, judicial decisions within the meaning of our law ; so far as our courts are concerned, it must be considered and treated as an act of legislation—not as a judicial decision.

This court is asked in this case to give to a purely legislative act the force and effect of judicial decision ; to give to that act of Parliament the same consideration as if at the former argument, it had been produced as a judicial construction of Section 17 of the Act of 1872, by a Canadian court. To say that it is a declaratory act makes it none the less legislation. Declaratory acts are not unusual even in this country, but they are to be considered and treated precisely the same as any other legislative act and are entitled to no greater force and effect; that it declares what the law is, and ever has been, does not give it any greater weight, and while, in a certain sense, every declaratory act is retroactive, as assuming to declare what the law was, before the declaratory act was passed, yet it remains for the Courts to interpret such declaratory acts and apply them. Undoubtedly, as has been forcibly stated,

> " it is always competent to change an existing law by a declaratory statute, and where
> " the statute is only to operate on future cases, it is not objectionable to its validity
> " that it assumes the law to have been in the past, what it now declares it shall be in
> " the future, but the legislative action cannot be made to retroact upon past contro-

> "versies and reverse decisions which the Courts, in the exercise of their undoubted "authority, have made, * * * as the legislation cannot set aside the construction "of a law already applied by the Courts to actual cases, neither can it compel the "Courts for the future to adopt a particular construction of the law which the Legis"lature permits to remain in force."

As stated in the case of Ogden *v.* Blackledge, 2 Cranch, 272,

> "but even if it had been brought after the law of 1799, that act could not alter the "past law, and make that to have been law which was not law at the time. The de"claring what the law is or has been is a judicial power, and declaring what the law "shall be, is legislation. One of the fundamental principles of our government is "that the legislative power shall be separated from the judicial."

In the case of Mayberry *v.* Madison, 1st Cranch, page 177, the Court states:

> "It is emphatically the province and duty of the judicial department to say what "the law is; those who apply the rule to particular cases must, of necessity, expound "and interpret the rules."

So that, if the Legislature in the exercise of its arbitrary legislative power, says what the law has been, it does not make it so.

No doubt, this Court is very familiar with the case of Desh *v.* Vankleeck, 7 Johnson Reports, N. Y., 477, but I earnestly urge upon the Court not to decide this case without again carefully considering the very able opinion of Chief Justice Kent, delivered in that case, as he therein reviews the entire subject of declaratory statutes, the position they occupy, and the force and effect to be given them by the Courts, not only in this country, but in all countries; the conclusions drawn from his opinion are, that all declaratory acts in all countries, are to be considered merely as legislative acts, and received as such, and not as judicial constructions, even though they may be binding on the Court from and after the date of their passage, and though the Legislature may have declared what the law has been and shall be, it is still for the Court to construe and apply that law.

That Parliament in the exercise of its arbitrary legislative power says the law "has been," is not by any means to be taken as the construction of the former law as expressed by the words used, and who shall say what meaning is to be given to those words, and whether applied so as to be retroactive or to operate only as to the future. The cases of

The People *v.* The Supervisors of N. Y., 16th N. Y. Rep., pp. 432, 433.
Manning *et al. v.* Farrier *et al.*, 46 Mo. Rep., pp. 376, 377.
In re Protestant Episcopal School, etc., Barber's Supreme Ct. Reps., V. LVIII., p. 164.
Denny *v.* Mitoon *et al.*, 84 Mass. Rep., 377-80.
McCabe *v.* Emerson, 18th Pa. Reps., 112.
Greenough *v.* Greenough, 11 Pa. Reps., 489-94.
Sedgwick on the Construction of Statutory and Constitutional Law, 2 Ed., pp. 174, 175 and following.

Wade on Retroactive Laws, Sec. 42, and Potter's Dwarris on Statutes and Constitutions, 78.

are to the same point, and worthy of great consideration in the determination of the questions involved.

I have cited and dwelt upon the foregoing cases as to declaratory acts, to establish the propositions that declaratory acts, no difference how worded, do not control or bind the judiciary in deciding what is the true interpretation and meaning of a former act, and its proper application, except as to cases rising subsequent to the declaratory act; that all declaratory acts are considered as arbitrary legislative acts, and in construing and applying such acts, the Courts always endeavor to avoid giving them a retroactive effect. So far as my researches extend, I have not found a single case in any country where the Legislature has passed a declaratory act, declaring what a former act has been, that the Court have accepted it as the construction of the former act.

It must by this time be evident to your Honors why the Act of May 26th, 1883, was passed, and who was the instigator of it. It was passed beyond any question, and was virtually acknowledged by Mr. Dickerson on the argument in the Gillette case, to circumvent the opinion of Judge Nixon construing section 17 of the Act of 1872.

If what has been attempted to be done can be done, then controversies may first be tried in the courts, and the disappointed partisan dissatisfied with the ruling of the Court, may appeal to the legislative power, and thus defeat the ruling of the Court. It is admitted that if what, as has been done in Canada, had been done in this country, it would not be binding upon this Court, as the only proper tribunal with us to interpret and apply the laws is the judiciary, and as the distribution of power in Canada is precisely the same as with us, it follows that the only proper tribunal in Canada to construe and apply the laws is the judiciary.

The Act of May 25, 1883, *is legislation* establishing an entirely new rule of law, to wit, that patents in Canada shall be for a continuous term of 15 years instead of separate terms of 5 and 10 years, subject to renewal as a right for a period of 15 years. If I am correct in saying that this is legislation, then the act is in effect an extension of the term of Canadian patents by subsequent legislation, and in no way affects the United States patent.

Henry *v.* Providence Tool Co., Official Gazette, vol. 14, page 855.

I submit with great confidence that the Act of May 25, 1883, is legislation and not a construction of section 17 of the Act of 1872, "By the Courts of Canada" or the "proper tribunal of Canada," and not binding upon this Court, that even though it be a construction of Section 17 of the Act of 1872, it is a legislative construction, or such a construction as does not bring it within the rule announced in the case of Elmendorf *v.* Taylor, and so as to be binding upon this Court.

Parliament of the Dominion of Canada is not the proper tribunal, nor a "competent tribunal" to construe the laws of Canada, the construction of its laws being, by the "British North American Act," confined solely to the judiciary. All acts of the Dominion Parliament are purely legislative; it does not, nor has it the authority, to act in a judicial capacity; it has no judicial functions whatever.

The case of Salters *v.* Tobias, 3 Paige Chancery Report, cited, falls far short of maintaining appellant's position, for in Canada the authority of the Dominion Parliament is limited by a written constitution—the British North American Act, and if it transcends the power and authority given it by that act, its acts are declared unconstitutional by the courts of judicature. It may, within its prescribed limits, pass declatory laws, but such are purely legislative acts, and *are not*, and have nvere been considered, or treated as judicial constructions of former acts.

Undoubtedly, this act of May 25, 1883, was passed, as is stated, for the very purpose of this and similar cases, but not "effectually passed," if, by that ~~he means~~ is meant, to effect this and similar cases. No better argament could be made, than that very admission, to convince this court that that act was not a judicial construction and interpretation of sec. 17, of the Act of 1872, and was not so intended and considered at the time of its passage; such was not the intent of the legislator.

In the case of the Bate Canadian patent, there was a *de facto* grant; which is a full compliance with the provisions of sec. 4887 of the Revised Statutes. It is of no moment, that subsequently, and after the expiration of the term which controlled the term of the American patent, the patent was declared void *ab initio.*

It is not necessary in this controversy for this court "to decide that a foreign statute is unconstitutional," as it is of no consequence whether the Act of May 25, 1883, is, or is not, unconstitutional.

It has not been disputed that the Dominion Parliament had constitutional authority to pass the Act of May 25, 1883; it has exclusive legislative authority over "Patents of invention and discovery," precisely as our Congress has over "Patents of invention and discovery" in this country.

The question here is, what effect, if any, has the Act of May 25, 1883, upon patents previously granted in this country? If it was an exercise of the legislative authority, it has no effect, as the duration of United States patents can be in no way affected by subsequent foreign legislation.

The Act of May 25, 1883, is not an authoritative construction of section 17, Act of 1872, as the Dominion Parliament has no authority to construe laws. Its sole duty is to enact laws, and in the exercise of that authority it may enact laws which correct former laws, but such acts are none the less legislative acts.

This whole question is summed up and completely disposed of by Mr. Justice Bradley in the Gillette case. He held that the Amendatory Act was subsequent legislation and not a judicial construction

of section 17 of the Act of 1872, and therefore had no effect whatever upon an existing United States patent or the term thereof.

It is respectfully submitted that the decree of the Circuit Court should be affirmed.

JOHN R. BENNETT,
Of counsel for appellees [illegible]
Counsel for B. W. Gillette and
others, and Joseph Eastman.

(Copy.)

DEPARTMENT OF THE INTERIOR,
WASHINGTON, January 18, 1882.

The Acting Commissioner of Patents:

SIR:

I acknowledge the receipt of your report of the 4th instant, upon the complaint of A. Pollok, Esq., relative to a requirement of your office, directing that an applicant for whom he appears as attorney shall file an additional oath, setting forth that he has obtained no other foreign patent than those mentioned by him in an oath now on file. The object in view in making this requirement is to enable the office to execute the law, which provides that "every patent granted for an invention "which has been previously patented in a foreign country shall "be so limited as to expire at the same time with the foreign "patent, or, if there be more than one, at the same time with the "one having the shortest term, and in no case shall it be in force "more than seventeen years."

It appears that in some foreign countries the duration of a patent is conditional upon the payment of fees at stated periods.

A patent in a foreign country may be issued after the filing of the applicant's statement in regard to the matter, but before the issue of the patent by your office, in which case your office would not have the information upon which to fix a limitation to the United States patent by particular reference to such foreign patent. In view of the difficulties of executing the law by the making of a reference upon the face of the patent to particular foreign patents, I will thank you to state to this department what objections, in your view, there are to changing the form of Letters Patent issued by your office so as, upon their face, to make all patents "subject to the provisions of section 4887 of the Revised Statutes," or the reciting in form the provisions of said section, which are applicable to cases in which an invention has been patented in a foreign country, or in foreign countries, prior to the issue of a patent for the same by your office, in order to limit the duration of the patent in such cases by the general provisions of law, without making a reference to any particular foreign patent or patents, and in this manner obviate the necessity for inquiry by your office as to the issue of a foreign patent in any case.

I will thank you also to give your opinion, whether all that said section 4887 contemplates cannot be effected in the method suggested.

Very Respectfully,
S. J. KIRKWOOD,
Secretary.

Misc. 90—1882.

(Copy.)

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., March 9, 1882.

Hon. S. J. KIRKWOOD,
Secretary of the Interior.

Sir:

I have the honor to acknowledge the receipt of your letter of January 18, 1882, addressed to the Acting Commissioner of Patents, in which you state: "In view of the difficulties of executing the law "by the making of a reference upon the face of the patent to particular foreign patents, I will thank you to state to this department "what objections, in your view, there are to changing the form of "Letters Patent issued by your office, so as, upon their face, to make "all patents subject to the provision of section 4887 of the Revised "Statutes, or the reciting in the form the provisions of said section "which are applicable to cases in which an invention has been patented in a foreign country, or in foreign countries, prior to the issue of "a patent for the same by your office, in order to limit the duration "of the patent in such cases by the general provisions of law, without "making reference to any particular foreign patent or patents, and "in this manner obviate the necessity for inquiry by your office as to "the issue of a foreign patent in any case.

"I will thank you also to give your opinion, whether all that said "section 4887 contemplates cannot be effected in the method suggested."

In reply, I have to state that I think a change in the practice of the office in the issuance of patents by the insertion of such a clause as you suggest, or as is suggested in your letter, would not be a compliance with either the letter or the spirit of the law.

By section 4884 (R. S.) it is provided that "Every patent shall "contain a short title or description of the invention or discovery, "correctly indicating its nature and design, and a grant to the "patentee, his heirs or assigns for the term of seventeen years, "of the exclusive right to make, use and vend the invention or "discovery throughout the United States and the Territories thereof." * * *

By section 4887 (R. S.) an exception is made in the length of the term for which the patent shall be granted, where the invention has first been patented in a foreign country. In that case the patent is to be "so limited as to expire at the same time with the foreign "patent, or, if there be more than one, at the same time with the "one having the shortest term, and in no case shall it be in force "more than seventeen years."

To limit is "to confine within certain bounds," "to circumscribe," "to restrain" (Webster). It is well settled that that is certain in the law which is capable of being rendered certain by inquiry.

I think there can be no doubt—at least it has never been questioned—that it is the duty of this office, in case a patent is first issued in this country, to express upon the face of the patent the term for which it shall run, viz.: seventeen years. The statute reads, "Every patent shall contain * * * a grant to the patentee, "his heirs or assigns, for the term of seventeen years." In that case it has always been held, and such is now the practice, that the patent must define the term for which it is granted.

In the case of an invention patented abroad, the statute reads: "Every patent granted for an invention which has been previously "patented in a foreign country shall be so limited as to expire," &c.

You will observe that in neither case does the statute provide that the *right* which the party secures shall last for a certain number of years, or shall expire at a certain time; but in both cases the *patent* itself must express the term it shall run and when it shall expire. In the case of the *patent* where the invention is first patented in this country, the term is definitely fixed. In the case of the invention first patented in a foreign country, the term for which the *patent* shall run is left to be ascertained by inquiry, and if more than one patent has issued in foreign countries, then the patent here issued must expire "at the same time with the one having the shortest "term."

It is possible to ascertain whether the invention has been patented in a foreign country or countries, and where it has so been patented with reasonable certainty, the one where it will have the shortest term. It is therefore possible to render certain, and so express upon the face of the patent issued, that which would be indefinite and uncertain if the patent were issued with such a clause as the one suggested in your letter above mentioned.

If it is the duty of this office to express upon the face of the patent the term for which the patent shall run, viz., seventeen years, if the invention be first patented in this country, I am unable to understand why it is not its duty to ascertain how long the patent shall run where the invention has first been patented in a foreign country or countries. It might be said, with equal propriety, that it is not necessary to fix any term in the patent where the invention is first patented in this country.

If the patent can run no longer than seventeen years, and the suggestion contained in your letter has any force, the patents issued by this office might simply grant to the patentee the exclusive right to make, use and vend the thing patented, without expressing any term, because the law would define the term, and it being presumed that every person knows the law, it would be only necessary for the public to see the date on which the patent was granted, and then compute the time when, by virtue of the statute, it must expire. This, however, in the view I entertain of the law, would not be a compliance therewith, because the statute says that the patent shall be for the term of seventeen years. In the case of the invention first obtained in a foreign country or countries, the statute says: "Every patent * * shall be so limited as to expire at the same time," &c. A patent, therefore, must not only grant the right to make, use and vend the thing patented, but it must express the term of years for which the patentee, or his assigns, is entitled to that exclusive right.

With the view I entertain of the law, it would be a neglect of duty on my part to fail to express, with as much certainty as possible, the time when any patent will expire, when it has been patented in a foreign country or countries.

Undoubtedly the object of placing any limitation on a patent, whether first issued in this country or in a foreign country, is that at some time the public may have the right to make, use and vend the invention without paying any royalty to the patentee or his assigns.

In limiting the term of patents, where the invention was first patented in a foreign country, so that they shall expire when the one having the shortest term expires, the reason of the statute seems to be that when the article or device shall belong to the public in any country, it shall belong to the public in this country. The public has the right to know when it may manufacture, use and sell articles or devices patented without paying a royalty. All the rights which a patentee obtains by his patent are such as are granted by the statute, and are in supposed compensation for something valuable which he has contributed to the public. If the term for which the patent shall run is expressed on its face, all persons may readily obtain information as to the time when that right expires. If such term is so expressed, there will be so much less danger of imposition on the part of evilly disposed persons than as if the term was for seventeen years, and every person was bound to inquire and know whether the patentee, in fact, had a right to make, use and vend the thing patented for a less term of years.

Independently, therefore, of what I deem to be the proper construction of the law, I think it is the duty of this office, when it issues a patent, and thereby proclaims to the world that the person named therein, as patentee, has the exclusive right to make, use and sell the thing patented; it shall also state how long that exclusive right shall last. I find no serious difficulty in administering the law in this way, and I think that any other mode of procedure would be

in conflict with the law, and in derogation of the rights of the people of this county.

Very respectfully,
Your obedient servant,
E. M. Marble,
Commissioner.

(Copy.)

Department of the Interior,
United States Patent Office.

Washington, D. C., March 17, 1882.

Hon. S. J. Kirkwood,

Secretary of the Interior.

Sir:

I have the honor to transmit herewith the application of Col. R. Mason, for "an executive order interpreting the 39th "rule and form " of oath as stated in *Official Gazette* of November 22, 1881, or an " amendment of the same, limiting the statement to such foreign patents as had been taken out before application filed."

Col. Mason at length states his objections to the present form of the rule and of the oath required under it. The rule is based upon section 4887 of the Revised Statutes.

In my letter to you of the 9th instant, in reply to your inquiry of January 18, 1882, I stated my views of the proper construction of the section above mentioned. If my construbtion of the section is correct, the rule (39), based thereon, is undoubtedly correct, and the form of the oath required under such rule is also proper. The question, therefore, turns upon the construction of said section, and as that question is now pending before you, I transmit this communication for your consideration.

As will be seen by Col. Mason's communication, the construction now put upon the statute is the construction which it has received since it was enacted, except during a short interval of the term of my predecessor, Mr. Commissioner Paine. I may state, however, that Mr. Commissioner Paine addressed to me a letter within one month after he had retired from office, stating that he believed his construction of section 4887 was erroneous.

Very respectfully,
Your obedient servant,
E. M. Marble,
Commissioner.

(Copy.)

DEPARTMENT OF THE INTERIOR,
WASHINGTON, April 10, 1882.

The Commissioner of Patents.

SIR:

I acknowledge the receipt of your letters of the 4th of January last and the 9th ultimo relative to the execution by the Patent Office of the provision of section 4887 of the Revised Statutes, which directs that every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, with the one having the shortest time to run, provided that in no case shall a patent be in force more than seventeen years.

It is the policy of the law to have patents granted in this country for inventions previously patented in foreign countries, expire in this country at the time at which they expire in the countries in which they have the shortest term to run. It is the duty of the department to give effect to this policy so far as it can do so.

It has been suggested that the Patent Office has not sufficient means of learning whether in fact inventions for which patents are claimed have been patented abroad. That is, doubtless, true, but still the Patent office should use what means it has to that end. Now, it can search the conscience of the applicant and require from him all his knowledge on the subject. It is true he may falsify, but so may all witnesses, and yet we must in all controversies rely on sworn testimony. The testimony of the applicant here and the transcripts of patents in foreign countries filed in the Patent Office, are perhaps the only means by which the Commissioner of Patents can learn the existence of a foreign patent and the date at which it was granted, and it does not seem wise to have the office reject either of the modes of ascertaining the fact.

It is claimed, in the case appealed, that the applicant has made oath that he has procured a patent for an invention in one foreign country and has been required to state in addition whether he has obtained a patent for the same invention in any other foreign country. He protests against such requirement. It seems to me a statement of this proposition carries with it sufficient answer, the object is to get not only the truth, but the whole truth.

The applicant surely cannot complain if his patent here be limited by his own sworn statement concerning the issue of a foreign patent. He knows what the law intends to give him; if he states truly, he gets all that and should not want more; if he states untruly, he runs the risk of taking nothing by his falsity, if discovered, and also the risk of prosecution for perjury.

It is also suggested that if the patent issued here refers to the law limiting the life of the patent issued here to the life of a foreign patent issued for the same invention, that will be effective and sufficient. That may be so in law and not in fact; if the applicant states truly all he knows (and he knows all there is to know), his